THE

TRADE MARKS ACT, 1905

(5 *Edw.* 7, *Chap.* 15);

WITH

NOTES UPON THE SECTIONS OF THE ACT,

AND

THE TRADE MARK RULES 1906.

BY

LEONARD MOSSOP, B.C.L.,

of Lincoln's Inn, Barrister-at-Law.

LONDON:

WATERLOW BROS. & LAYTON, LIMITED,

24 & 25, Birchin Lane, E.C.

1906.

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TO

JOHN MEIR ASTBURY, Esq., K.C., M.P.

PREFACE.

This book is written for those whose interests and duties bring them into contact with the law relating to Trade Marks. It is intended as a handbook for the trader who has a Trade Mark to Register or protect, and for the agent whom the trader may employ for either of these purposes.

This being the object of the book, I have attempted to state as clearly and as concisely as I can, the general principles of law relating to Trade Marks. My hope is that from such a statement the trader and his agent may gain some assistance, and may the better be enabled to avoid the pitfalls which await those who are desirous of registering a Trade Mark or of protecting a Trade Mark already registered.

The reported cases on many branches of Trade Mark law have become so numerous as to tend to obscure the principles which underlie them. To the trader certainly, and perhaps also to the agent, the reported cases are a source of confusion rather than of help. I have consequently not dealt with the cases in detail, as is done in the learned works of Mr. Sebastian and Mr. Kerly, but have merely attempted to state the general principles which underlie them.

I have throughout this book, followed the arrangement of the subject prescribed by the Act itself, and have appended to each section any notes which have occurred to me as likely to be of assistance in elucidating its meaning.

I wish to acknowledge the courtesy and kindness which has been shown to me by H. Hatfield, Esq., Barrister-at-Law, of the Patent Office, and by J. C. Martin, Esq., of the same office. My thanks are also due to H. I. Whitaker, Esq., of Lincoln's Inn Library, for preparing the table of statutes and the index.

LEONARD MOSSOP.

12, *Old Square*,
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THE

TRADE MARKS ACT, 1905

(5 Edw. 7, Chap. 15).

BE it enacted by the King's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :— **Secs. 1, 2, 3.**

Short Title.

1. This Act may be cited as the Trade Marks Act, 1905.

Commencement of Act.

2. This Act shall, save as otherwise expressly provided, come into operation on the 1st day of April 1906.

Part I.

Definitions.

Definitions.

3. In and for the purposes of this Act (unless the context otherwise requires) :—

A "mark" shall include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof :

A "trade mark" shall mean a mark used or proposed to be used upon or in connection with goods for the purpose of indicating that they are the goods of the proprietor

of such trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale:

A "registrable trade mark" shall mean a trade mark which is capable of registration under the provisions of this Act:

"The register" shall mean the register of trade marks kept under the provisions of this Act:

A "registered trade mark" shall mean a trade mark which is actually upon the register:

"Prescribed" shall mean, in relation to proceedings before the Court, prescribed by rules of court, and in other cases, prescribed by this Act or the Rules thereunder:

"The Court" shall mean (subject to the provisions for Scotland, Ireland, and the Isle of Man) His Majesty's High Court of Justice in England.

Definitions.

A "mark" (*see* notes under section 9 at p. 20).

A "trade mark" and a "registrable trade mark" (*see* notes under section 8 at p. 6).

The "register" (*see* notes under section 4 at p. 3).

The Court.

The "Court" in England generally means the High Court of Justice.(a) The Court of Chancery of the County Palatine of Lancaster has the like jurisdiction as the High Court with respect to proceedings in relation to trade marks, the registration whereof is applied for in the Manchester Branch. As to the Manchester Branch, *see* section 64.

In Scotland the term "the Court" means the Court of Session. (b)

In Ireland the term "the Court" means the High Court of Justice in Ireland. (b)

As to the Isle of Man, *see* section 70.

(a) As to the County Court, *see* Bow *v.* Hart, 22 P.R. 222.
(b) Section 69.

Register of Trade Marks.

4. There shall be kept at the Patent Office for the purposes of this Act a book called the Register of Trade Marks, wherein shall be entered all registered trade marks with the names and addresses of their proprietors, notifications of assignments and transmissions, disclaimers, conditions, limitations, and such other matters relating to such trade marks as may from time to time be prescribed. The register shall be kept under the control and management of the Comptroller-General of Patents, Designs, and Trade Marks, who is in this Act referred to as the Registrar. Register of trade marks.

This section provides that there shall be kept at the Patent Office a register of trade marks. The register existing at the date of the commencement of this Act, and all registers kept under previous Acts are incorporated with the register established by this section (*see* section 6). The register.

There are also registers at Manchester for cotton goods (*see* section 64), and at Sheffield for metal goods (*see* section 63).

The register is under the control and management of the Comptroller-General of Patents, Designs and Trade Marks. The Comptroller-General in this Act and in the notes thereto is referred to as the Registrar. The Registrar is entitled under section 56, in any case of doubt or difficulty, to apply to the Attorney- or Solicitor-General for directions. The Registrar.

Under section 60 the Board of Trade has power from time to time to make rules, prescribe forms, and do such things as may be considered necessary for regulating registration under this Act. The rules and forms at present in force are set out in Appendix A.

The particulars to be entered on the register are as follows[a], viz.:— Particulars to be entered.

(1) The date of application (*see* section 16);

(*a*) Rules 64 to 67.

Particulars to be entered.

(2) The names and addresses of the proprietors (*see* section 32); and their descriptions (*see* Rule 63).

(3) A statement of the class or classes of goods in respect of which the mark is registered (*see* section 8);

(4) A note of assignments and transmissions (*see* sections 22, 23 and 33);

(5) A note of disclaimers (*see* section 15); and

(6) A note of conditions, limitations, and such other matters as may from time to time be prescribed (*see* sections 12 (2), 14 (4), and 21).

No notice of any trust may be entered on the register (section 5).

Certificates.

On the registration of a trade mark the Registrar issues to the applicant a certificate of the registration (*see* section 17). Such certificate is *primâ facie* evidence of the entry having been made, and of the contents thereof (*see* section 51).

All certified copies of the register are evidence in all legal proceedings (*see* section 50).

Any person making or causing to be made a false entry in the register is guilty of a misdemeanor (*see* section 66).

Renewal.

The registration of a trade mark may be renewed from time to time (*see* sections 28-31).

Rectification.

The register may be from time to time corrected and rectified (*see* sections 32-35).

Inspection.

The register is open to inspection of the public (*see* section 7).

Notices.

As to notices, *see* Rule 7; [a] and as to fees, *see* First Schedule to Rules.

Trust not to be entered on register.

5. There shall not be entered in the register any notice of any trust expressed, implied, or constructive, nor shall any such notice be receivable by the Registrar.

Trusts.

Where two identical marks are registered in respect of the same class of goods, an entry on the register of a note that the use of the marks is regulated by an agreement between the proprietors is irregular, unless the effect of the agreement is stated.[b] Even where the effect of the agree-

(*a*) Appendix A.
(*b*) Mitchell & Coy's. Tm. 28, C.D. 666.

ment is stated, the entry of the note ought not to be made if the effect of the agreement is to create a trust expressed or implied.(a)

Incorporation of existing register.

6. The register of trade marks existing at the date of the commencement of this Act, and all registers of trade marks kept under previous Acts, which are deemed part of the same book as such register, shall be incorporated with and form part of the register. Subject to the provisions of sections thirty-six and forty-one of this Act the validity of the original entry of any trade mark upon the registers so incorporated shall be determined in accordance with the statutes in force at the date of such entry, and such trade mark shall retain its original date, but for all other purposes it shall be deemed to be a trade mark registered under this Act.

See notes under sections 4, 36 and 41.

Inspection of and extract from register.

7. The register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Time for inspection

The register is open to the inspection of the public upon payment of the prescribed fee, on every week-day, except Saturday, between the hours of ten and four, and on Saturday between the hours of ten and one, except on the days following:—

Christmas Day; Good Friday; the day observed as His Majesty's Birthday; days observed as days of public fast or thanksgiving, or as holidays at the Bank of England; and days which may from time to time be

(a) De Otaduy's Tm. 1885, W.N. 177.

notified by a placard posted in a conspicuous place in the Patent Office.

The prescribed fee is 1s. for each quarter of an hour.

Searches.

A person wishing to adopt a trade mark should, before engraving any block and circulating impressions of the mark among his customers, make a search or a formal application for the registration at the Trade Marks Office with a view of ascertaining whether his proposed mark is already registered, or whether, from its being calculated to deceive, it would be refused registration under sections 11 and 19.

The Registrar will cause a search to be made amongst the trade marks recorded at his office upon a proper application.(a)

Complete searches amongst classified collections of marks in the cotton classes (classes 23, 24 and 25) can only be made at the Manchester Branch Office, 48, Royal Exchange, Manchester.

Certified copies of entries on the register are evidence in all legal proceedings (*see* section 51).

Registrable Trade Marks.

Trade mark must be for particular goods.

8. A trade mark must be registered in respect of particular goods or classes of goods.

A trade mark, characteristics of

A trade mark means a mark used or proposed to be used upon or in connection with goods for the purpose of indicating that they are the goods of the proprietor of such trade mark by virtue of manufacture, selection, certification, dealing with or offering for sale.(b) In order to make such a trade mark registrable under this Act, it must (except in the case of an old mark) contain one of the essential particulars set out in section 9. An old mark, viz., a mark used prior to the 13th August, 1875, must fall within the terms of the proviso relating to old marks contained in that section.

A registrable trade mark must consequently have the following characteristics, viz. :—

it must be a mark

(1) It must be a mark, *i.e.* a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof.(c)

(a) Rule 95.
(b) Section 3.
(c) Section 3, and see notes at p. 20.

(2) It must comply with the provisions of section 9. with an essential particular.

(3) It must be used or proposed to be used. A trader need not have used the trade mark prior to registration, but a trader cannot properly register a trade mark for goods in which he does not deal or in which he has not, at the time of registering, some definite and present intention to deal.(a) A trader may not place a mark on the register for the sole purpose of preventing others using it.(b) it must be used

(4) Such user must be upon or in connection with goods. The mark may be stamped on or affixed to the goods or attached to them or to the covering in which they are wrapped. It is immaterial in what manner the mark is attached, all that is necessary is that the mark shall be connected physically in some way or another with the goods as they are sold.(c) The user by a trader of his mark on packing cases or in his advertisements or price lists is not enough. in connection with goods

(5) The mark must be used for the purpose of indicating that the goods are the goods of the proprietor. This appears from the definition of a trade mark given in section 3, but it should be remembered that a trade mark in order to comply with section 9 must be a distinctive thing. Consequently a mark must not only indicate that the goods are the goods of the proprietor, but also must be adapted to distinguish the goods of the proprietor from those of other persons.(d) to indicate proprietor

(6) The mark must indicate that the goods are the goods of the proprietor by virtue of manufacture, selection, certification, dealing with, or offering for sale. A trade mark usually indicates either the manufacturer of the goods or the source from whence the goods come. In some cases the mark indicates the dealer in the goods or the selector.(e) by virtue of manufacture, &c.

A trader who has a registrable trade mark, *i.e.* a mark possessing the characteristics set out above, must register it in respect of particular goods or classes of goods. Under this and the previous Acts the Board of Trade has power to classify goods for the purpose of the registration of trade marks. The present classification of goods is set out in Classification of goods.

(a) Batt's Tm. 1898, 2 Ch. 432.
(b) Apollinaris Coy.'s Tm. 1891, 2 Ch. 186 at p. 234.
(c) Singer Manufact uring Coy. *v.* Wilson, 2 C. D. 441.
(d) *See* definition in section 9, and notes at p. 18.
(e) Hirsch *v.* Jonas, 3 C. D. 584.

Appendix A. If any doubt arises as to what class any particular description of goods belongs to, the doubt may be determined by the Registrar.

Each class separate.

Each of the classes of goods is to be treated as separate and distinct, and the registration of a mark in respect of each class is to be taken as a separate registration. When a trader applies for registration under a particular class, it is not enough for him simply to allege that he has already registered the same mark for another class. A trader may be prevented from registering his mark in a second class if any other person has used the same or a sufficiently similar mark for that latter class.(a)

User for part of a class.

It is not the intention of the Act that a man registering a trade mark for an entire class, and yet only using it for one description of goods in that class, shall be able to claim for himself the exclusive right to use it for every description of goods in that class.(b) If he desires to apply his trade mark to a new description of goods in that class, he must register his trade mark in respect of those goods. This he is entitled to do provided no other person has a right to use the same or a similar mark in respect of those goods.

The right to sue.

The right to sue for infringement of a trade mark is limited to the class of goods in respect of which the mark has been registered,(c) and to the goods in that class in respect of which the mark has been used.(d)

The trader who has registered his mark in respect of some of the goods of a class can sue for infringement of trade mark only in respect of those goods.(e) A trader may at Common Law acquire rights to the whole class if he has in fact used the mark for the whole class, and by such user the goods have become known to the public.(e) In other words, he may bring an action, not for infringement of trade mark under this Act, but at Common Law to prevent other persons passing off their goods as his.(f)

Registration gives exclusive right.

Upon registration the proprietor obtains, subject to the conditions entered on the register and to the concurrent rights of other people, the exclusive right to use the trade mark upon

(a) Lyndon's Tm. 32 C. D. 109, 113.
(b) Edwards *v.* Dennis, 30 C. D. 454; Hargreave *v.* Freeman, 1891, 3 Ch. 39.
(c) Hart *v.* Colley, 44 C. D. 193.
(d) Edwards *v.* Dennis, 30 Ch. D. 454; Hargreave *v.* Freeman, 1891, 3 Ch. 39.
(e) Jay *v.* Ladler, 40 Ch. D. 649.
(f) *See* section 39.

and in connection with the goods in respect of which it is registered.(a) This exclusive right continues until determination in one of the following ways, viz. :—

How lost.

(1) By being removed from the register under section 35.

(2) By the mark becoming publici juris or open to all to use. This generally occurs from the mark becoming descriptive of the article itself and not of the manufacturer. Thus "Linoleum" has become the name of a floorcloth which for many years was made under a secret process. In a recent case where the proprietors of a trade mark consisting of the word "Maizena" for corn-flour allowed the word to be used for 20 years as descriptive of the article and not of their own manufacture, the word was held to have become publici juris.(b)

(3) By the mark being severed from the goodwill of a business. A trade mark cannot exist in gross, but must exist in connection with the goodwill of the business, and is terminable with such goodwill.(c)

(4) By the mark being abandoned. In order to establish abandonment, there must be evidence of distinct intention to abandon. Mere discontinuance of user for lack of demand for the goods, even though coupled with non-registration and non-assertion of any right, is not sufficient.(d)

(5) By the mark being used so as to deceive. A deceptive trade mark is not entitled to the protection of the Court,(e) and

(6) By the non-renewal of registration under section 30.

Registrable trade marks.

9. A registrable trade mark must contain or consist of at least one of the following essential particulars :—

(1) The name of a company, individual, or firm represented in a special or particular manner ;

(2) The signature of the applicant for registration or some predecessor in his business ;

(a) Section 39.

(b) The National Starch Manufacturing Coy. *v.* Munn's Patent Maizena Coy., 1894, A. C. 275.

(c) *See* section 22, and notes thereunder.

(d) Mouson *v.* Boehm, 26 C. D. 398.

(e) Cochrane *v.* Macnish, 1896, App. Ca. 225, and the cases there cited.

(3) An invented word or invented words;

(4) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;

(5) Any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the above paragraphs (1), (2), (3), and (4), shall not, except by order of the Board of Trade or the Court, be deemed a distinctive mark:

Provided always that any special or distinctive word or words, letter, numeral, or combination of letters or numerals used as a trade mark by the applicant or his predecessors in business before the thirteenth day of August one thousand eight hundred and seventy-five, which has continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to the date of the application for registration shall be registrable as a trade mark under this Act.

For the purposes of this section "distinctive" shall mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons.

In determining whether a trade mark is so adapted, the tribunal may, in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered such trade mark in fact distinctive

for the goods with respect to which it is registered or proposed to be registered.

Previous sections.

This section governs all applications for trade marks from and after the 1st day of April, 1906. The previous sections were as follows, viz. :—

From 1875 to 1883, section 10 of the Act of 1875.

From 1883 to 1888, section 64 of the Act of 1883.

From 1888 to the 1st April, 1906, section 10 of the Act of 1888.

Section 10 of the Act of 1888.

Section 10 of the Patents, Designs and Trade Marks Act, 1888, was as follows :—

Section 10 (1) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars :

(*a*) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

(*b*) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark ; or

(*c*) A distinctive device, mark, brand, heading, label or ticket ; or

(*d*) An invented word or invented words ; or

(*e*) A word or words having no reference to the character or quality of the goods, and not being a geographical name.

(2) There may be added to any one or more of the essential particulars mentioned in this section any letters, words or figures, or combination of letters, words or figures, or any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

(3) Provided as follows :—

(1) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.

(ii) Any special and distinctive word or words, letter, figure or combination of letters or figures, or of letters and figures used as a trade mark before the thirteenth day of August, one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act.

Points of difference between this section and section 10.

The main points of difference between this section and section 10 of the Act of 1888 are as follows :—

(1) In sub-section (1) the insertion of the word "company."

(2) In sub-section (2) the insertion of the words "predecessor in business."

(3) In sub-section (4) the insertion of the words "according to its ordinary signification," a geographical name and the words "a surname."

(4) The substitution of sub-section (5) for the words "a distinctive device, mark, brand, heading, label or ticket."

(5) The omission of the provisions as to added matter and disclaimer. (As to this *see* section 15.)

(6) In the proviso as to "old marks" the addition of the last four lines commencing with the words "which has continued to be used."

(7) The insertion of a definition of the word "distinctive."

A Registrable Trade Mark must contain or consist of at least one of the following essential particulars :—

Essential particulars.

A registrable trade mark means a trade mark which is capable of registration under this Act. For a trade mark to be capable of registration it must contain one of the essential particulars set out in sub-sections (1), (2), (3), (4) and (5) of this section, or must fall within the proviso relating to old marks.

The mark may possibly fall within more than one of the five sub-sections, but each sub-section is separate and distinct and must be construed accordingly.(a)

(a) Eastman's Photographic Materials Coy., 1898, A.C. 571.

An old mark must have been used as a trade mark prior to the 13th August, 1875. No prior user of a new mark is necessary, but the applicant must intend to use it.(a) User.

By section 34 the Registrar is given power to alter trade marks in any manner not substantially affecting the identity of the same. It is thought, however, that this provision does not authorize the alteration of an essential particular of a mark. Alterations.

(1) *The name of a company, individual, or firm represented in a special or particular manner.*

The owners of old name marks, *i.e.* names of individuals or firms used as trade marks prior to the 13th August, 1875, may be properly registered under this Act. And this is so, although they are merely printed in ordinary type upon the goods. These old name marks differ from other trade marks. An ordinary trade mark is a distinctive thing assumed or invented by a man to mark his goods. Such a mark cannot be properly used by anyone but the proprietor. An old name mark, on the other hand, such as "Smith," printed in ordinary type, may designate many persons. According to English law a man cannot be prevented from carrying on his business in his own name, although it may be the name of a better known manufacturer, so long as he does nothing at all in any way to represent that he is that better known manufacturer.(b) Thus, Smith (No. 1) may make and sell pills as "Smith's Pills," but he cannot prevent Smith (No. 2) from doing the same thing so long as Smith (No. 2) does not represent his pills as being the pills of Smith (No. 1). Old name marks.

The rule may be stated thus: A manufacturer's right in his own name is absolute and exclusive as against persons bearing a different name, but is not so as against persons of the same name. But no man can have any right to represent his goods as the goods of another person.(c) Consequently if, in the illustration taken above, Smith (No. 2) in any way represents his goods as the goods of Smith (No. 1), then Smith (No. 1) can restrain him from so doing. A statement the rule.

(a) Apollinaris Tm., 1891, 2 Ch. 186; Batt & Coy.'s Tm., 1898, 2 Ch. 432.
(b) Burgess *v.* Burgess, 3 De G. M. & G. 896; Turton *v.* Turton, 42 C.D. 128, 143.
(c) Holloway *v.* Holloway, 13 B. 209.

The disability does not attach to new name marks.

The disability or inconvenience which attaches to an old name mark in the manner indicated above does not affect the names of companies, individuals or firms registered as trade marks under this sub-section. These latter have to be represented in a special or particular way. If a new name mark is registered in a special or particular way (and the Registrar may reject any name not so represented) no difficulty can arise with companies, individuals, or firms bearing the same or similar names.

Points for applicant to consider.

An applicant desiring to register a name mark under this sub-section should keep in mind the following points, viz. :—

(1) A name mark should be combined with some other element in respect of printing, colouring or pattern, so that the same may be represented in a special or particular manner.

(2) A name is not represented in a particular or special manner which is simply printed in ordinary type, whether capital letters are used or not.(a) The addition of words common to the trade will not make the mark a good one.(b)

(3) The name should not be registered in the possessive case, *e.g.* "Pirie's Parchment Bank,"(c) but in the nominative case.

(4) The name may be registered alone or in combination.

(5) The name need not be the name of a living person, nor the name of the applicant for registration.(d)

(6) The names of fictitious persons, *e.g.* "Trilby," are not within the sub-section, but such name may be capable of registration under sub-section (4).(d)

A name mark is assignable.

In most cases the name registered is the name of the actual manufacturer, and is intended to represent that the article is of his manufacture. The mark once registered is, however, assignable in connection with the goodwill of a business, and so may come into the ownership of persons bearing a different name from that registered. In such cases the mark ceases to represent the manufacturer, and becomes merely a sign of the quality of the article or the source from whence it comes.(e)

(a) Gianaclis' Tm., 6 P.R. 467; Carroll's application, 16 P.R. 82.
(b) *In re* Price's Candle Coy., 27 C.D. 681.
(c) 1892, 1 Ch. 35, 43.
(d) Holt's Tm., 1896, 1 Ch. 711.
(e) Hall *v.* Barrows, 4 De G. J. and S. 150.

(2) *The signature of the applicant for registration, or some predecessor in his business.*

Signatures.

Under the corresponding sub-section in the repealed Act the signature was bound to be the signature of the applicant for registration. Under the present sub-section the signature of any predecessor of the applicant's business may be registered, and this is so whether such predecessor be living or dead.

The owner of a trade mark registered under this sub-section cannot prevent the signature of another person bearing the same or a similar name being registered.(a)

(3) *An invented word or words.*

Sub-sections (3) and (4) are separate and distinct.

An invented word within the meaning of this sub-section may be registered as a trade mark, although it has reference to the character or quality of the goods within the meaning of those words in sub-section 4.(b) Sub-sections (3) and (4) are independent of one another.(b)

Invented words.

It is of course of great importance that descriptive words, *i.e.* words in ordinary use referring to the character or quality of goods, should not be monopolised by a single trader so that others are excluded from using them. The exclusive user by a single trader of an invented word, *i.e.* a word which does not form any part of our language, hurts no one. Thus the word "Solio" is not used in any sense which would make it intelligible in England. The word therefore registered as a trade mark for photographic paper is an invented word within the meaning of this sub-section, although it is an Italian word meaning a throne, and although it is a Latin word in the ablative case with the same meaning, and although an ingenious person might find in the word some covert allusion to the character or quality of the goods.(b)

The word "Tachytype" for a type-composing machine(c) and the word "Tabloid" for medicine(d) have been held to be invented words.

Points for applicant to consider.

An applicant desiring to register an invented word as his trade mark should keep in mind the following points, viz.:—

(a) Crawford & Son *v.* Bernard & Co., 11 P.R. 580.
(b) Eastman's Photographic Materials Coy., 1898, A.C. 571.
(c) The Linotype Coy.'s application, 1900, 2 Ch. 238.
(d) Burroughs, Wellcome & Coy.'s Tm., 21 P.R. 217.

Points for applicant to consider.

(1) A word already in existence and in use is not an invented word. This is so, whether the person claiming to have invented the word was aware of its existence or not.(a) The word "Electrozone" was refused upon the ground that it had become familiar to the residents of America.(b) The word "Hoematogen" for a medicine(c) and the word "Bioscope" for a cinematographic apparatus(d) were refused upon similar grounds.

(2) A combination of English words is not an invented word, *e.g.* "cheapandgood."

(3) An ordinary English word misspelt is not an invented word, *e.g.* "Uneeda"(e) and "Phiteesi."

(4) A word which sounds exactly like an ordinary English word is not an invented word, *e.g.* "Perle" for pearl.(f)

(5) A mere addition to a word already in use of a common English termination, such as "ne" or "ine," is not sufficient to make the word an invented word. The words "Eboline,"(g) "Satinine"(h) and "Absorbine"(i) have been refused for this reason.

The addition to a word of a meaningless termination may be sufficient to make the word an invented word, *e.g.* "Savonol."(j) In such cases the Registrar will no doubt require the disclaimer of the part formed by the word already in use.

(6) A foreign word is not an invented word, even though the word is not current in England.(k)

(4) *A word or words having no direct reference to the character or quality of the goods and not being according to its ordinary signification a geographical name or a surname.*

In selecting a word for registration under this sub-section care must be taken to see that it has no reference to the

(a) Sir Titus Salt & Coy.'s Tm., 1894, 3 Ch. 166.
(b) British Electrozone Coy.'s Tm., 13 P.R. 447.
(c) Honmel *v.* Bauer & Coy., 22 P.R. 43.
(d) Warwick Coy. *v.* Urban, 21 P.R. 240.
(e) National Biscuits Coy.'s Tm., 1901, 1 Ch. 550.
(f) Ripley's Tm., 15 P.R. 151.
(g) Sir Titus Salt & Coy.'s Tm., 1894, 3 Ch. 166.
(h) Meyerstein's Tm., 43 C.D. 604.
(i) Christy *v.* Tipper, 21 P.R. 755.
(j) Field Limited, *v.* Wagel Syndicate, Ltd., 17 P.R. 266.
(k) Eastman's Photographic Materials Coy., 1898, A.C. 571, 577.

character or quality of the goods to which it is to be applied. In order to invalidate the mark the reference to the character or quality of the goods must be a direct reference. It is not enough that by the exercise of ingenuity you can extract from a word used as a trade mark for goods some reference of the character or quality of such goods. Thus the word "Solio" registered as a trade mark for photographic paper has no direct reference to the character or quality of such paper;(a) the same may be said of the word "Mazawattee" as applied to tea,(b) and the word "Trilby"(c) as applied to gloves, and the word "Kynite" as applied to explosives.(d)

Words referring to character or quality.

On the other hand, words having a direct reference to the character or quality of the goods to which they are applied cannot be registered. For instance, the words "Filtered Blue" as applied to laundry blue,(e) the word "Satinine" as applied to starch,(f) and the word "Typograph"(g) as applied to a typewriting machine.

Further, a word to be registrable under this sub-section must not according to its ordinary signification be a geographical name. The corresponding sub-section of the repealed Act did not contain the words "according to its ordinary signification," and this renders many of the previous decisions of little assistance in considering this sub-section. In selecting a name for registration, the applicant should be guided by the following rules, viz.:—

Geographical words.

(1) If the name to be registered has in its ordinary signification in this country a geographical meaning, the registration will be bad, *e.g.* "Glenfield Starch," "Eton Cigarettes," or "Melrose Hair Restorer."

Points for applicant to consider.

(2) If the name to be registered has in fact a geographical meaning, but also has a meaning better known in England than the geographical one, then the latter meaning will prevail and the registration will be good. For instance, the word "Magnolia" is the name of several places in America, but is better known in this country as the name of a flower; consequently as a registered trade mark in this country,

(a) Eastman's Photographic Materials Coy., Ltd., 1898, A.C. 571.
(b) Densham's Tm., 1895, 2 Ch. 176.
(c) Holt & Coy.'s Tm., 1896, 1 Ch. 711.
(d) Kynoch's Tm., 14 P.R. 905.
(e) Edge's Tm., 8 P.R. 207.
(f) Meyerstein's Tm., 7 P.R. 114.
(g) Linotype Coy.'s Tm., 14 P.R. 900.

Geographical words.

the word is not (subject to (3) hereunder) according to its ordinary signification a geographical name.(a)

(3) Where the name registered is the name of a place (although practically unknown in this country), and is also the name of an article well known in this country, then if the article is itself identified with the place, either by being manufactured there or deriving its name therefrom, the registration will be bad. Thus the word "Apollinaris" is the name of a spring in Rhenish Prussia, and is also the name of a mineral water well known in this country; the name of the mineral water is taken from the spring, and its registration would accordingly be bad.(b)

Surnames.

A word to be properly registered under this sub-section must not be a surname. Surnames are registrable under sub-section (1), and must then be represented in a special or particular manner. The names of fictitious persons, *e.g.* "Trilby," are registrable, if at all, under this sub-section.(c)

(5) *Any other distinctive mark.*

This sub-section authorizes the registration as a trade mark of any distinctive mark other than those mentioned in the first four sub-sections, and subject only to an exception as regards names, signatures and words.

Distinctive, definition of.

The word "distinctive" means any mark adapted to distinguish the goods of the proprietor of the mark from those of other persons.

Points for applicant to consider.

In selecting a mark for registration under this sub-section it is of the utmost importance that the mark should be distinctive in the sense defined above. It is impossible to lay down any fixed rule as to whether a mark is distinctive or not, but the applicant for registration should keep the following points in mind, viz.:—

Marks common to the trade.

(1) Marks which are common to a trade should not be taken. Marks common to a trade are such marks as are known to a trade and open to every person in that trade to use.(d) For instance, representations of elephants or lions are common in some trades, and triangular figures, crowns, &c., are common in others; such marks are not distinctive.

(a) Magnolia Metal Coy.'s Tm., 1897, 2 Ch. 371.
(b) Apollinaris Coy.'s Tm., 1891, 2 Ch. 186.
(c) Holt's Tm., 1896, 1 Ch. 711.
(d Burland *v.* Broxburn Oil Coy., 42 C. D. 274.

(2) Marks which describe the article itself or its quality or character are not distinctive, and should not be taken.(a) For instance, a representation of a motor car should not be registered as a trade mark for a motor car company unless such representation has been worked up into a distinctive design. Descriptive marks.

This equally applies to word marks which describe the article, or have come to do so in the course of time. For instance, a company for many years manufactured a composition of lead and other metal, first under a secret process and then under a patent. The company sold this compound as Magnolia metal. Subsequently the company registered the word "Magnolia" as a trade mark. It was held that the mark was bad upon the ground that the compound, *i.e.* the article sold, had become generally known as Magnolia.(b) Word marks.

It may be stated as a general rule that when an article is made under a secret process, or when the manufacture of it is protected by a patent, the manufacturer or patentee cannot by any means entitle himself to a monopoly in the use, after the secret process has been discovered or the term of the patent has expired, of the name by which the manufactured article is exclusively known whilst the secret is undiscovered or the term of the patent is unexpired.(c) Goods made under secret process or patent.

In determining whether the trade mark is distinctive, the tribunal may take into consideration the extent to which user has rendered such trade mark in fact distinctive of the goods in respect of which it is registered.(d) Thus a name which in its ordinary signification is geographical may by actual user as the trade mark for specific goods become distinctive. For instance, the word "Anatolia" for liquorice,(e) or "Glenfield" for starch.(f) In like manner a word other than a geographical name may obtain by user in connection with goods a secondary meaning which will render it distinctive, *e.g.* Camel hair Belting.(g) User to be considered.

(3) Under the repealed Acts it was held that a mark must be distinctive irrespective of its colour. By section 10 of this Act it is enacted that a trade mark may be limited in whole or in part to one or more specified colours, and in such cases the Colour to be considered.

(a) James's Tm., 31 C.D. 340.
(b) Magnolia Metal Coy.'s Tm., 1897, 2 Ch. 371, 391.
(c) Magnolia Coy.'s Tm., *supra*.
(d) Section 9.
(e) McAndrew *v.* Bassett, 33 L.J. Ch. 561.
(f) Wotherspoon *v.* Currie, L.R. 5 H.L. 508.
(g) Reddaway *v.* Banham (1896), A.C. 199, 205.

fact that it is so limited shall be taken into consideration by any tribunal having to decide on the distinctive character of such trade mark. In future therefore the colour of a mark is an element to be taken into account in deciding whether the mark is or is not distinctive.

Deceptive marks.

(4) Marks which are calculated to deceive the public must be avoided (*see* section 11).

(5) Marks which so nearly resemble other trade marks as to be calculated to deceive must be avoided (*see* section 19).

(6) Marks which so nearly resemble the marks used by competitors in their advertisements, price lists and billheads must be avoided.

The Royal Arms.

(7) Representations of the Royal Arms of the King or any member of the Royal Family, or of the Royal Crown, or the national arms or flag must be avoided.

A mark, definition of.

The word "mark" as defined by section 3 includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof.

A device.

The word "device" includes any design or picture or representation, *e.g.* of animals or geometrical figures or crests, &c.; and providing these are distinctive they may be registered. Thus a design of a black dome is a distinctive mark for black lead,(*a*) or a magnolia flower for metal goods,(*b*) but the design should not be a representation of the article itself.

Portraits.

A portrait of the manufacturer of the article will as a general rule be distinctive,(*c*) but some portraits, owing to the fact that they have become common to the trade, are not distinctive and cannot be registered; for instance, a copy of Gainsborough's portrait of the Duchess of Devonshire was held to be common to the trade in respect to millinery goods,(*d*) and a portrait of Dr. Liebig was held to be common to the trade when applied to extracts of meat.(*e*)

Arrangement of letters.

Prior to this Act it was held that an arrangement of letters, however distinctly combined, was not a distinctive device,(*f*) and the same was held as to a single letter.(*g*) But query whether a letter, word, or numeral, or a combination thereof, is

(*a*) James's Tm., 31 C.D. 340; 33 C.D. 392.
(*b*) Magnolia Metal Coy.'s Tm., 1897, 2 Ch. 371.
(*c*) Rowland *v.* Michell, 1897, 1 Ch. 71.
(*d*) Louise *v.* Gainsborough, 20 P.R. 61.
(*e*) Anderson's Case, 26 C.D. 409.
(*f*) *Ex p.* Stephens, 3 C.D. 659.
(*g*) Mitchell's Tm., 7 C.D. 36.

not under the present sub-section a good mark, provided it is represented in a distinctive fashion. Even prior to this Act letters in ornamental characters were held to be a distinctive device and entitled to registration.(a)

A brand.

The word "brand" refers to a mark which is used by being stamped upon or burnt in or woven into goods.(b) A watermark may be a good brand.(b) A brand trade mark should be used as a brand only.(b) A man cannot obtain registration of words not otherwise registrable by calling the mark a brand. For instance, the words "Piries Parchment Bank"(b) and the words "John Bull Brand"(c) have been refused registration as brands.

A heading.

A single word used alone is not a heading.(d) In regard to cotton goods, a heading means a mark or pattern woven into the goods. In one case a particular heading consisting of purple, pink and green coloured threads in combination was held to be a good mark.(d*)

A label.

A "label" refers to a piece of paper or any other substance which is intended to be affixed or stuck upon the articles sold. Any distinctive label will do, but words or marks not registrable under the other sub-sections do not become so simply because they are printed upon a label. For instance, the name of a firm printed in ordinary type upon a label cannot be registered.(e)

A ticket.

A "ticket" differs from a label only in the fact that it is loosely attached to the goods instead of being stuck upon them.

Names, signatures and words.

"Names, signatures and words." Unless a name, signature, word or words can be registered as a trade mark under sub-sections (1), (2), (3) and (4) of this section, they cannot be registered as distinctive marks under sub-section (5) except by order of the Board of Trade or the Court.(f)

"Letters and numerals." It is thought that letters and numerals and any combination thereof are now good trade marks and may be registered as such, provided they are represented in a distinctive manner.

(a) Rotherham's Tm., 11 C.D. 250.
(b) Pirie *v.* Goodall, 1892, 1 Ch. 35, 41.
(c) Paine's Tm., W. N., 1892, 56.
(d) Leonard and Ellis's Tm., 26 C.D., 295.
(d*) Harter *v.* Souvazoglu, 1875, W.N. 11, 101; and *see* section 64 (10).
(e) The Great Tower Tea Company *v.* Smith, 6 P.R., 170.
(f) Applications to register a name, signature or word or words under sub-section 5 of section 9 are governed by Rules 35 to 41; *see* Appendix A.

Old Marks.

Many marks used prior to the 13th August, 1875, do not fall within any of the five sub-sections of this section, and the proviso relating to old marks is inserted to enable such old marks to be registered.

Registrable old marks.

Old marks registrable under this provision consist of a word or words, letters, numerals, or combination of letters or numerals. Any of these may be registered, provided they are special or distinctive, and have been used prior to the 13th August, 1875, as trade marks.

Special, meaning of.

There is but little difference between the meaning of the words special and distinctive. The word "special" means a word used as a trade mark which separates the article to which it is applied from all others of the same class or character, something which points out the article as standing alone, which makes the man who sees or reads the word understand that the article has a special standing, a special existence, and is not of the general class (*e.g.* of pianos), but belongs to a class of a particular character.(*a*)

The word "distinctive" means any mark adapted to distinguish the goods of the proprietor of the mark from those of other persons; *see* notes as to "distinctive" at p. 18.

Points for applicant to consider.

An applicant desiring to register an old mark under this Act should keep in mind the following points, viz. :—

(1) The mark must have been used as a trade mark prior to the 13th August, 1875. Slight evidence of user prior to that date will be sufficient.(*b*)

(2) The user must have been in the United Kingdom.(*b*) The importation of goods marked with a distinctive brand or label for the purpose of transhipment only is not sufficient user in England.(*c*)

(3) The applicant or his predecessors in business must have continued to use the mark down to the date of application.

(4) The mark must have been used alone as a trade mark and not in combination of other marks.(*d*)

(5) The mark must have been used as a trade mark, *i.e.* not as a design or pattern.(*e*) The fact that goods have been

(*a*) Hopkinson's Tm., 1892, 2 Ch. 118, 121.
(*b*) Chorlton and Dugdale's Tm., 53 L.T. N.S., 337.
(*c*) Meeus' application, 1891, 1 Ch. 41.
(*d*) Perry, Davis & Son *v.* Harbord, 15 App., 316.
(*e*) Harrisons' Tm., 42 C.D. 691.

known prior to the year 1875 by the name sought to be registered as a trade mark through the use of that name in price lists, catalogues, billheads, &c., is not sufficient.(a)

(6) The mark must have been used on the goods as they were sold in the market. Consequently user of a mark on the packing cases for wine or other bottled goods is not sufficient.(b) User of the mark upon the boxes in which goods are actually sold is sufficient, *e.g.* boxes of cigars, soap, &c.(c)

(7) The user must have been upon the same class of goods in respect of which the mark is registered (d); and

(8) The user must not have been calculated to deceive the public.(e)

Coloured trade marks.

10. A trade mark may be limited in whole or in part to one or more specified colours, and in such case the fact that it is so limited shall be taken into consideration by any tribunal having to decide on the distinctive character of such trade mark. If and so far as a trade mark is registered without limitation of colour it shall be deemed to be registered for all colours.

The mark must have an essential particular.

This sub-section is substituted for section 67 of the Act of 1883. Under section 67 a trade mark might be registered in any colour or colours. It was held, however, that a trade mark must have one of the essential particulars set out in section 10 of the Act of 1888,(f) independently of the colour in which it was registered. In other words, a trade mark of which the only distinction was colour could not be registered.(g) Consequently a trade mark consisting of a label shaded so as to represent three colours, across it being printed the words "red, white and blue," was refused.(g)

Under the present section the same remarks apply. In order that a trade mark may be good, one must find in it an

(a) Hayward's Tm., 54 L. J. Ch. 1003.
(b) Richards *v.* Butcher, 1891, 2 Ch. 522.
(c) Powell's Tm., 1893, 2 Ch. 388.
(d) *In re* Jelley, Son & Jones, 51 L. J. Ch. 639.
(e) Heaton's Tm., 27 C.D. 570.
(f) This section is set out on p 11.
(g) Hanson's Tm., 37 C.D. 112.

Coloured trade marks.

essential particular as defined by section 9. Given an essential particular, then the Court ought to take into consideration the fact that the trade mark is limited to certain specified colours. The specified colours may render the mark distinctive, *i.e.* may distinguish the goods of the proprietor of the mark from the goods of other persons.

Where no limit as to colour.

When a mark is registered without limitation of colour it is open to the proprietor to use it in any colour. This is a fact which may be material in deciding whether a mark so nearly resembles another mark as to be calculated to deceive.(a)

The fact that a mark is actually used in connection with certain colours may be material in an action for infringement.

Restriction on registration.

11. It shall not be lawful to register as a trade mark or part of a trade mark any matter, the use of which would by reason of its being calculated to deceive or otherwise be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

Deceptive marks.

This section prohibits the registration of a deceptive mark. A mark may be deceptive by reason of its resemblance to another mark, or by reason of its containing a misrepresentation of fact.

Marks bad under section 19.

When a mark is alleged to be deceptive owing to its resemblance to another mark, the same question arises as under section 19, and the same considerations apply. The note and cases cited under that section are in point, and all that it is necessary to say here is that an applicant for the registration of a trade mark must avoid any mark which would be refused under section 19.

Misstatement of facts.

The applicant must further avoid all marks which contain a misrepresentation of fact. For instance, a mark which represents that the goods to which it is applied were made in England, when in fact they were made abroad, ought not to be registered.(b) The same remark applies to a mark which

(a) *See* Dewhirst's application, 1896, 2 Ch. 137; La Société Anonyme's Tm., 1894, 1 Ch. 61, 65.

(b) Wood *v.* Lambert, 32 C.D. 247.

represents the goods as made under a patent, when in fact they are not so made.(a) Misstatement of facts.

The words "trade mark" must not be printed so as to represent that part of the mark and not the whole is the actual mark registered.(b)

The applicant should omit the words "Patent," "Patented," "registered," "registered design," "copyright," "Entered at Stationers' Hall," or "to counterfeit this is a forgery," and Representations of the Royal Arms.(c)

Registration of Trade Marks.

12.—(1) Any person claiming to be the proprietor of a trade mark who is desirous of registering the same must apply in writing to the Registrar in the prescribed manner. Application for registration.

(2) Subject to the provisions of this Act the Registrar may refuse such application, or may accept it absolutely or subject to conditions, amendments, or modifications.

(3) In case of any such refusal or conditional acceptance the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving at the same, and such decision shall be subject to appeal to the Board of Trade or to the Court at the option of the applicant.

(4) An appeal under this section shall be made in the prescribed manner, and on such appeal the Board of Trade or the Court, as the case may be, shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what conditions, amend-

(a) Leather Cloth Case, 11 H.L.C. 523.
(b) Dexter's application, 1893, 2 Ch. 262.
(c) Appendix A., Rules 11 to 15.

ments, or modifications, if any, the application is to be accepted.

(5) Appeals under this section shall be heard on the materials so stated by the Registrar to have been used by him in arriving at his decision, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar, other than those stated by him, except by leave of the tribunal hearing the appeal. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.

(6) The Registrar or the Board of Trade or the Court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such terms as they may think fit.

Applications for registration.

Applications for the registration of trade marks are governed by sections 12, 13 and 14 of this Act, and the rules under this Act, which are set out in Appendix A.

This section deals with an application for the registration of a trade mark from its inception down to the date of its being either accepted or refused by the Registrar. Section 13 provides for the advertisement of an application for registration when accepted by the Registrar. Section 14 deals with the opposition to an application after it has been accepted and advertised.

Who may register.

Any persons claiming to be the proprietor of a trade mark may apply for its registration. The word a "person" includes an individual or a firm or a company, and it is immaterial whether such persons are British subjects or foreigners, provided the mark is used or is to be used upon goods sold in this country. The person must, however, be the proprietor of the mark to be registered. An importer of foreign

goods cannot register as his own the trade mark of the foreign producer.(a)

Applications, how made;

Applications for the registration of a cotton mark must be made to the Keeper of Cotton Marks at the Manchester Branch, 48, Royal Exchange, Manchester.(b) Other applications (except applications which, under section 63 of this Act, should be made to the Cutlers' Company) should be addressed and sent to the Registrar at the Patent Office, Trade Marks Branch, 25, Southampton Buildings, London.

must be in writing,

The application must be made in writing upon the prescribed form. Except in the case of special applications (c) (*e.g.* under paragraph 5 of section 9, under section 62, and under section 26) the form to be used is Form T.M. No. 2.

must be signed.

This form must be signed(d) either by the applicant himself or by a member of the firm if the applicant is a firm, or by the secretary or other principal officer of a company if the applicant is a company. The form may also be signed by an agent for the applicant, duly authorized to the satisfaction of the Registrar.(d)

Representation of the mark.

The application for registration of a trade mark must contain a representation of the mark affixed to it in the square which the form contains for that purpose.(e) In the event of the representation of the mark exceeding the square in size, the representation of the mark must be mounted on linen tracing-cloth, or other material that the Registrar may consider suitable. Part of the mounting must be affixed to the square upon the form and the rest folded over. Accompanying the application form there must also be sent to the Registrar four additional representations of the mark as provided by the rules.

Translations to be supplied.

When a trade mark contains a word or words in other than Roman characters, there must be indorsed on the application a sufficient transliteration and translation to the satisfaction of the Registrar of each of such words, and every such endorsement must be signed by the applicant or his agent.(f)

(a) Apollinaris Coy.'s Tm., 1891, 2 Ch. 186.

(b) Rule 18.

(c) As to applications under section 9 (5), *see* Rules 35 to 41; as to applications under section 62, *see* Rules 42 to 46; and as to applications under section 26, *see* Rule 27.

(d) Rule 17.

(e) Rule 21.

(f) Rule 28.

Translations.

Where a trade mark contains a word or words in a language other than English, the Registrar may ask for an exact translation thereof, and if he so requires, such translation shall be endorsed and signed as aforesaid.(a)

The class of goods to be stated.

The application form must state the class of goods in which the mark is to be registered, and must specify the kind of goods in that class in respect of which the mark is to be registered. For the purposes of registration goods have been classified, and the classification is set forth in the third schedule to the Rules.(b) An applicant should not claim a mark unless he intends to use it, or unless he deals or intends to deal in the goods in respect of which the goods are registered, and unless he intends to apply the mark to the goods in respect of which it is registered.(c)

Search to be made.

The application having been sent to the Registrar, the Registrar causes a search to be made amongst the registered marks and pending applications for the purpose of ascertaining whether there are on record any marks for the same goods or description of goods identical with the mark applied for, or so nearly resembling it, as to be calculated to deceive.(d)

Registrar's discretion to accept or refuse.

After such search has been made, the Registrar may either refuse the application or may accept it absolutely, or subject to certain conditions and amendments and modifications, or subject to a disclaimer being made. The Registrar's discretion is a judicial discretion, and must be exercised reasonably and not capriciously.(e)

Grounds for refusal.

The grounds upon which the Registrar may refuse to register may be classified in the following manner, viz. (1) that the application is irregular, *e.g.* made by a person who is not the proprietor, or made in the wrong form; (2) that the mark does not contain one of the essential parts prescribed by section 9; (3) that the mark in other respects is not a registrable trade mark;(f) (4) that the mark so nearly resembles another trade mark as to be calculated to deceive (*see* section 19); (5) that the mark is deceptive (*see* section 11); and (6) that it offends against the Rules,(g) *e.g.* it contains representations of the Royal Arms, &c.

(a) Rule 28.
(b) *See* section 8, and Appendix A.
(c) *See* section 8, and note thereunder.
(d) *See* Rule 29.
(e) Eno *v.* Dunn, 15 App. Ca. 252.
(f) *See* section 8, and notes thereunder.
(g) Rules 11 to 15.

The Registrar's decision

Before exercising his discretion under this section the Registrar will if so required(a) hear the person who will be affected by the exercise of such power.

In the event of the Registrar either refusing the application or accepting it subject to conditions, the applicant is entitled to require the Registrar to state in writing the grounds of his decision and the materials used by him in arriving at the same.(b)

Is subject to appeal.

The decision of the Registrar is subject to an appeal to the Board of Trade or to the Court, at the option of the applicant. An appeal to the Board of Trade must be made in the manner prescribed by Rules 122 to 127.

On an appeal, the Board of Trade, or the Court, as the case may be, may determine whether, and subject to what conditions, if any, the application is to be accepted. Upon such appeal the only objections to the application which can be taken (except by leave of the tribunal hearing the appeal) are those stated by the Registrar to have been used by him in arriving at his decision. Where any further grounds of objection are taken the applicant is entitled to withdraw his application without payment of costs on giving notice as prescribed.

In the event of the application being accepted either absolutely or subject to conditions, the preliminary part of the application is ended, and the application proceeds as laid down in sections 13 and 14.

Advertisement of application.

13. When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions, the Registrar shall, as soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner. Such advertisement shall set forth all conditions subject to which the application has been accepted.

This section deals with an application for registration which has been accepted either absolutely or conditionally,

(a) Rule 32.
(b) Rule 33.

Advertisement of application.

and provides for the advertisement of the application as accepted in the manner prescribed by Rules 47 to 50. These Rules provide for the advertisement by the Registrar in the *Trade Marks Journal* of the application as accepted.

For the purposes of such advertisement the applicant may be required to furnish a wood-block or electrotype of the trade mark, of such dimensions as may be directed by the Registrar, and when an application relates to a series of trade marks the applicant may be required to furnish a wood-block or electrotype of any or each of the trade marks constituting the series.

As a general rule a representation of the trade mark is included in the advertisement. If no representation of the trade mark be inserted, the Registrar must state a place or places where a specimen or representation of the trade mark is deposited for exhibition.

Opposition to registration.

14.—(1) Any person may, within the prescribed time from the date of the advertisement of an application for the registration of a trade mark, give notice to the Registrar of opposition to such registration.

(2) Such notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(3) The Registrar shall send a copy of such notice to the applicant, and within the prescribed time after the receipt of such notice, the applicant shall send to the Registrar, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.

(4) If the applicant sends such counter-statement, the Registrar shall furnish a copy thereof to the persons giving notice of opposition, and shall, after

hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions, registration is to be permitted.

(5) The decision of the Registrar shall be subject to appeal to the Court or, with the consent of the parties, to the Board of Trade.

(6) An appeal under this section shall be made in the prescribed manner, and on such appeal the Board of Trade or the Court, as the case may be, shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(7) On the hearing of any such appeal any party may either in the manner prescribed or by special leave of the tribunal bring forward further material for the consideration of the tribunal.

(8) In proceedings under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar other than those stated by the opponent as herein-above provided except by leave of the tribunal hearing the appeal. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(9) In any appeal under this section, the tribunal may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity of such trade mark, but in such case the trade mark as

so modified shall be advertised in the prescribed manner before being registered.

(10) The Registrar, or in the case of an appeal to the Board of Trade the Board of Trade, shall have power in proceedings under this section to award to any party such costs as they may consider reasonable, and to direct how and by what parties they are to be paid.

(11) If a party giving notice of opposition or of appeal neither resides nor carries on business in the United Kingdom, the tribunal may require such party to give security for costs of the proceedings before it relative to such opposition or appeal, and in default of such security being duly given may treat the opposition or appeal as abandoned.

Notice of opposition to registration

The notes under sections 12 and 13 deal with the procedure relating to an application for registration of a trade mark down to the date of its advertisement in the *Trade Marks Journal*. Under this section we have to consider the procedure where the registration of a trade mark is opposed by a rival trader.

must be in writing,

Any person may, within one month from the date of the advertisement of the application, give notice to the Registrar of opposition to such registration.(a) The notice of opposition must be given in writing upon the prescribed form. (Form T.M. No. 7 in the first schedule to the rules.)(b) This notice must be signed by the opponent, and must contain an address for service in the United Kingdom.

must state grounds.

The notice must contain a statement of the opponent's grounds of opposition. The grounds of opposition will, as a rule, be similar to the grounds upon which the Registrar may refuse registration.(c)

If the ground or one of the grounds of opposition is that there is already on the register a trade mark similar or identical with the mark proposed to be registered, the notice

(a) Rule 51.
(b) Rule 52.
(c) *See* p. 28.

should state the numbers of such marks, and the numbers of the Journals in which they have been advertised.

The counter-statement.

A copy of the notice of opposition is sent to the applicant, and within one month from the date of its receipt the applicant must send to the Registrar a counter-statement (Form T.M. No. 8), setting out the grounds on which he relies for his application.(a) The applicant, if he fails to send this counter-statement, is considered to have abandoned his application.

Evidence.

The Registrar is bound to furnish a copy of the counter-statement to the opponent, and the opponent must, within one month from the receipt of such counter-statement, leave at the Patent Office his evidence in support of his opposition, and deliver copies thereof to the applicant.(b)

Within one month from the delivery of the opponent's evidence the applicant must leave at the Patent Office his evidence in answer, and deliver to the opponent copies thereof.(c)

Within fourteen days from the receipt of the applicant's evidence the opponent must put in his evidence in reply.(d)

The times prescribed by the rules may be enlarged by the Registrar, if he thinks fit.(e)

Statutory declarations.

In any proceedings before the Registrar the evidence is given by statutory declaration, in the absence of directions to the contrary.(f) Any declaration may, in the case of appeal, be used before the Court in lieu of evidence by affidavit, and if so used has all the incidents and consequences of evidence by affidavit.

Viva voce.

The Registrar may direct that the evidence be taken *viva voce*, and if this is done, the Registrar has, in respect of requiring the attendance of witnesses and taking evidence on oath, the same powers as an Official Referee of the Supreme Court.(g)

The hearing by the Registrar.

On the completion of the evidence the Registrar gives notice to the parties of the date when he will hear the arguments in

(a) Rule 53.
(b) Rule 54.
(c) Rule 55.
(d) Rule 56.
(e) Rule 99.
(f) Sect. 49.
(g) Sect. 49.

The hearing by the Registrar.

the case.(a) Within seven days of the receipt of such notice each party must give notice that he intends to appear. (Form T.M. No. 9.) Upon the appointed day the Registrar hears the case in the ordinary way, but the grounds of opposition are limited to those stated in the notice of opposition. The Registrar, however, has power to amend the notice of opposition upon an application to him to do so. After hearing the parties the Registrar decides whether the registration shall be refused or accepted, and if accepted, upon what conditions. The Registrar's decision is usually notified to the parties in writing.

An appeal lies to the Board of Trade

The decision of the Registrar is subject to an appeal to the Court or, with the consent of the parties, to the Board of Trade. An appeal to the Board of Trade is made in the manner prescribed by Rules 122 to 127.

or to the Court.

An appeal to the Court is made by motion to the Chancery Division of the High Court of Justice.(b) The notice of motion should be an originating one, and should be brought to the writ department of the central office and assigned to one of the judges. Such motions commence upon the day they are assigned, and affidavits sworn prior to such assignment are premature. Prior to this Act, the usual practice was to make the statutory declarations evidence by verifying them by affidavit. But quære whether this verification is now necessary having in view the provisions of section 49 of this Act.

Evidence on appeal.

It is usual to allow further evidence by affidavit and, if cross-examination is desired, to put the motion in the witness list.

New grounds of objection.

No further grounds of objection are allowed to be taken other than those stated in the notice of opposition except by leave of the Court. Where any further grounds of objection are taken, the applicant is entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

After hearing the appeal, the Court decides either to refuse registration or to allow registration, subject to conditions or otherwise. Under sub-section 9 the Court may allow the trade mark to be modified in any manner not substantially affecting its identity; but in such case the mark as so modified

(a) Rule 59.
(b) Rule 121.

must be advertised in the prescribed manner before being registered.(a)

As to costs of proceedings before the Registrar and the Board of Trade *see* section 14 (10). Costs of proceedings.

As to costs generally *see* notes under section 48.

As to security for costs *see* section 14 (11) and rule 60.

As to fees *see* schedule 2 to the Rules.

15. If a trade mark contains parts not separately registered by the proprietor as trade marks, or if it contains matter common to the trade or otherwise of a non-distinctive character, the Registrar or the Board of Trade or the Court, in deciding whether such trade mark shall be entered or shall remain upon the register, may require, as a condition of its being upon the register, that the proprietor shall disclaim any right to the exclusive use of any part or parts of such trade mark, or of all or any portion of such matter, to the exclusive use of which they hold him not to be entitled, or that he shall make such other disclaimer as they may consider needful for the purpose of defining his rights under such registration: Provided always that no disclaimer upon the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made. Disclaimers.

A trade mark must contain one of the essential particulars set out in the first five sub-sections of section 9, or in the case of an old mark, must have been used as a trade mark prior to the 13th day of August, 1875. A trade mark, however, is not restricted to essential particulars alone, but may be combined with other elements, such as the name of the Marks combined with other elements.

(a) Compare section 34.

manufacturer, or a statement referring to the character or quality of the goods, or a word or mark common to trade. In practice many trade marks consist of an essential particular, combined with other elements, as stated above. Manufacturers prefer that their mark should appear in the *Trade Marks Journal* and the register as a whole, and as they intend to use it.

Registrar's discretion as to added matter.

This section provides for the disclaimer by the applicant of such part of the added matter—*i.e.* the matter not being an essential particular—as the Registrar thinks fit. In other words, the section vests in the Registrar a discretion as to what part of such added matter ought to be disclaimed, and enables him to insist upon such a disclaimer by making it a condition precedent to registration. Where a mark is on the register, and the Registrar considers that the proprietor ought to make a disclaimer in respect of some part of it, the Registrar may call upon the proprietor to make the requisite disclaimer. But it is not clear in what manner the Registrar can enforce his views in the event of the proprietor refusing to make the disclaimer.

The Registrar may insist upon a disclaimer in either of the following cases, viz.:—

Distinctive matter not separately registered.

(1) If a trade mark contains parts not separately registered as trade marks. Thus, where a trade mark to be registered consists of an essential particular, combined with a device not separately registered as a trade mark, the Registrar can insist upon the device being disclaimed.(a) If the added matter is distinctive it may be capable of separate registration, but unless it is so registered the Registrar can insist upon its disclaimer. Consequently the Registrar may order the disclaimer of distinctive words, or words intended to be distinctive, such as "Silverpan,"(b) "Herbalin"(c) or "Washerine."(d)

Applicant's name.

It is thought that the Registrar will not insist upon a disclaimer by the applicant of his own name so long as it is used fairly and *bonâ fide* as representing the owner of the mark, *e.g.* Colman's mustard.(e)

(a) *Re* König and Ebhardt's Tm., 1896, 2 Ch. 236.
(b) Faulder's Tm., 18 P. R. 37.
(c) Humphries *v.* Taylor, 59 L. T. 820.
(d) Burland *v.* Broxburn Oil Coy., 42, C.D. 274.
(e) Colman's Tm., 1894, 2 Ch. 115.

(2) If a trade mark contains matter common to the trade or otherwise of a non-distinctive character. Matter common to the trade is matter open to anyone in the trade to use, and actually used, at the date of application, by more than three persons,[a] such user being in the United Kingdom.[b] Non-distinctive matter.

Non-distinctive matter is matter not adapted to distinguish the goods of the proprietor of the trade mark from those of other persons.[c] Such matter would not be registrable as a trade mark under the first five sub-sections of section 9.

The Registrar may insist upon a disclaimer of all matter common to the trade or non-distinctive, *e.g.* the words "Royal Baking Powder"[d] and "Smokeless Powder,"[e] and it is thought that he will do so unless the words cannot possibly do harm. If the matter added is distinctive or intended to be so, the Registrar can insist upon a disclaimer under No. (1) *supra*, unless separately registered as a trade mark.

As regards old marks, the rule adopted under the repealed Acts was to insist upon their being registered and kept registered in exactly the same form in which they were used prior to the 13th August, 1875.[f] It is thought that this rule will be adhered to under this Act. Old marks.

16. When an application for registration of a trade mark has been accepted and has not been opposed, and the time for notice of opposition has expired, or having been opposed the opposition has been decided in favour of the applicant, the Registrar shall, unless the Board of Trade otherwise direct, register the said trade mark, and the trade mark, when registered, shall be registered as of the date of the application for registration, and such date shall be deemed for the purposes of this Act to be the date of registration. Date of registration.

(*a*) Burland *v.* Broxburn Oil Coy., 42 C.D. 274.
(*b*) Münch's Application, 50 L. T. 12.
(*c*) Section 9.
(*d*) Royal Baking Powder Coy's. Tm., 19 P. R. 261.
(*e*) Smokeless Powder Coy., Ltd., 1892, 1 Ch. 590.
(*f*) Henry Clay & Co's. Tm., 1892, 3 Ch. 549.

Certificate of registration.

17. On the registration of a trade mark the Registrar shall issue to the applicant a certificate in the prescribed form of the registration of such trade mark under the hand of the Registrar, and sealed with the seal of the Patent Office.

Under section 51 the certificate is *primâ facie* evidence of the entry having been made and of the contents thereof. (a)

Non-completion of registration.

18. Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in such notice.

Identical Trade Marks.

Identical marks.

19. Except by order of the Court or in the case of trade marks in use before the thirteenth day of August one thousand eight hundred and seventy-five, no trade mark shall be registered in respect of any goods or description of goods which is identical with one belonging to a different proprietor which is already on the register with respect to such goods or description of goods, or so nearly resembling such a trade mark as to be calculated to deceive.

Old marks.

The registration of identical or similar old marks, *i.e.* trade marks in use prior to the 13th day of August, 1875, is regulated by what is known as the Three Mark Rule. That rule may be stated thus: Applicants for the registration of identical or similar old marks will be registered up to the number of three, but no more. If at any time it is proved

Three marks Rule.

(a) *See* Rule 67.

that more than three persons *bonâ fide* used the mark prior to the 13th August, 1875, then the mark is to be deemed common to the trade, and incapable of registration. This rule does not apply to new marks.

New marks.

As regards new marks, the intention of this section is to prevent the registration of any mark which so nearly resembles another mark as to be calculated to deceive.

Provisions to protect public.

The provisions of the section exist not merely for the benefit of owners of trade marks, who will be injured by the registration of marks similar or identical with their marks, but for the protection of the public.(a) Consequently registration ought not to be permitted unless the Court is satisfied that there is no reasonable probability of harm resulting.(a) The object of the section being to protect the public, it is in most cases immaterial whether the proprietor of the mark already on the register consents to the registration of a new mark or not.(b)

The question for the Court.

The question which the Court or Registrar has to determine is whether one mark so nearly resembles another mark as to be calculated to deceive. This is the most important question in trade mark cases, for it arises not only in deciding whether a mark should be registered under this section, but also (*a*) in deciding whether a mark is calculated to deceive under section 11, (*b*) in deciding whether a mark ought to be expunged from the register under section 35, and (*c*) in deciding all actions of infringement and passing off.

When the question arises under this section the onus is on the applicant of proving that there is no reasonable probability of deception.(c)

The degree of resemblance.

It is impossible to define what degree of resemblance is necessary between two marks. The question is a question of fact to be decided having regard to the circumstances of each particular case. Decided cases afford but little assistance. All that can be said is that the Court in deciding as to the resemblance between two marks will have regard to the following points, viz.:—

An ordinary purchaser.

(1) The Court will consider whether an ordinary purchaser purchasing with ordinary caution is likely to be misled by

(*a*) Ehrmann's Tm. 1897, 2 Ch. 495.
(*b*) Dewhurst's application, 1896, 2 Ch. 137.
(*c*) Eno *v.* Dunn, 15 App. Ca. 252.

the two marks.[a] It is not necessary that the resemblance should deceive persons who see the two marks side by side.[a] All that is necessary is that a person purchasing in the ordinary way, *i.e.* with merely a recollection of one of the marks, is likely to be deceived by the other mark.

The nature of the goods.

(2) The Court will consider the nature of the goods in respect of which the two marks are to be registered. The goods must have something in common between them, as there is nothing to prevent identical or similar marks being registered in respect of different classes of goods. The Court, however, is not bound by the classification of goods made by the Board of Trade under this Act. The Court will itself consider whether or not the goods in respect of which the marks are to be registered have in fact anything in common.[b] If the Court finds on the facts that the goods have in practice a connection, it will not permit the registration of the same or identical mark in respect of those goods. In one case the trade mark "Kodak" which had been registered in respect of photographic materials was refused registration in respect of bicyles.[b]

Mark to be considered as a whole.

(3) The Court will consider the trade mark as a whole, that is to say, the essential particulars of the mark as got up with other elements common to the trade. Of course there must be some resemblance between the essential particulars of the two marks. If the only resemblance between the two marks is in elements common to the trade, then they cannot so nearly resemble one another as to be calculated to deceive.[c] If, however, there is some resemblance between the essential particulars of the two marks, *e.g.* a buffalo and a bull's head, then those marks as combined with other things must be looked at, and if taken as a whole they resemble one another the registration of the new mark ought to be refused.[d]

Mark as actually used.

(4) The Court will consider the marks as they are actually used and not as they appear in the *Trade Marks Journal*.[e] All the circumstances, such as their size, colour, and the method in which they are affixed or stamped on goods, will be taken into consideration.[e]

(*a*) Seixo *v.* Provezende, L.R. 1 Ch. 192.
(*b*) Eastman's Co., Ltd., *v.* John Griffiths Cycle Co., 15 P. R. 105.
(*c*) Jamieson *v.* Jamieson, 15 P. R. 169.
(*d*) Farrow's Case, 7 P. R. 260.
(*e*) Rosing's application, 54 L. J. Ch. 975.

(5) The Court will consider the number of similar marks already on the register.[a] The more marks there are in existence nearly resembling each other, the more reason there is for not allowing an additional one. The number of similar marks.

(6) The Court will consider all the surrounding circumstances; for instance, that the marks are used or are likely to be used in different markets. Again, if the goods of a manufacturer have from the mark he has used become known by a particular name, a rival must not adopt a mark which will cause his goods to bear the same name.[b] All the surrounding circumstances.

The words below in the left-hand column were considered to so nearly resemble the words in the right-hand column as to be calculated to deceive:— Illustrations.

Apolonis[c]	Apollinaris.
Kokoko[d]	Coco.
Dunn's Fruit Salts[e] ...	Eno's Fruit Salts.
Ivy[f]	Ivory.
Savoline[g]	Savonol.
Securine[h]	Secotine.
Plasmonade[i]	Plasmon.

The words in the left-hand column were held *not* to so nearly resemble the words in the right-hand column as to be calculated to deceive:—

Oomoo[j]	Emu.
Emolliolorum[k]	Molliscorium.
Triticine[l]	Triticumina.

20. Where each of several persons claims to be proprietor of the same trade mark, or of nearly identical trade marks in respect of the same goods or description of goods, and to be registered as such proprietor, the Registrar may refuse to register any Rival claims to identical marks.

(*a*) Rosing's application, 54 L. J. Ch. 975.
(*b*) Seixo *v.* Provezende, L. R. 1 Ch. 192.
(*c*) Apollinaris Company *v.* Herrfeldt, 4 P. R. 478.
(*d*) Jackson's Tm., 6 P. R. 80.
(*e*) Eno *v.* Dunn, 15 App. Cas. 252.
(*f*) Goodwin *v.* Ivory Soap Coy., 17 P. R. 689.
(*g*) Field *v.* Wagel Syndicate, Ltd., 17 P. R. 266.
(*h*) McCaw *v.* Nickols, 21 P. R. 15.
(*i*) International Plasmon, Ltd., *v.* Plasmonade, Ltd., 22 P. R. 543.
(*j*) Burgoyne's Tm., 6 P. R. 227.
(*k*) Talbot's Tm., 11 P. R. 77.
(*l*) Meaby *v.* Triticine, Ltd., 15 P. R. 1.

of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or (on appeal) by the Board of Trade.

The Registrar's discretion.

This section confers upon the Registrar a discretion to refuse the registration of similar trade marks of two claimants until the rights of the claimants have been determined by the Courts or by an agreement approved by him.

The Registrar may, before exercising such discretion, require each claimant to attend before him and make explanations with respect to such matters as he may require. If the Registrar, after hearing the claimants refuses to register, the claimants must either have their rights determined by the Courts, or settle such rights by an agreement within the meaning of this section.

Determination of Rights by the Court.

In the event of the claimants deciding to go to the Court, the usual practice is for the Registrar to require one of the claimants to apply for directions as to the mode of trial, and the usual direction is for the applicant to apply by motion or summons.(a) Upon such motion or summons coming on, the Court either refuses registration or allows registration simply or subject to a condition.

By agreement.

Under the present section the claimants may settle the questions between them by an agreement. The agreement must be approved by the Registrar or (on appeal) by the Board of Trade. The Registrar will only approve of an agreement where the rights of the public are in his opinion sufficiently protected.(b)

Concurrent user.

21. In case of honest concurrent user or of other special circumstances which, in the opinion of the Court, make it proper so to do, the Court may permit the registration of the same trade mark, or of nearly identical trade marks, for the same goods or description of goods by more than one proprietor subject to

(a) *In re* Simpson, Davies & Sons' Tm., 15 C.D. 525.
(b) Dewhurst's application, 1896, 2 Ch. 137; and note under section 21.

such conditions and limitations, if any, as to mode or place of user or otherwise, as it may think it right to impose.

Concurrent user.

This section permits the registration of similar or identical trade marks in the case of honest concurrent user or of other special circumstances. In allowing the concurrent registration of two proprietors in respect of the same mark, the practice differs as regards old and new marks.

Old marks.

As regards old marks, *i.e.* marks used prior to the 13th August, 1875, the Three Marks Rule applies.(a) By that rule applicants may be registered up to the number of three in respect of the same old mark. But if more than three traders have *bonâ fide* used the mark prior to the 13th August, 1875, the mark cannot be registered at all, as it is then common to the trade. This rule does not apply to new marks.

New marks.

In deciding as to whether two new marks (similar or identical) shall be registered, the Court has regard not merely to the interests of the proprietors of the marks, but also to the interests of the public. The Court will not allow concurrent registrations except when it is satisfied that there is no reasonable probability of harm resulting to the public.(b) Consequently upon the dissolution of a partnership the Court will not allow the registration of the trade marks in the name of each of the partners.(c) This was so decided before the present Act, but it is thought the case is still good law under this section, as there is no concurrent user where a trade mark is owned by a firm, and an ordinary dissolution of partnership presents no special circumstances.

Use restricted to a particular place.

Under the Act of 1883 the Court considered that it had no power to direct the registration of a trade mark subject to a condition that it should be used only in a particular country.(d) Under this section the Court clearly has the power to impose such a condition, and it is thought that the power will be exercised, provided the concurrent registration is free from other objections.(e)

Mode of user restricted.

The Court also has power to impose conditions as to the mode of user of the mark. It is thought that the Court's

(a) *In re* Jelley, 51 L. J. Ch. 639n.
(b) *See* notes under section 19.
(c) Ehrmann's Tm., 1897, Ch. 495; *see* section 23.
(d) Dewhurst's application, 1896, 2 Ch. 137.
(e) *See* sections 11 and 19.

order will be carried out as heretofore by means of a note of the condition imposed being entered on the register.(a) In several cases a note has been entered on the register of an undertaking by the applicant to use the mark in a particular manner, *e.g.* "not in the same way as the mark is used by an opposing manufacturer,"(b) or "only in the manner the mark has heretofore been used" by the applicant.(c)

Restriction defined by agreement.

Sometimes the condition or limitation to be imposed upon the user of the mark is defined by an agreement between the respective owners in the manner contemplated by section 20. In such cases the Court will permit the registration of the mark subject to an entry upon the register of a note stating the condition or limitation, *e.g.* that the mark is only to be used upon goods exported to Australia.(d) An entry on the register of a note that the use of the mark is restricted by an agreement between the respective owners is irregular, as affording no information to the public as to the actual restriction on the user.(e)

If the two marks are calculated to deceive, the Court will not allow concurrent registration, even with the consent of the respective proprietors.(f)

Assignment.

Assignment and transmission of trade marks.

22. A trade mark when registered shall be assigned and transmitted only in connection with the goodwill of the business concerned in the goods for which it has been registered and shall be determinable with that goodwill. But nothing in this section contained shall be deemed to affect the right of the proprietor of a registered trade mark to assign the right to use the same in any British possession or protectorate or foreign country in connection with any goods for which it is registered

(a) *Re* Rabone Bros. & Co. Seb. Dig., 395.
(b) Whiteley's Tm., 43 L. T. 627.
(c) Sykes & Co.'s Tm., 43 L. T. 626.
(d) Keep's Tm., 26 C. D. 187.
(e) Mitchell & Coy.'s Tm., 28 C. D. 666.
(f) Dewhurst's application, 1896, 2 Ch. 137.

together with the goodwill of the business therein in such goods.

Assignment must be in connection with goodwill.

The proprietor of a registered trade mark has power to assign the same subject to any rights appearing on the register, and subject to equities (if any) in respect of the same.(a)

An assignment of a trade mark must be in connection with the goodwill of the business concerned in the goods for which it has been registered.

The goodwill.

A trade mark is part of the goodwill, and on the assignment of the goodwill the trade marks will pass, unless expressly excluded.(b)

A trade mark cannot be assigned in gross,(c) but an assignment in gross may be cured by a subsequent assignment of the goodwill.(d) The goodwill in connection with which the trade mark is assigned must exist,(e) and, as a rule, must exist in England,(f) but there is nothing to prevent (1) a proprietor of a registered trade mark from assigning the right to use the same abroad in connection with any goods for which it is registered, together with the goodwill of the business therein in such goods,(g) or (2) a proprietor of a registered trade mark used in one part of his business from assigning a trade mark in connection with the goodwill of that part of his business.(h)

Marks deceptive if used by assignee.

A trade mark which if used by an assignee would be deceptive cannot be assigned. Thus an assignment of a trade mark used in connection with a sauce made in accordance with a secret recipe is bad, if made to a person who does not know the secret recipe.(i) On the other hand, a trade mark consisting of the name of the original manufacturer may be assigned to a person of a different name.(j) Such marks in the course of time cease to denote the manufacturer of the goods, and become merely an indication of the quality of the goods.

(a) Section 38 and see rules 74 to 81.
(b) Shipwright *v.* Clements, 19 W. R. 599.
(c) Pinto *v.* Badman, 8 P. R. 181.
(d) Hammond & Coy. *v.* Malcolm Brunker & Co., 9 P. R. 301.
(e) Harness's Tm., 17 P. R. 40.
(f) Magnolia Coy's Tm., 1897, 2 Ch. 371, 395.
(g) Section 22.
(h) Edwards *v.* Dennis, 30 C. D. 454.
(i) Cotton *v.* Gillard, 44 L. J. Ch. 90.
(j) Leather Coy. *v.* American Leather Coy., 11 H. L. C. 523.

On dissolution of partnership.

A trade mark registered in the name of a firm is an asset of the firm, and saleable like any other assets. On the purchase by a surviving partner of the goodwill of the business, a trade mark should be valued on the footing that such surviving partner is entitled to set up the same description of business instead of purchasing.(a)

On a dissolution of partnership the partners cannot, even by mutual agreement, be registered as the proprietors of the same mark.(b) Trade marks may be apportioned between the partners under section 23.

Devolution of trade marks.

On the death of the registered proprietor of a trade mark, the trade mark devolves on his personal representatives.

On the bankruptcy of the registered proprietor of a trade mark, the trade mark devolves on his trustee.(c)

Assignments to be registered.

Assignments of trade marks ought to be registered under section 33. Registration of an assignment is not a condition precedent to bringing an action for infringement.(d)

On an assignment of a trade mark it may be necessary to alter the trade mark itself, in which case an application should be made under section 34.

Apportionment of marks on dissolution of partnership.

23. In any case where from any cause, whether by reason of dissolution of partnership or otherwise, a person ceases to carry on business, and the goodwill of such person does not pass to one successor but is divided, the Registrar may (subject to the provisions of this Act as to associated trade marks), on the application of the parties interested, permit an apportionment of the registered trade marks of the person among the persons in fact continuing the business, subject to such conditions and modifications, if any, as he may think necessary in the public interest. Any decision of the Registrar under this section shall be subject to appeal to the Board of Trade.

(a) Hall *v.* Barrows, 32 L. J. Ch. 548 ; 33 L. J. Ch. 204.
(b) Ehrmann's application, 1897, 2 Ch. 495.
(c) Hammond *v.* Malcolm, Brunker & Co., 9 P. R. 301.
(d) Ihlee *v.* Hensbaw, 31 C. D. 323.

Apportionment of trade marks.

This section confers upon the Registrar a discretion as to allowing the apportionment of trade marks where the goodwill of a business becomes vested in different persons.(a) It is thought that the Registrar will allow such apportionment, provided he is satisfied that there is no reasonable probability of the public being deceived. This section does not authorize the Registrar to register two persons as the proprietors of the same mark. Where two persons claim to be entitled to the same mark, sections 20 and 21 apply.

Associated trade marks can only be assigned as a whole.(b)

As to assignments generally and dissolution of partnership, *see* notes under section 22.

Associated Trade Marks.

Associated trade marks.

24. If application be made for the registration of a trade mark so closely resembling a trade mark of the applicant already on the register for the same goods or description of goods as to be calculated to deceive or cause confusion if used by a person other than the applicant, the tribunal hearing the application may require as a condition of registration that such trade marks shall be entered on the register as associated trade marks.

Sections 24 to 27 inclusive relate to associated trade marks, or marks registered or registrable as a series.

This section applies to the case where the two marks to be registered so closely resemble one another as to be calculated to deceive or cause confusion.(c) In such a case the Registrar can insist upon the applicant registering the two marks as associated trade marks.

Associated trade marks are only assignable as a whole, and not separately.(d)

Section 25 enables the proprietor of a trade mark to register any portion of his mark separately, provided that the

(a) See Rules 87 to 89.
(b) Section 27.
(c) As to this, *see* note under section 19.
(d) Section 27.

portion separately registered satisfies all the conditions of an ordinary trade mark.

Section 26 enables the proprietor of various marks to register them as associated trade marks.

Combined trade marks.

25. If the proprietor of a trade mark claims to be entitled to the exclusive use of any portion of such trade mark separately he may apply to register the same as separate trade marks. Each such separate trade mark must satisfy all the conditions and shall have all the incidents of an independent trade mark, except that when registered it and the trade mark of which it forms a part shall be deemed to be associated trade marks and shall be entered on the register as such, but the user of the whole trade mark shall for the purposes of this Act be deemed to be also a user of such registered trade marks belonging to the same proprietor as it contains.

This section applies to a trade mark which is capable of being split up into separate and independent trade marks. In such a case the proprietor can under this section register a portion of the mark separately. The portion separately registered must satisfy all the conditions and have all the incidents of an independent trade mark.(a)

Series of trade marks.

26. When a person claiming to be the proprietor of several trade marks for the same description of goods which, while resembling each other in the material particulars thereof, yet differ in respect of—

(a) statements of the goods for which they are respectively used or proposed to be used; or

(a) *See* note to section 8.

(*b*) statements of number, price, quality, or names of places; or

(*c*) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or

(*d*) colour;

seeks to register such trade marks, they may be registered as a series in one registration. All the trade marks in a series of trade marks so registered shall be deemed to be, and shall be registered as, associated trade marks.

This section enables a person claiming to be proprietor of several trade marks for the same description of goods to register them as a series in one registration.(*a*) Trade marks registered in a series are assignable as a whole and not separately.

Assignment and user of associated trade marks.

27. Associated trade marks shall be assignable or transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade marks. Provided that where under the provisions of this Act user of a registered trade mark is required to be proved for any purpose, the tribunal may if and so far as it shall think right accept user of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for such user.

Associated trade marks under this section are assignable and transmissible only as a whole and not separately. Such assignment and transmission must be in connection with the goodwill of the business concerned in the goods for which the associated trade marks have been registered.(*b*)

(*a*) See Rules 27 and 65.
(*b*) Section 22.

Renewal of Registration.

Duration of registration.

28. The registration of a trade mark shall be for a period of fourteen years, but may be renewed from time to time in accordance with the provisions of this Act.

Sections 28 to 31 inclusive regulate the procedure in respect of the renewal of trade marks.(a)

This section makes the original registration of a trade mark good for a period of 14 years, and provides for the renewal of the same from time to time in accordance with sections 29 and 30 of this Act.

Renewal of registration.

Under section 29 the registration of a trade mark may be renewed for a period of 14 years from the expiration of the original registration, or of the last renewal of the registration, upon an application for that purpose made by the proprietor of the trade mark in the prescribed manner.

Section 30 regulates the procedure to be adopted by the Registrar on the expiry of the period of registration, and invests the Registrar with the power to remove a trade mark from the register if the registration of the same is not properly renewed in accordance with the provisions of this Act.

Status of unrenewed mark.

Section 31 defines the status of an unrenewed trade mark. An unrenewed trade mark for the purpose of any application for registration during one year next after the date of its removal from the register is to be deemed a trade mark already registered. This presumption, however, may be rebutted on proof that there has been no *bonâ fide* trade user of such mark during the two years immediately preceding its removal from the register.

Renewal of registration.

29. The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of such trade mark for a period of fourteen years from the expiration of the original registration or of the last renewal of registration, as

(a) *See* Rules 68 to 75.

the case may be, which date is herein termed "the expiration of the last registration."

Procedure on expiry of period of registration.

30. At the prescribed time before the expiration of the last registration of a trade mark, the Registrar shall send notice in the prescribed manner to the registered proprietor at his registered address of the date at which the existing registration will expire and the conditions as to payment of fees and otherwise upon which a renewal of such registration may be obtained, and if at the expiration of the time prescribed in that behalf such conditions have not been duly complied with, the Registrar may remove such trade mark from the register, subject to such conditions (if any) as to its restoration to the register as may be prescribed.

Status of unrenewed trade mark.

31. Where a trade mark has been removed from the register for nonpayment of the fee for renewal, such trade mark shall, nevertheless, for the purpose of any application for registration during one year next after the date of such removal, be deemed to be a trade mark which is already registered, unless it is shown to the satisfaction of the Registrar that there had been no *bonâ fide* trade user of such trade mark during the two years immediately preceding such removal.

Correction and Rectification of the Register.

Correction of register.

32. The Registrar may, on request made in the prescribed manner by the registered proprietor or by some person entitled by law to act in his name,—

(1) Correct any error in the name or address of

the registered proprietor of a trade mark; or

(2) Enter any change in the name or address of the person who is registered as proprietor of a trade mark; or

(3) Cancel the entry of a trade mark on the register; or

(4) Strike out any goods or classes of goods from those for which a trade mark is registered; or

(5) Enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of such trade mark.

Any decision of the Registrar under this section shall be subject to appeal to the Board of Trade.

The object of section.

This and the following sections are framed with the object of keeping the register a perfect record, complete up to date, of trade marks and of the names and addresses of their proprietors. The governing section is section 35, which enables any person aggrieved to apply to the Court for rectification of the register, and in a proper case to obtain an order for such rectification against the wishes and in spite of the opposition of the proprietor.

Where no dispute.

This section and sections 33 and 34 are merely ancillary, and enable the register to be rectified in cases in which there is no dispute. Under each of these sections the application is made by the proprietor himself, and the only opponent to the application is the Registrar. If, as is generally the case, the Registrar sees no objection to the application, the necessary rectification is made as of course.

Jurisdiction of Registrar.

Under this section the Registrar can on the application of the proprietor rectify the register in any of the ways mentioned in the five sub-sections. The first two sub-sections apply to clerical errors arising in inserting the names or

addresses of registered proprietors upon the register, and to cases where the proprietor has changed his or her name or address. Jurisdiction of Registrar.

The last three sub-sections are intended to save applications under section 35. For instance, where a proprietor desires either to abandon his mark altogether or to limit it to certain goods, or to disclaim certain parts of it, he can now do so without incurring the expense of an application under section 35. A proprietor may desire to do any of the above things, either because he feels that he cannot defend his mark or because he has entered into an agreement with other traders. Moreover upon a dissolution of partnership an application by the partners under this section may be necessary.

An application must be made in the prescribed manner.(a)

33. Subject to the provisions of this Act where a person becomes entitled to a registered trade mark by assignment, transmission, or other operation of law, the Registrar shall, on request made in the prescribed manner, and on proof of title to his satisfaction, cause the name and address of such person to be entered on the register as proprietor of the trade mark. Any decision of the Registrar under this section shall be subject to appeal to the Court or, with the consent of the parties, to the Board of Trade. Registration of assignments, &c.

As to assignments generally, see note under section 22.

Where a person becomes entitled to a registered trade mark by assignment, transmission or other operation of law, he should send a written request to the Registrar for the entry of his name in the register as proprietor.(b) Such request should be signed by the applicant, or in the case of a firm by a partner, or in either case by a duly authorized agent. A company may sign by its secretary or other principal officer. The request should state the name, address and description of the claimant, and the particulars of the assignment, transmission or other operation of law, and should show Application: how made.

(a) *See* rules 90 to 92, Appendix A.
(b) *See* rules 76 to 81; as to joint application, *see* rule 76.

that the trade mark has been assigned and transmitted in connection with the goodwill of a business concerned in the particular goods for which the mark has been registered.(a) The statement contained in the request should be verified by a statutory declaration. The statutory declaration should state that the particulars set out in the request comprise every material fact and document affecting the proprietorship of the trade mark.(a)

Instances.

An instance of an assignment arises upon the sale of a business as a going concern, of a transmission upon the death of the registered proprietor, and of a devolution by operation of law upon a limited company changing its name as provided by the Companies Acts.(b)

Appeal.

In the event of the Registrar's refusal to enter the name and address of the claimant upon the register, the claimant may appeal to the Court, or with the consent of the parties, to the Board of Trade.

Alteration of registered trade mark.

34. The registered proprietor of any trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter such trade mark in any manner not substantially affecting the identity of the same, and the Registrar may refuse such leave or may grant the same on such terms as he may think fit, but any such refusal or conditional permission shall be subject to appeal to the Board of Trade. If leave be granted, the trade mark as altered shall be advertised in the prescribed manner.

Sections 32 and 33 deal with alterations to the entry in the register. This section is confined to alterations in the trade mark itself.

Alterations which will not be allowed.

The applicant is the registered proprietor of the mark. The power conferred upon the Registrar is to allow the applicant to add to or alter his mark in any way not substantially affecting the same. The Registrar will not allow additions or alterations which would in effect amount

(a) *See* rules 76 to 81, Appendix A.
(b) New Ormonde Cycle Coy.'s Tm. 1896, 2 Ch. 520.

to the registration of a new mark.(a) New marks can only be registered by following the procedure laid down by sections 12, 13 and 14. Moreover, no alteration or addition will be allowed which would prejudicially affect the trade marks of other people, *e.g.* by making the trade mark in question similar or identical with the trade mark of another person,(b) or which would bring the trade mark within the restrictions on registration imposed by this Act, *e.g.* by rendering the trade mark in question deceptive.(c)

Non-essential particulars.

All the essential particulars of the trade mark must remain, but alterations or additions of non-essential particulars will be allowed. For instance, changes in the names of the owners or their addresses may be altered,(d) and non-essential words omitted.(e)

Old marks.

It is more difficult to obtain leave to alter an old mark, because it is the policy of the Trade Mark Acts to keep such marks registered as they were used prior to August, 1875.(f) Alterations, although only allowed in special circumstances, have in some instances been made, *e.g.* the words in a trade mark "Maw & Thompson" were altered by striking out "Thompson" and substituting "and Sons"(g); and the words in a trade mark "Guinness & Co." were altered by the addition of the word "Limited.(h) But leave to alter old marks by striking out the word "trade mark" (i) or "patent" (j) has been refused.

Applications under section.

An application under this section should be made in manner prescribed by the rules,(k) and the Registrar may either refuse such application or permit it upon such terms as he thinks fit. An appeal lies from such refusal or conditional permission to the Board of Trade. The Board of Trade may refer such appeal to the Court under section 59.

Rectification of register.

35. Subject to the provisions of this Act—

(1) The Court may on the application in the

(a) Rivière's Tm., 55 L. J. Ch. 545.
(b) Reiss's Tm., 5 P. R. 291; and *see* sections 19, 20 and 21.
(c) Section 11.
(d) Stockowners Meat Coy. of New South Wales, 14 P. R. 733; Holbrook's mark, 18 P. R. 447; Davonport's Tm., 21 P. R. 726.
(e) Burke's Tm. 1891, W. N. 2.
(f) Henry Clay's Tm. 1892, 3 Ch. 549.
(g) Maw's Tm., 19 P. R. 260.
(h) Guinness & Coy.'s. Tm., 5 P. R. 316.
(i) Philip's Tm. 1891, 3 Ch. 139
(j) Adams's Tm., 9 P. R. 174. (k) Rules 93, 94, Appendix A.

prescribed manner of any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, make such order for making, expunging, or varying such entry, as it may think fit :

(2) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register :

(3) In case of fraud in the registration or transmission of a registered trade mark, the Registrar may himself apply to the Court under the provisions of this section :

(4) Any order of the Court rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

The object of section.

The object of this and the previous sections is to make the register a perfect register, complete up to date. Under the previous sections, viz. sections 32, 33 and 34, the application to rectify, correct or alter the register is made by the proprietor of the mark himself. Under this section the application is made by any person aggrieved, and any such person may obtain an order for rectification, even in the face of the opposition of the registered proprietor.

"Person aggrieved."

The intention of the section in requiring an applicant for rectification to be a "person aggrieved" is only to prevent

the interference of common informers, or of persons actuated by merely sentimental or fanciful notions,(a) and not to require evidence of serious damage.(b)

"Person aggrieved."

Persons aggrieved are persons who in some way or other are interested in having a mark removed from the register, or persons who would be damaged if a mark remained. Consequently any of the following persons are persons aggrieved, viz.:—

(1) Any person who is in the same trade as the person who has wrongfully registered a mark, and who desires to deal in the goods covered by the wrongful registration.(c)

(2) Any person excluded by the wrongful registration from a portion of the trade into which he desires to enter, or is hampered or prejudiced by such wrongful registration.(c)

(3) Any person sued for infringement of the trade mark in question.(d)

(4) Any person charged with "passing off" the goods in respect of which the trade mark is registered.(d)

(5) A foreigner, although not carrying on business in this country,(e) may be a person aggrieved.

In case of fraud in the registration or transmission of a mark, the Registrar may himself apply for rectification.

A person whose application to register a trade mark has been refused under section 12 is not a person aggrieved within the meaning of this section.(f) His proper remedy is to appeal under sub-section (3) of section 12.

An assignee of a trade mark who has been refused registration under section 33 should appeal to the Court or the Board of Trade as provided by that section.(g)

The power of the Court.

The power conferred upon the Court by this section is to "make, expunge or vary an entry on the register."

(1) Making an entry.

(1) The Court may order an entry to be made. This power does not authorize the Court to place upon the Register a new mark.(h) The registration of a new mark can only be

(a) As an instance of fanciful injuries, *see* Wright, Crossley & Co., 15 P. R. 131, 377 (1898), and Ellis & Coy.'s Tm., 21 P. R. 617.
(b) Apollinaris Coy.'s Tm. 1891, 2 Ch. 186.
(c) Apollinaris Coy.'s Tm. 1891, 2 Ch. 186; *in re* Powell's case, 1893, 2 Ch. 388.
(d) Gianacli's Tm., 6 P. R. 467.
(e) Rivière & Coy.'s, 26 Ch. D. 48.
(f) *In re* Trade Mark "Normal," 35 Ch. D. 231.
(g) Compare New Ormonde Cycle Coy.'s Tm. 1896, 2 Ch. 520.
(h) Rivière's Tm., 55 L. J. Ch. 545.

properly effected by following the procedure laid down in sections 12, 13 and 14.

The Court, however, may order an entry to be made upon the register which does not materially alter the mark. For instance, the Court may order the entry upon the register of a disclaimer by the proprietor of the mark of some part of the mark, *e.g.* a disclaimer of words common to the trade.(*a*) Or again, the Court may order the entry on the register of a note limiting the use of the mark either to particular goods,(*b*) or to a particular area.(*c*)

(2) Expunging an entry.

(2) The Court may order a mark to be expunged from the register. Any mark may be expunged which is on the register "without sufficient cause." A mark is on the register without sufficient cause if (*a*) the proprietor is a person incapable of being registered (section 12, 1); (*b*) the mark is not a registrable mark (section 8); (*c*) the mark is calculated to deceive (section 11); (*d*) the mark is identical with another mark (sections 19, 20 and 21); (*e*) the mark is not *bonâ fide* used as a trade mark within the meaning of section 37; (*f*) the registration was obtained by a misstatement of material facts; and (*g*) the registration is not renewed in accordance with the provisions of sections 28, 29 and 30.

(3) Varying an entry.

(3) The Court may order the register to be varied. This may be done either by the entry of a disclaimer, &c., as mentioned under No. 1, *supra*, or by an actual alteration of what is entered upon the register; for instance, by altering the date of registration,(*d*) or the name of the proprietor.(*e*) In the case of the alteration of the name of the proprietor, the proper course generally is to apply under sections 31 and 32.(*f*)

Registration under former Acts.

In all applications under this section the effect of sections 36, 40 and 41 must be borne in mind. Under section 36 the proprietor of a trade mark registered prior to the commencement of this Act is entitled to retain his mark on the register if he can prove that its registration is valid under the previous Acts or under this Act.

(*a*) Edge's Tm., 8 P. R., 207, and *see* cases under section 15.
(*b*) Edwards *v.* Dennis, 30 Ch. D. 454; Anglo-Swiss Condensed Milk Coy. *v.* Metcalf, 31 Ch. D. 454; Banks and James' Tm., 12 P. R. 333.
(*c*) Mitchell & Co.'s Tm., 28 Ch. D. 666.; *see* notes under section 21.
(*d*) Hayward's case, 54 L. J. Ch. 1003.
(*e*) Plumbago Crucible Coy.'s Tm., 7 P. R. 282.
(*f*) Compare New Ormonde Cycle Coy.'s Tm., 1896, 2 Ch. 520.

Registration, *primâ facie* evidence.

By section 40 the fact that a person is registered as proprietor of a trade mark is *primâ facie* evidence of the validity of the original registration. Consequently, in all applications under section 35 to expunge an entry, the onus is on the person aggrieved to show that the entry is on the register without sufficient cause.

Registration conclusive evidence when?

By section 41 a trade mark which has been registered for the time prescribed by that section is to be deemed valid in all respects, unless such registration was obtained by fraud, or unless the trade mark offends against the provisions of section 11. It would therefore appear that upon an application under this section, in all cases where the trade mark has been registered for the time prescribed by section 41, the person aggrieved is limited to these two objections, and is not entitled to rely on any other grounds, *e.g.* that the mark is not a registrable mark under the Act. But it is thought that objections to a mark which arise subsequently to the date of the original registration may be taken by the person aggrieved, *e.g.* that the registered proprietor has not used the mark, or that the rights of the proprietor have been determined by severance from the goodwill of a business, or by abandonment.

Application, how made.

The procedure to be adopted by the person aggrieved is to apply to the Chancery Division of the High Court of Justice.(a) The application is usually made by notice of motion. The right to rectification should not be raised by counterclaim in an action for infringement or passing off.

The order of the Court rectifying the register must be served on the Registrar in the prescribed manner. (b)

The respondent.

The registered proprietor of the trade mark if within the jurisdiction should be made a respondent to the motion. (c) In the case of a person outside the jurisdiction of the Court, the proper course is to give him notice of the application. If such person appears and opposes the application, he may be liable for costs; if he does not appear, the Court has jurisdiction under this section to rectify the register notwithstanding his absence. (c)

The evidence.

The question raised by the motion will be tried in the usual way, either upon affidavit or *viva voce* evidence, as

(a) As to the meaning of the word Court, *see* section 3 and note.
(b) *See* Rule 129, Appendix A.
(c) King & Coy.'s Tm., 1892, 2 Ch. 462.

the judge directs. Generally speaking, the statutory affidavits used upon the application for registration may be put in evidence by either party. (a)

The costs.

The usual rules as to costs apply. (b) A foreigner whose registered trade mark is in question may appear and oppose an application to rectify it without giving security for costs; (c) but if he appeals from an order, he may have to give security. (c)

Trade marks registered under previous Acts.

36. No trade mark which is upon the register at the commencement of this Act and which under this Act is a registrable trade mark shall be removed from the register on the ground that it was not registrable under the Acts in force at the date of its registration. But nothing in this section contained shall subject any person to any liability in respect of any act or thing done before the commencement of this Act to which he would not have been subject under the Acts then in force.

The intention of this section is to give marks already upon the register the benefit not only of the Acts under which the same were registered, but also of this Act. Thus a mark not registrable under the Acts in force at the date of its registration, will not be removed from the register if its registration can be justified under this Act. On the other hand, if the mark was validly registered under the previous Acts, then nothing in this Act is to render such registration invalid. (d)

Non-user of trade mark.

37. A registered trade mark may, on the application to the court of any person aggrieved, be taken off the register in respect of any of the goods for which it is registered, on the ground that it was registered by the proprietor or a predecessor in title without any bonâ fide intention to use the same in

(a) Thewlis and Blakey's Tm., 10 P. R. 373.
(b) *See* notes under section 48.
(c) La Société Anonyme, &c., Tm., 10 P. R. 290; 11 P. R. 142.
(d) Compare Apollinaris Coy.'s Tm., 1891, 2 Ch. 201.

connection with such goods, and there has in fact been no bonâ fide user of the same in connection therewith, or on the ground that there has been no bonâ fide user of such trade mark in connection with such goods during the five years immediately preceding the application, unless in either case such non-user is shown to be due to special circumstances in the trade, and not to any intention not to use or to abandon such trade mark in respect of such goods.

Registration without any intention of using.

A trader cannot properly register a trade mark for goods in which he does not deal or in which he has not at the time of registration some definite or present intention of dealing. Consequently where there has been no real user of a trade mark before or since its registration and it has been registered in a particular class, without any *bonâ fide* intention to use it in that class, it may be expunged under this section.(a) Moreover, if a trade mark is registered in respect of an entire class and is used in respect of part only of the goods in that class, the mark will be limited to those goods in respect of which it has been actually used.(b)

Non-user after registration.

Even where the mark has been in the first instance properly registered, it will be removed if there is no *bonâ fide* user of the mark in connection with the goods for five years. However, in order to deprive a manufacturer of his right to a trade mark the use of which has been given up for a period of five years, mere discontinuance of user owing to the lack of demand for the goods is not enough;(c) there must be evidence of distinct abandonment.(c)

Effect of Registration.

Powers of registered proprietor.

38. Subject to the provisions of this Act—

(1) The person for the time being entered in the register as proprietor of a trade mark shall, subject to any rights appearing

(a) Batt's Tm., 1898, 2 Ch. 432; 1899, A.C. 428; *see* notes under section 8 at p. 8.
(b) Edwards *v.* Dennis, 30 Ch. D. 454; *see* notes under section 8 at p. 8.
(c) Mouson & Co. *v.* Boehm, 26 Ch. D. 398, Hedley's Tm., 17 P. R. 719.

from such register to be vested in any other person, have power to assign the same, and to give effectual receipts for any consideration for such assignment:

(2) Any equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

As to the assignment of trade marks, *see* notes under section 22.

This section preserves any equities which may attach to the trade mark as between the proprietor or his assignee and third parties. By section 5 it is provided that notice of a trust shall not be entered on the register.

Rights of proprietor of trade mark.

39. Subject to the provisions of section forty-one of this Act and to any limitations and conditions entered upon the register, the registration of a person as proprietor of a trade mark shall, if valid, give to such person the exclusive right to the use of such trade mark upon or in connection with the goods in respect of which it is registered: Provided always that where two or more persons are registered proprietors of the same (or substantially the same) trade mark in respect of the same goods no rights of exclusive user of such trade mark shall (except so far as their respective rights shall have been defined by the Court) be acquired by any one of such persons as against any other by the registration thereof, but each of such persons shall otherwise have the same rights as if he were the sole registered proprietor thereof.

The section gives an exclusive right to use.

This section defines the right given by registration, viz. it confers on the registered proprietor the exclusive right to the use of the trade mark upon or in connection with the goods in respect of which it is registered. This right is

subject to the limitations and conditions entered on the register and to the concurrent right of other persons in the use of the mark. No prior user of the mark is necessary, but the registered proprietor must intend to use it.(a)

Enforceable. How?

The exclusive right of user conferred by this section can be enforced against persons contravening the right, either by an action for infringement arising out of this Statute or by an action at common law, commonly called a "passing-off" action. In cases of flagrant infringement the proprietor of the mark may prefer to take proceedings under the Merchandise Marks Act, 1887 (50 & 51 Vict. c. 28).

The action for infringement. Facts to be proved by plaintiff:

A person commencing an action to restrain an infringement of his trade mark should be in a position to allege and prove the following facts, viz.:—

(1) That he is owner.

(1) That he is the owner of the trade mark. Clearly if the plaintiff is not the owner he is not entitled to sue for an infringement. Thus an importer of goods made or produced abroad has no right to sue for the infringement of the trade marks belonging to the producers.(b) This section carefully preserves the rights of persons who have concurrent rights to use the same mark.(c) Such persons may enforce their rights against third persons either jointly or alone.

(2) That mark is registered.

(2) That the trade mark is registered. It is the registration that gives "the exclusive right to use" conferred by this section. Consequently registration is a condition precedent to an action for infringement, except in the case of an unregistered trade mark or in the case of an assignment. The owner of an unregistered trade mark, prior to commencing an action for infringement, should obtain a certificate that registration has been refused under section 42. An assignee of a registered trade mark may bring an action to prevent the use of the trade mark without having registered the assignment under section 33.(d)

How proved.

Registration of a trade mark is proved by the production of a certificate issued by the Registrar under section 17 (e), or by a certified copy of the register issued by the Registrar under section 50.

(a) *See* note to section 8.
(b) Apollinaris Coy.'s Tm. 1891, 2 Ch. 186.
(c) *See* sections 21 and 41.
(d) Compare Ihlee *v.* Henshaw, 31 Ch. D. 323.
(e) *See* section 51.

Registration *primâ facie* evidence.

By section 40 the fact that a person is registered proprietor of a trade mark is made *primâ facie* evidence of the validity of the original registration of such trade mark and of all subsequent assignments and transmissions of the same. Consequently upon a plaintiff in an action for infringement producing the certificate of registration, the onus of proving that the trade mark is invalid is thrown upon the defendant.

Conclusive evidence when?

By section 41 the original registration of a trade mark after the expiration of seven years from the date of such original registration (or seven years from the passing of this Act, whichever event happens last) is to be deemed valid in all respects unless such original registration was obtained by fraud, or unless the trade mark offends against the provisions of section 11. Even where the registration is obtained by fraud or where the mark offends against the provisions of section 11, the proper course is to apply under section 35 to expunge the mark from the register.(a) Possibly it would be a good defence to an action for infringement to prove that the registration of the plaintiff's trade mark was obtained by fraud. Subject to this, the effect of section 41, so far as an action for infringement is concerned, is to exclude in the case of a mark which has been on the register for the prescribed time all defences touching the validity of the original registration. Certain objections arising subsequently to the original registration may be taken, *e.g.* that the trade mark has become separated by assignment from the goodwill of a business,(b) or that the plaintiff's rights in the trade mark have been determined or abandoned.(c)

Restrictions on rights.

It should be noted that the plaintiff can only rely upon the registration as it actually exists, so that his rights are subject to all limitations, disclaimers and conditions entered on the register. His right to exclusive user of the mark is also limited by the concurrent rights of user existing in other people.(d)

(3) That mark has been copied.

(3) That the defendant has used the trade mark, or an essential part of it, or a colourable imitation of it. Where the defendant has used a mark identical with the plaintiff's registered mark, the case is clear, unless the defendant can prove a right to concurrent user. Where the defendant has

(a) Apollinaris Coy. *v.* Snook, 7 P. R. 474.
(b) Pinto *v.* Badman, 8 P. R. 181.
(c) *See* notes on page 9.
(d) *See* sections 39 and 41.

taken part only of the plaintiff's registered mark, the question is whether the part taken is a material and substantial part of the mark. If the part taken is a material and substantial part of the registered mark, the plaintiff will be entitled to an injunction, unless the defendant can prove that the mark he is using is not calculated to deceive.(a) It is not sufficient to prove that the defendant has taken non-distinctive parts of the registered mark or parts common to the trade.(b)

Colourable imitation.

Where the defendant has not copied the mark or part of it, but has made a colourable imitation of it, the question is whether the defendant's spurious mark so nearly resembles the registered mark as to be calculated to deceive. This is a question of fact in each case. If the spurious mark is calculated to deceive an ordinary buyer, then the plaintiff is entitled to restrain its use.(c)

Evidence of similarity.

It is not necessary for the plaintiff in any of the above cases to prove that the defendant was acting fraudulently,(d) or that anyone was in fact deceived.(e) It is enough for him to show that the spurious mark is so like his registered mark that the exclusive use given to him by this section is likely to be interfered with. In judging this question the Court will have rrgard to the same points as when judging whether two similar marks ought to be registered under section 19, and the cases mentioned in the note to that section are in point.(f)

Evidence of get-up and colour.

By section 43 the Court trying the question of infringement may admit evidence of the usages of the trade in respect to the get-up of the goods for which the mark is registered, and of any trade marks or get-up legitimately used in connection with such goods by other persons. It is thought that the Court will also take into consideration the fact that a registered trade mark is limited in use to one or more specified colours under section 10.

(4) that spurious is being used.

(4) That the defendant is using the spurious mark for trading purposes (g) in the United Kingdom,(h) and possibly in the market in which the plaintiff's goods circulate.(i)

(a) Orr Ewing & Co. *v.* Johnston & Co., 13 Ch. D. 434; 7 App. Cas. 219.
(b) Jamieson *v.* Jamieson, 15 P. R. 169.
(c) And *see* notes under section 19.
(d) Singer Coy. *v.* Wilson, 3 App. Cas. 376.
(e) Johnston & Co. *v.* Orr Ewing & Co., 7 App. Cas. 219.
(f) *See* pp. 38 to 41.
(g) Upmann *v.* Forester, 24 Ch. D. 231.
(h) Compare British Motor Syndicate, Ltd., *v.* Taylor & Son, 1900, 1 Ch. 577; 1901, 1 Ch. 122.
(i) Paine *v.* Daniell's Breweries, 1893, 2 Ch. 567.

(5) on the same class of goods.

(5) That the defendant is using the spurious mark upon or in connection with goods in respect of which the plaintiff's mark is registered and used. It is clear that a trade mark registered under one of the classes given by the rules, but in respect to some particular articles in that class, is protected as to those articles only,(a) and that registration of a trade mark for one class of goods does not entitle the registered proprietor to prevent another person from using the mark in connection with goods included in a different class.(b) It is also clear that the plaintiff must in fact use his trade mark upon the goods in respect of which his mark is registered.(c)

(6) that the goods are not the plaintiff's goods.

(6) That the goods upon which the defendant is placing the spurious mark are not the genuine goods of the plaintiff. Thus where a manufacturer sells to a dealer in bulk and without any restrictions as to its disposal, an article usually sold and used in small quantities, the dealer may call the article by the name registered by the manufacturer as his trade mark.(d)

The defendant is a person aggrieved.

A defendant sued for infringement of a registered trade mark is a person aggrieved within the meaning of section 35, and may apply under that section for the removal of the trade mark from the register. The Court cannot rectify the register upon a counterclaim set up by a defendant in an action for infringement.(e)

Defences open to defendant.

A defendant in an infringement action may defend the action by disproving any of the plaintiff's essential allegations, *e.g.* (1), (2), (3), (4), (5) or (6) set out above.

In addition to these defences the defendant may plead (1) that he is equally entitled with the plaintiff to use the trade mark.(f) If a defendant claims the mark in question as his own trade mark, he should apply in the usual way for registration ;(g) (2) that the plaintiff has consented to his use of the mark ; (3) that the plaintiff's rights in the mark have determined or been abandoned,(h) but mere delay not amounting to abandonment or acquiescence is not sufficient

(a) Jay *v.* Ladler, 40, Ch. D. 649.
(b) Hart *v.* Colley, 44 Ch. D. 193 ; and *see* notes under section 8 at p. 8.
(c) Edward *v.* Dennis, 30 Ch. D. 454.
(d) Condy *v.* Taylor, 56 L. T. 891.
(e) Pinto *v.* Badman, 8 P. R. 181.
(f) As to concurrent user, *see* sections 21, 39 and 41.
(g) Mouson *v.* Boehm, 26 C. D. 398.
(h) *See* section 37, and notes at p. 9.

and (4) that the plaintiff's mark is deceptive.(a) Thus where the article sold by the plaintiff is described as patented when it is not in fact patented,(b) or where the words "trade mark" are so used as to deceive people as to what the plaintiff's trade mark really is.(c)

The "passing off" action.

Independently of the action for infringement, the proprietor of a registered trade mark may sue any person for passing off his goods as the goods of such proprietor. A "passing off" action is founded on the common law, and although it has many points of resemblance with the statutory action for infringement, is in reality distinct. The foundation of the common law action is that a man has no right to put up his goods for sale as the goods of a rival trader, and he cannot be allowed to use names, marks, letters or other indicia by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person. This is the fundamental rule which governs all "passing off" actions whatever be the particular mode adopted by the defendant for selling his goods as the goods of the plaintiff, whether it is done by the use of a registered trade mark or in any other way.

In many passing off actions the gist of the matter lies in the fact that the defendant has copied or imitated a trade mark, but this is by no means the only way in which one trader may pass off his goods as those of a rival trader. For instance, the "passing off" may be effected by using the trade name of a rival or by copying his advertisements.

Adding claim to an action for infringement

Where, however, the passing off is effected either by copying the trade mark or part of it, or by using a colourable imitation of it, it is usual to add in every action for infringement a further claim for "passing off." The relief required, the evidence to be produced, and the questions to be tried, are of so similar a nature that little, if any, additional expense is involved in combining the two claims.

The advantage of so doing.

On the other hand the advantage in some cases is great, as the plaintiff may fail on the one claim yet succeed upon the other. A good illustration of this is to be found in the Stone ale case.(d) In that case the plaintiffs were brewers at

(a) *See* notes at p. 24.
(b) Cochrane *v.* MacNish, 1896, App. Ca. 225, and cases cited there.
(c) Dexter's Tm. 1893, 2 Ch. 262; and *see* notes at p. 25.
(d) Montgomery *v.* Thompson, 8 P. R. 361.

Stone, their brewery was called Stone Brewery, and their ales were known to the public as Stone ales. The plaintiffs had also registered the words "Stone Ales" as a trade mark. The defendants built a brewery at Stone and commenced to sell their beer as Stone ales. The plaintiffs brought an action claiming (1) an injunction to restrain the defendants from infringing the trade mark; and (2) an injunction to restrain the defendants from passing off their beer as the plaintiffs' beer. The defendants moved to expunge the trade mark "Stone Ales" from the register, upon the grounds that those words were not used alone prior to August, 1875. The defendants succeeded upon their motion to expunge, but an injunction was granted to restrain them from passing off their goods as the goods of the plaintiffs.

In a "passing off" action plaintiff relies on user.

The converse of this case also arises in practice, and in this way: In a "passing off" action the plaintiff does not rely upon the rights given by this Statute to a registered trade mark. The plaintiff in such an action relies upon the fact that he has used a certain name or mark on the article sold by him, and that in consequence of such user the article has become known to the public by that name or mark. In many cases a trader, who has properly registered a mark under this Act, is not in a position to prove at the date of his action that his goods have become known to the public by that mark. In such cases the trader must rely upon the rights given him by the Statute, and cannot rely upon the common law.

Action—how commenced.

In England[a] actions for infringement and passing off are usually commenced in the Chancery Division of the High Court, and in certain cases in the Palatine Chancery Court of Lancashire.

The relief claimed.

The relief usually asked is (1) for an injunction; (2) for delivery up and destruction of all goods bearing the spurious mark; and (3) for damages or (in the alternative) an account of the profits made by the defendant.

The certificate of validity.

In any action in which the validity of a registered trade mark comes into question and is decided in favour of the proprietor, the Court may certify the validity of the trade mark under section 46.

The costs.

As regards costs, *see* notes under section 48.

(*a*) *See* notes under section 3.

Registration to be primâ facie evidence of validity.

40. In all legal proceedings relating to a registered trade mark (including applications under section thirty-five of this Act) the fact that a person is registered as proprietor of such trade mark shall be primâ facie evidence of the validity of the original registration of such trade mark and of all subsequent assignments and transmissions of the same.

The object of this section is to facilitate the proof by the registered proprietor of a trade mark of his title, either by the production of the certificate of registration or by a certified copy of the register.(a) Upon the production by the proprietor of a trade mark of such evidence, the validity of the original registration is *primâ facie* established. It is, however, open to a defendant in an action for infringement or to a person aggrieved in an application under section 35 to rebut this evidence by showing that for some reason or other the original registration was in fact invalid.

Registration to be conclusive after seven years.

41. In all legal proceedings relating to a registered trade mark (including applications under section thirty-five of this Act) the original registration of such trade mark shall after the expiration of seven years from the date of such original registration (or seven years from the passing of this Act, whichever shall last happen) be taken to be valid in all respects unless such original registration was obtained by fraud, or unless the trade mark offends against the provisions of section eleven of this Act:

Provided that nothing in this Act shall entitle the proprietor of a registered trade mark to interfere with or restrain the user by any person of a similar trade mark upon or in connection with goods upon or in connection with which such person has, by himself or his predecessors in business, continuously

(a) *See* sections 17, 50 and 51.

used such trade mark from a date anterior to the user of the first-mentioned trade mark by the proprietor thereof or his predecessors in business, or to object (on such user being proved) to such person being put upon the register for such similar trade mark in respect of such goods under the provisions of section twenty-one of this Act.

The previous section.

This section is substituted for section 76 of the Act of 1883. That section was as follows :—

76. "The registration of a person as proprietor of a trade mark shall be *primâ facie* evidence of his right to the exclusive use of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of this Act."

It was decided under section 76 that in spite of the fact that a trade mark had been registered for five years a person aggrieved could move to expunge the entry on the ground that it was on the register without sufficient cause; in other words, the person aggrieved could attack the registration of the trade mark on every ground. The effect of this construction of the section was to render it of little value to the registered holder.

The effect of this section.

The effect of the present section (subject to the proviso at the end) is, it is thought, as follows :—

(1) On a motion to expunge an entry which has been on the register for the length of time prescribed by this section a person aggrieved is limited to showing either that such entry was obtained by fraud or that it offends against the provisions of section 11 of this Act. Objections to the mark which arise subsequently to the date of registration may probably be taken.(a)

(2) In an action for infringement, a trade mark which has been upon the register for the length of time prescribed by this section is to be deemed valid in all respects. If the defendant desires to show that the trade mark offends against the provisions of section 11, his proper course is to move under

(a) *See* p. 59.

section 35 to rectify the register. A defendant in an infringement action ought not to raise this point by way of counterclaim.(a)

It may be open to a defendant to raise the defence that the original registration of a trade mark was obtained by fraud, but probably even in this case the better course would be to apply by motion to rectify.

Concurrent rights.

Although registration for the time prescribed by this section confers rights upon the registered proprietor, it does not take away the rights of other persons. Consequently if a trader has continuously used a trade mark similar to that registered from a date anterior to the user of the registered mark, the rights of such trader remain unaffected, and he cannot be restrained from using the mark in the way in which he has been accustomed to use it. If such trader claims the mark as a trade mark, he should apply in the usual way for registration.(b)

Unregistered trade mark.

42. No person shall be entitled to institute any proceeding to prevent or to recover damages for the infringement of an unregistered trade mark unless such trade mark was in use before the thirteenth of August one thousand eight hundred and seventy-five, and has been refused registration under this Act. The Registrar may, on request, grant a certificate that such registration has been refused.

In the case of new marks, registration is a condition precedent to bringing an action for infringement.

Old marks, *i.e.* marks in use prior to the 13th August, 1875, must either be registered as trade marks or must have been refused registration.

This section does not apply to "passing off" actions.

Infringement.

43. In an action for the infringement of a trade mark the court trying the question of infringement shall admit evidence of the usages of the trade in respect to the get-up of the goods for which the

(a) Apollinaris Co. *v.* Snook, 7 P. R. 474.
(b) Mouson *v.* Boehm, 26 C. D. 398.

trade mark is registered, and of any trade marks or get-up legitimately used in connection with such goods by other persons.

Evidence of "get-up."

The question raised in an action for infringement is whether the defendant's mark so nearly resembles the plaintiff's registered mark as to be calculated to deceive.(a) In order to form an opinion as to this it is essential that the marks should be compared as they are actually used by the parties. Thus two marks, such as "a bull's head" and a "buffalo," quite distinguishable by themselves, may become deceptive when used in combination with a get-up common to the trade.(b)

This section enables either party to an action for infringement to call evidence as to the usage of a trade in respect to the get-up of the goods for which the mark is registered; for instance, as to the size and shape of the boxes or packages in which the goods are placed, and the colour or ornamentation of wrappers, &c.

User of name, address, or description of goods.

44. No registration under this Act shall interfere with any bonâ fide use by a person of his own name or place of business or that of any of his predecessors in business, or the use by any person of any bonâ fide description of the character or quality of his goods.

Use by a trader of his own name.

The Court will not prevent a person carrying on business in his own name in rivalry with another of the same name. There must be something more than that, viz., that the person who is carrying on business in his own name is doing it in such a way as to "pass off" his goods as the goods of the other. Of course no man can have the right to represent his goods as the goods of another person.(c)

Description of quality or character.

The same remarks apply to a *bonâ fide* description by a person of the quality or character of his goods. The use of the words of the English language are open to all, and any trader may use them, provided he does not represent his goods as the goods of another person.

(a) *See* notes under section 19 at pp. 38 to 41.
(b) Farrow's Tm. 7 P. R. 260; Jamieson *v.* Jamieson, 15 P. R. 169.
(c) *See* notes at pp. 13, 67.

"Passing off" action.

45. Nothing in this Act contained shall be deemed to affect rights of action against any person for passing off goods as those of another person or the remedies in respect thereof.

See notes under section 39 at p. 67.

Legal Proceedings.

Certificate of validity.

46. In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of such trade mark, the Court may certify the same, and if it so certifies then in any subsequent legal proceeding in which such validity comes into question the proprietor of the said trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges, and expenses as between solicitor and client, unless in such subsequent proceeding the Court certifies that he ought not to have the same.

Under the repealed section (viz., section 18 of the Act of 1888) a certificate of validity could only be given in an action for infringement.[a]

Granted in all proceedings.

Under this section the certificate can be given in any legal proceedings in which the validity of the registration of a registered trade mark comes into question. Consequently the certificate can now be given where the validity of a trade mark is questioned by a motion to rectify. No appeal lies against an order granting a certificate under this section.[b]

Must be pleaded.

In order to obtain an order for the payment of solicitor and client costs of an action, the certificate should have been granted prior to the issue of the writ,[c] and should be pleaded in the statement of claim.[d]

(*a*) B. Edgington, Ltd., *v.* John Edgington & Coy., 6 P. R. 513.
(*b*) Haslam Foundry Coy., Ltd., *v.* Hall, 20 Q. B. D. 491.
(*c*) Automatic Weighing Machine Coy. *v.* International Hygienic Society, 6 P. R. 475.
(*d*) Pneumatic Tyre Coy. *v.* Chisholm, 13 P. R. 488.

Registrar to have notice of proceeding for rectification.

47. In any legal proceeding in which the relief sought includes alteration or rectification of the register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court. Unless otherwise directed by the Court, the Registrar in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases, or of such other matters relevant to the issues, and within his knowledge as such Registrar, as he shall think fit, and such statement shall be deemed to form part of the evidence in the proceeding.

As to the Registrar's costs of appearing, *see* section 48.

Costs.

Costs of proceedings before the Court.

48. In all proceedings before the Court under this Act the costs of the Registrar shall be in the discretion of the Court, but the Registrar shall not be ordered to pay the costs of any other of the parties.

The Registrar's costs.

The Court has no jurisdiction to order the Registrar to pay the costs of any other of the parties. Where there is an appeal from the Registrar's decision, the general rule is to allow the Registrar his costs of appearing to oppose the appeal. And this is so whether the Registrar's opposition is successful or not.(a)

In exceptional cases, *e.g.* where the case is treated as a test case,(b) or where the opposition is unreasonable,(c) the Registrar may be deprived of costs.

(a) Rotherham's Tm. 14 C. D. 585.
(b) Van Duzer's Tm. 34 C. D. 623.
(c) Leaf's Tm. 33 C. D. 477.

The costs of other parties.

A question of costs arising between an applicant for registration and his opponent, or between plaintiff and defendant in proceedings before the Court, is governed by the general rule of the Courts.(a) The general rule is that the costs of all proceedings are in the discretion of the Court. An unsuccessful party usually has to pay the costs. A judge, however, if dissatisfied with the conduct of a successful party, may deprive him of the costs. Where both sides are partially successful it is usual to make no order as to costs.

As to the costs of proceedings before the Registrar, *see* section 14 (10).

Evidence.

Mode of giving evidence.

49. In any proceeding under this Act before the Board of Trade or the Registrar, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which it shall think it right so to do, the tribunal may (with the consent of the parties) take evidence vivâ voce in lieu of or in addition to evidence by declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

In case any part of the evidence is taken vivâ voce the Board of Trade or the Registrar shall in respect of requiring the attendance of witnesses and taking evidence on oath be in the same position in all respects as an Official Referee of the Supreme Court.

Declarations.

In proceedings before the Registrar or Board of Trade the evidence is nearly always given by statutory declaration. By this section a statutory declaration may be used upon an appeal in lieu of evidence by affidavit.

(a) Supreme Court of Judicature Act, 1890, section 5.

Affidavits. In proceedings in the Chancery Division the evidence is nearly always given by affidavit. Leave to cross-examine upon affidavit evidence can be obtained.

Vivâ voce. In proceedings before a jury the evidence is given *vivâ voce.*

Certificates. Registration of a trade mark is proved by the production of the Registrar's certificate given under section 17. By section 51 certificates are *primâ facie* evidence of an entry on the register having been made and of the contents thereof.

Copies. The actual terms of the entry on the register are proved by printed or written copies or extracts of or from the register, purporting to be certified by the Registrar and sealed with the seal of the Patent Office.(a)

Registration. The fact that a person is registered is *primâ facie* evidence of the validity of such registration.(b) Registration is conclusive evidence of validity after seven years, unless the registration was obtained by fraud, or the trade mark offends against the provisions of section 11.(c)

By section 52 documents purporting to be orders made by the Board of Trade are made evidence.

Evidence of infringement. Evidence of infringement is given by showing that the defendant is using or is about to use a mark so like the plaintiff's as to be calculated to deceive. As to the evidence which should be produced to show that two marks are calculated to deceive, *see* notes under section 19.

Sealed copies to be evidence.

50. Printed or written copies or extracts of or from the register, purporting to be certified by the Registrar and sealed with the seal of the Patent Office, shall be admitted in evidence in all courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Certificate of Registrar to be evidence.

51. A certificate purporting to be under the hand of the Registrar as to any entry, matter, or thing which he is authorised by this Act, or rules made thereunder, to make or do, shall be primâ facie

(a) Section 50.
(b) Section 40.
(c) Section 41.

evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or not done.

Certificate of Board of Trade to be evidence.

52.—(1) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(2) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

Part II.

Powers and Duties of Registrar of Trade Marks.

Exercise of discretionary power by Registrar.

53. Where any discretionary or other power is given to the Registrar by this Act or rules made thereunder he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without (if duly required so to do within the prescribed time) giving such applicant or registered proprietor an opportunity of being heard.

Appeal from Registrar.

54. Except where expressly given by the provisions of this Act or rules made thereunder there shall be no appeal from a decision of the Registrar otherwise than to the Board of Trade, but the court,

in dealing with any question of the rectification of the register (including all applications under the provisions of section thirty-five of this Act), shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

Recognition of agents.

55. Where by this Act any act has to be done by or to any person in connection with a trade mark or proposed trade mark or any procedure relating thereto, such act may under and in accordance with rules made under this Act or in particular cases by special leave of the Board of Trade be done by or to an agent of such party duly authorised in the prescribed manner.

Registrar may take directions of law officers.

56. The Registrar may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to His Majesty's Attorney-General or Solicitor-General for England for directions in the matter.

See the remarks of Lindley, LJ., *in re* Trade Mark "Normal."(a)

Annual reports of Comptroller.

57. The Comptroller General of Patents, Designs, and Trade Marks shall in his yearly report on the execution by or under him of the Patents, Designs, and Trade Marks Act, 1883, and Acts amending the same, include a report respecting the execution by or under him of this Act as though it formed a part of or was included in such Acts.

46 & 47 Vict. c. 57.

(a) 35 C. D., at p. 245.

Powers and Duties of the Board of Trade.

Proceedings before Board of Trade.

58. All things required or authorised under this Act to be done by to or before the Board of Trade may be done by to or before the President or a secretary or an assistant secretary of the Board or any person authorised in that behalf by the President of the Board.

Appeals to Board of Trade.

59. Where under this Act an appeal is made to the Board of Trade, the Board of Trade may, if they think fit, refer any such appeal to the court in lieu of hearing and deciding it themselves, but, unless the Board so refer the appeal, it shall be heard and decided by the Board, and the decision of the Board shall be final.

When an appeal lies.

An appeal [a] lies to the Board of Trade from the Registrar's decision—

(1) Where he has refused, or accepted, or accepted conditionally, an application to register a trade mark (section 12–(3) and section 14–(5), and as to the Manchester Branch, *see* section 64–(5)).

(2) Where he has refused to register two identical marks (section 20).

(3) Where he has apportioned trade marks upon a dissolution of partnership (section 23).

(4) Where he has refused to correct or alter the register under sections 32, 33 or 34.

It is usual for the Board of Trade to refer appeals to the Chancery Division of the High Court of Justice.

Power of Board of Trade to make rules.

60.—(1) Subject to the provisions of this Act the Board of Trade may from time to time make such rules, prescribe such forms, and generally do such things as they think expedient—

(*a*) For regulating the practice under this Act:

[a] Rules 122-127.

(*b*) For classifying goods for the purposes of registration of trade marks:

(*c*) For making or requiring duplicates of trade marks and other documents:

(*d*) For securing and regulating the publishing and selling or distributing in such manner as the Board of Trade think fit, of copies of trade marks and other documents:

(*e*) Generally, for regulating the business of the office in relation to trade marks and all things by this Act placed under the direction or control of the Registrar, or of the Board of Trade.

(2) Rules made under this section shall, whilst in force, be of the same effect as if they were contained in this Act.

(3) Before making any rules under this section the Board of Trade shall publish notice of their intention to make the rules and of the place where copies of the draft rules may be obtained in such manner as the Board consider most expedient, so as to enable persons affected to make representations to the Board before the rules are finally settled.

(4) Any rules made in pursuance of this section shall be forthwith advertised twice in the Trade Marks Journal, and shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament.

(5) If either House of Parliament within the next forty days after any rules have been so laid before such House, resolve that such rules or any of

them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

The rules now in force are set out in Appendix A.

Fees.

61. There shall be paid in respect of applications and registration and other matters under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade. Fees.

A list of fees is set out in Appendix A.

Special Trade Marks.

62. Where any association or person undertakes the examination of any goods in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic, and certifies the result of such examination by mark used upon or in connection with such goods, the Board of Trade may, if they shall judge it to be to the public advantage, permit such association or person to register such mark as a trade mark in respect of such goods, whether or not such association or person be a trading association or trader or possessed of goodwill in connection with such examination and certifying. When so registered such trade mark shall be deemed in all respects to be a registered trade mark, and such association or person to be the proprietor thereof, save that such trade mark shall be transmissible or assignable only by permission of the Board of Trade. Standardization, &c., trade marks.

As to special applications under this section *see* Rules 42-46, Appendix A.

Sheffield Marks.

Sheffield marks.

63. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company), and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, seachers, and assistants of that company, the following provisions shall have effect:—

(1) The Cutlers' Company shall continue to keep at Sheffield the register of trade marks (in this Act called the Sheffield register) kept by them at the date of the commencement of this Act, and, save as otherwise provided by this Act, such register shall for all purposes form part of the register:

(2) The Cutlers' Company shall, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in such register before the passing of this Act:

(3) An application for registration of a trade mark used on metal goods shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company:

(4) Every application so made to the Cutlers' Company shall be notified to the Registrar in the prescribed manner, and, unless the Registrar within the prescribed time gives notice to the Cutlers' Company of any objection to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner:

(5) If the Registrar gives notice of an objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may in the prescribed manner appeal to the Court:

(6) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the Registrar, who shall thereupon enter the mark in the register of trade marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the Registrar on that day:

(7) The provisions of this Act, and of any rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section (and notwithstanding anything in any Act relating to the Cutlers' Company), apply to the registration of trade marks on metal goods by the Cutlers' Company, and to

all matters relating thereto; and this Act and any such rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield register, for the Registrar, the Patent Office, and the Register of Trade Marks respectively; and notice of every entry, cancellation, or correction made in the Sheffield register shall be given to the Registrar by the Cutlers' Company:

(8) When the Registrar receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used on metal goods, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company:

(9) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the court:

(10) For the purposes of this section the expression "metal goods" means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal:

(11) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield register a certificate under the

hand of the Master of the Cutlers' Company shall have the same effect as the certificate of the Registrar.

The Sheffield Register.

This section is substituted for section 81 of the Act of 1883 as amended by section 20 of the Act of 1888. The section authorizes the Cutlers' Company to continue to keep at Sheffield the register of trade marks (called the Sheffield register) kept by them at the date of the commencement of this Act.

Metal goods.

The Sheffield register is a register of trade marks for metal goods. Metal goods mean all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.

The effect of section.

The effect of the section is as follows: Where a person carrying on business in Hallamshire or within six miles thereof desires to register a trade mark for metal goods, the application for registration must be made to the Cutlers' Company. Upon receipt of such an application the Cutlers' Company notifies the Registrar, and, unless the Registrar objects, proceeds with the application in the prescribed manner. If the Registrar gives notice of an objection the application cannot be proceeded with, but the applicant may appeal.

In all applications to the Cutlers' Company the provisions of this Act and any rules made hereunder apply.(a) The certificate of the Master of the Cutlers' Company has the same effect as the certificate of the Registrar. The date of the registration is the date of application to the Cutlers' Company.

Where a person not carrying on business in Hallamshire or within six miles thereof applies to the Registrar for registration of a trade mark for metal goods, the application must be notified to the Cutlers' Company in the prescribed manner.

Cotton Marks.

Cotton marks.

64.—(1) The Manchester Branch of the Trade Marks Registry of the Patent Office (herein-after called "the Manchester Branch") shall be continued

(a) Rules 107-112.

according to its present constitution. A chief officer of the Manchester Branch shall be appointed who shall be styled "the Keeper of Cotton Marks," and shall act under the direction of the Registrar. The present keeper of the Manchester Branch shall be the first Keeper of Cotton Marks.

(2) As regards cotton goods which have hitherto constituted classes 23, 24, and 25, under the classification of goods under the Patents, Designs, and Trade Marks Acts, 1883 to 1902, the Register of Trade Marks for all such goods, except such as may be prescribed, shall be called "the Manchester Register," and a duplicate thereof shall be kept at the Manchester Branch.

(3) All applications for registration of trade marks for such cotton goods in the said classes (herein-after referred to as "cotton marks") shall be made to the Manchester Branch.

(4) Every application so made to the Manchester Branch shall be notified to the Registrar in the prescribed manner together with the report of the Keeper of Cotton Marks thereon, and unless the Registrar, after considering the report and hearing, if so required, the applicant, within the prescribed time gives notice to the Keeper of Cotton Marks of objection to the acceptance of the application, it shall be advertised by the Manchester Branch and shall be proceeded with in the prescribed manner.

(5) If the Registrar gives notice of objection as aforesaid the application shall not be proceeded with, but any person aggrieved may in the prescribed manner appeal to the Court or the Board of Trade, at the option of the applicant.

(6) Upon the registration of a trade mark in the Manchester Register the Keeper of Cotton Marks shall upon notice thereof from the Registrar thereupon enter the mark in the duplicate of the Manchester Register, and such registration shall bear date as of the day of application to the Manchester Branch, and shall have the same effect as if the application had been made to the Registrar on that day.

(7) When any mark is removed from or any cancellation or correction made in the Manchester Register notice thereof shall be given by the Registrar to the Keeper of Cotton Marks, who shall alter the duplicate register accordingly.

(8) For the purpose of all proceedings in relation to trade marks entered in the Manchester Register a certificate under the hand of the Keeper of Cotton Marks shall have the same effect as a certificate of the Registrar.

(9) In every application for registration of a cotton mark, if such mark has been used by the applicant or his predecessors in business prior to the date of application, the length of time of such user shall be stated on the application.

(10) As from the passing of this Act—

(*a*) In respect of cotton piece goods and cotton yarn no mark consisting of a word or words alone (whether invented or otherwise) shall be registered, and no word or words shall be deemed to be distinctive in respect of such goods:

(*b*) In respect of cotton piece goods no mark consisting of a line heading alone shall

be registered, and no line heading shall be deemed to be distinctive in respect of such goods :

(*c*) No registration of a cotton mark shall give any exclusive right to the use of any word, letter, numeral, line heading, or any combination thereof.

(11) The right of inspection of the Manchester Register shall extend to and include the right to inspect all applications whatsoever that have been since the passing of the Trade Marks Registration Act, 1875, and hereafter shall have been made to the Manchester Branch in respect of cotton goods in classes 23, 24, and 25, whether registered, refused, lapsed, expired, withdrawn, abandoned, cancelled, or pending.

39 & 40 Vict. c. 33.

(12) The Keeper of Cotton Marks shall, on request, and on production of a facsimile of the mark, and on payment of the prescribed fee, issue a certified copy of the application for registration of any cotton mark, setting forth in such certificate the length of time of user (if any) of such mark as stated on the application, and any other particulars he may deem necessary.

(13) As regards any rules or forms affecting cotton marks which are proposed by the Board of Trade to be made, the draft of the same shall be sent to the Keeper of Cotton Marks and also to the Manchester Chamber of Commerce. And the said Keeper, and also the said Chamber, shall, if they or either of them so request, be entitled to be heard by the Board of Trade upon such proposed rules before the same are carried into effect.

(14) The existing practice whereby the Keeper of the Manchester Branch consults the Trade and Merchandise Marks Committee appointed by the Manchester Chamber of Commerce upon questions of novelty or difficulty arising on applications to register cotton marks shall be continued by the Keeper of Cotton Marks.

The Manchester Branch.

This section provides for the continuation of the Manchester Branch of the Trade Marks Register (herein called the "Manchester Branch"). This office is under the management and control of an officer styled the "Keeper of Cotton Marks." For the purpose of all proceedings in relation to trade marks entered in the Manchester Registry, a certificate under the hand of the Keeper of Cotton Marks has the same effect as a certificate of the Registrar.

Cotton goods.

The Manchester Branch is a register for cotton goods which have hitherto constituted classes 23, 24 and 25, under the classification of goods made under the previous Acts.(a)

These classes were as follows :—

Class 23, (*a*) cotton yarn and sewing cotton not on spools or reels; (*b*) sewing cotton on spools or reels.

Class 24, cotton piece goods of all kinds, such as cotton shirtings, longcloth.

Class 25, cotton goods not included in classes 23, 24 or 38, such as cotton lace, cotton braids, cotton tapes.

Effect of section.

All applications for the registration of trade marks for cotton goods must be made to the Manchester Branch.

When an application is made to the Manchester Branch, notice thereof is given to the Registrar. If the Registrar gives notice of objection the application cannot be proceeded with, but any person aggrieved may appeal to the Court or the Board of Trade. If the Registrar does not object, the application proceeds in the prescribed manner.

Application, How made?

The manner in which an application is made is dealt with by the rules in 113-120 Appendix A. Substantially the same procedure applies as is provided by sections 13, 14 and 15.

(*a*) Classes 23, 24 and 25 under the new Rules are substantially the same, *see* Appendix A.

The marks registrable in respect of cotton goods are the same as the marks registrable under section 9 of this Act, save in so far as that section is modified by sub-section (10) of section 64.

Upon the registration of a trade mark in the Manchester register, notice is given to the Registrar, who thereupon enters the mark in the duplicate of the Manchester Register kept in London.

Alteration of Register.

The sub-section (7) of this section provides for notice being given of any cancellation or alteration in the Register.

Inspection.

Sub-section (11) provides for the inspection of the Manchester Register.

As to the jurisdiction of the Court of Chancery of the County Palatine of Lancaster, *see* section 71.

International and Colonial Arrangements.

International and Colonial arrangements. 48 & 49 Vict. c. 63.

65. The provisions of sections one hundred and three and one hundred and four of the Patents, Designs, and Trade Marks Act, 1883 (as amended by the Patents, Designs, and Trade Marks (Amendment) Act, 1885), relating to the registration of trade marks both as enacted in such Acts and as applied by any Order in Council made thereunder, shall be construed as applying to trade marks registrable under this Act.

Section 103 of the Act of 1883 deals with international arrangements made for the protection of inventions, designs and trade marks. The conventions entered into with foreign states are set out in Mr. Kerly's book on "Trade Marks," at pp. 764—773.

Section 103 (as amended by the Act of 1885) is as follows:—

Section 103.—(1.) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs and trade marks, or any of them, then any person who has applied for protection for any invention, design or trade mark in any such state, shall be entitled to a patent for his invention, or to registration of his design or trade mark

(as the case may be) under this Act, in priority to other applicants ; and such patent or registration shall have the same date as the date of the application in such foreign state.

Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2.) The publication in the United Kingdom, or the Isle of Man, during the respective periods aforesaid, of any description of the invention or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark :

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act : Provided that, in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act :

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

Section 104, which deals with colonial arrangements for the protection of trade marks, is as follows :—

Section 104.—(1.) Where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this

country, it shall be lawful for Her Majesty from time to time by Order in Council to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

Offences.

Falsification of entries in register.

66. If any person makes or causes to be made a false entry in the register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

Penalty on falsely representing a trade mark as registered.

67.—(1) Any person who represents a trade mark as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2) A person shall be deemed, for the purposes of this enactment, to represent that a trade mark is registered, if he uses in connection with the trade mark the word "registered," or any words expressing or implying that registration has been obtained for the trade mark.

The word "registered" means "registered in the United Kingdom" when used on an article sold in this country.(a)

The use by a trader on his goods of the words "trade mark" in connection with an unregistered trade mark does

(a) Wright, Crossley & Co. *v.* William Dobbin & Co., 15 P. R. 21; MacSymons' Stores, Ltd., *v.* Shuttleworth, 15 P. R. 748.

not necessarily imply that the trade mark is registered so as to constitute an offence within this section.(a)

Royal Arms.

Unauthorised assumption of Royal Arms.

68. If any person, without the authority of His Majesty, uses in connection with any trade, business, calling, or profession, the Royal Arms (or arms so closely resembling the same as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised so to use the Royal Arms, or if any person without the authority of His Majesty or of a member of the Royal Family, uses in connection with any trade, business, calling, or profession any device, emblem, or title in such manner as to be calculated to lead to the belief that he is employed by or supplies goods to His Majesty or such member of the Royal Family, he may, at the suit of any person who is authorised to use such arms or such device, emblem, or title, or is authorised by the Lord Chamberlain to take proceedings in that behalf, be restrained by injunction or interdict from continuing so to use the same: Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing any such arms, device, emblem, or title to continue to use such trade mark.

Courts.

General saving for jurisdiction of courts.

69. The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland or Ireland in any proceedings relating to trade marks; and with reference to any such pro-

(a) Sen Sen Co. *v.* Britten, 1899, 1 Ch. 692.

ceedings in Scotland the term "the Court" shall mean the Court of Session; and with reference to any such proceedings in Ireland the term "the Court" shall mean the High Court of Justice in Ireland.

The High Court of Justice in England has jurisdiction to rectify the register of trade marks kept under this Act, notwithstanding that the registered proprietor of the mark affected is domiciled in Scotland or Ireland.(a) It has been held that the Irish Courts have no such jurisdiction.(b) As to Scotland, *see* Cowie Bros. & Co. *v.* Herbert,(c) and John Dewar & Sons, Ltd. *v.* Dewar.(d)

Isle of Man.

70. This Act shall extend to the Isle of Man, and—

(1) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man in proceedings for infringement or in any action or proceeding respecting a trade mark competent to those courts:

(2) The punishment for a misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour and with or without a fine not exceeding one hundred pounds, at the discretion of the Court:

(3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which

(a) King & Coy.'s Tm. 1892, 2 Ch. 432.
(b) Bayer *v.* Connell, 14 P. R. 275.
(c) 14 P. R. 436.
(d) 17 P. R. 341.

offences punishable on summary conviction may for the time being be prosecuted.

Jurisdiction of Lancashire Palatine Court.

71. The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks, the registration whereof is applied for in the Manchester Branch, have the like jurisdiction under this Act as His Majesty's High Court of Justice in England, and the expression "the Court" in this Act shall be construed and have effect accordingly:

Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that court in other cases.

As to the jurisdiction of the Court of Chancery of the County Palatine of Lancaster, *see* the Chancery of Lancaster Act, 1890 (53 & 54 Vict. c. 23, section 3).

Offences in Scotland.

72. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

Repeal; Savings.

Repeal and saving for rules, &c.

73. The enactments described in the schedule to this Act are repealed to the extent mentioned in the third column, but this repeal shall not affect any rule, table of fees, or classification of goods made under any enactment so repealed, but every such rule, table of fees, or classification of goods shall continue in force as if made under this Act until superseded by rules, tables of fees, or classification under this Act.

Application of 46 & 47 Vict. c. 57, ss. 82-84.

74. The provisions of sections eighty-two to eighty-four of the Patents, Designs, and Trade

Marks Act, 1883, as amended by any subsequent enactment, shall continue to apply with respect to the administration at the Patent Office of the Law relating to the registration of trade marks, and shall accordingly be construed as if this Act formed part of that Act.

Sections 82, 83 and 84 of the Act of 1883 mentioned in this section are as follows:—

Section 82. (1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

(2.) Until a new patent office is provided, the offices of the Commissioners of Patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the patent office within the meaning of this Act.

(3.) The patent office shall be under the immediate control of an officer called the comptroller-general of patents, designs, and trade marks, who shall act under the superintendence and direction of the Board of Trade.

(4.) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorized by the Board of Trade.

Section 83. (1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs and trade marks, and so many examiners and other officers and clerks with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

Section 84. There shall be a seal for the patent office, and impressions thereof shall be judicially noticed and admitted in evidence.

SCHEDULE.

Section 73.

Enactments repealed.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Sections 62 to 81, and, so far as they respectively relate to trade marks, sections 85 to 99, 101, 102, 105, 108, and 111 to 117.
51 & 52 Vict. c. 50.	The Patents, Designs, and Trade Marks Acts, 1888.	Sections 8 to 20, and, so far as they respectively relate to trade marks, sections 21 to 26.

APPENDIX A.

APPENDIX A.

STATUTORY RULES AND ORDERS, 1906.

No. 233.

TRADE MARK.

TRADE MARKS RULES, 1906. DATED MARCH 24, 1906.

By virtue of the provisions of the Trade Marks Act, 1905, the Board of Trade do hereby make the following Rules:—

PRELIMINARY.

1. These Rules may be cited as the Trade Marks Rules, 1906, and shall come into operation from and immediately after the 31st day of March, 1906.

INTERPRETATION.

Interpretation.

2. In the construction of these Rules any words herein used the meaning of which is defined by the said Act or the Interpretation Act, 1889,* shall have the meanings thereby assigned to them respectively.

"Agent" means an agent duly authorised to the satisfaction of the Registrar.

"Office" means Patent Office, Trade Marks Branch, 25, Southampton Buildings, London, W.C.

"Journal" means "Trade Marks Journal."

FEES.

Fees.

3. The fees to be paid in pursuance of the said Act shall be the fees specified in the First Schedule to these Rules.

* NOTE—The more material definitions of the Interpretation Act are:—

"Statutory Declaration" means a declaration made by virtue of the Statutory Declarations Act, 1835.

"Month" means calendar month.

"Person," unless the contrary intention appears, includes any body of persons corporate or unincorporate.

Words in the singular shall include the plural and words in the plural shall include the singular.

FORMS.

Forms.

4. The forms herein referred to are the forms contained in the Second Schedule to these Rules, and such forms shall be used in all cases to which they are applicable, and shall be modified as directed by the Registrar to meet other cases.

CLASSIFICATION OF GOODS.

Classification of goods.

5. For the purposes of trade marks registration and of these Rules goods are classified in the manner appearing in the Third Schedule hereto.

If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Registrar.

DOCUMENTS.

Size, &c., of documents.

6. Subject to any other directions that may be given by the Registrar, all applications, notices, counter-statements, papers having representations affixed, or other documents required by the said Act or by these Rules to be left with or sent to the Registrar or to the Keeper of Cotton Marks or to the Cutlers' Company, shall be upon foolscap paper of a size of approximately 13 inches by 8 inches, and shall have on the left-hand part thereof a margin of not less than one inch and a half.

Service of documents.

7. Any application, statement, notice, or other document authorised or required to be left, made, or given at the Office, or to or with the Registrar, or with or to any other person may be sent through the post by a prepaid or official-paid letter; any document so sent shall be deemed to have been delivered at the time when the letter containing the same would be delivered in the ordinary course of post, and in proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post. A letter addressed to a registered proprietor of a trade mark at his address as it appears on the register, or address for service, or to any applicant for or person opposing the registration of a trade mark at the address appearing in the application or notice of opposition or given for service as hereinafter provided shall be deemed to be sufficiently addressed.

Address.

8. Where any person is by the said Act or these Rules bound to furnish the Registrar with an address the following provisions shall apply:—

The address given shall in all cases be as full as possible, for the purpose of enabling any person easily to find the place of business of the person whose address is given.

When a person does not reside in a town with streets, the Registrar may require the address to include all indications which he thinks necessary for such purpose so far as it can be attained.

When an applicant resides in a town where there are streets, the address given shall include the name of the street, and the number in the street or name of premises, if any.

Address for service.

9. Every applicant for the registration of any trade mark, and every opponent to such registration, and every agent, who does not reside or carry on business in the United Kingdom, shall, if so required, give an address for service in the United Kingdom, and such address may be treated as the actual address of such applicant, opponent, or agent for all purposes connected with such application for registration or the opposition thereto.

The Registrar may require the proprietor of a registered trade mark who does not reside or carry on business within the United Kingdom to give an address for service within the United Kingdom, and such address may be treated as the actual address of the proprietor for all purposes connected with such trade mark.

AGENTS.

Agency.

10. An application for registration and an opposition to registration and all other communications between an applicant, an opponent and the Registrar, or the Board of Trade, and between the proprietor of a registered trade mark and the Registrar, or the Board of Trade, or any other person, may be made by or through an agent.

Any such applicant, opponent, or proprietor may appoint an agent to represent him in the matter of the trade mark by signing and sending to the Registrar an authority in writing to that effect in the Form T.M. No. 1, or in such other form as the Registrar may deem sufficient. In case any proprietor of a registered trade mark shall appoint such an agent, service upon such agent of any document relating to such trade mark shall be deemed to be service upon the person so appointing him, and all communications directed to be made to such person in respect of such trade mark may be addressed to such agent.

The Registrar shall not be bound to recognise as such agent any person who has been convicted criminally or struck off the Roll of Solicitors, or whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the Register of Patent Agents, kept under the provisions of the Patents, Designs, and Trade Marks Act, 1888, relating to the registration of Patent Agents, and not since restored.

REGISTRABLE TRADE MARKS.

Registrable trade marks.

11. The Registrar may refuse to accept any application upon which the following appear:—

(*a*) The words "Patent," "Patented," or "By Royal Letters Patent," "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is forgery," or words to like effect.

(*b*) Representations of Their Majesties or of any member of the Royal Family.

Royal Arms.

12. Representations of the Royal Arms or Royal crests, or arms or crests so nearly resembling them so as to lead to mistake, or of British Royal crowns, or of the British national flags, or the word Royal or any other words letters or devices calculated to lead persons to think that the applicant has Royal patronage or authorization, may not appear on trade marks the registration of which is applied for. Provided always that nothing contained in this rule shall preclude the Registrar from allowing the registration as an "old mark," that is as a mark which was used by the applicant or his predecessors in business before the 13th August, 1875, of any mark which was capable of being so registered before the Trade Marks Act, 1905, came into operation.

Arms of foreign State.

13. Where representations of the arms of a foreign State or place appear on a mark the Registrar may call for such justification as he may deem necessary for their use.

Arms of city, &c.

14. Where a representation of the arms or emblems of any city, borough, town, place, society, body corporate, or institution appears on a mark, the applicant shall, if so required, furnish the Registrar with a consent from such official as the Registrar may consider entitled to give consent to the use of such arms or emblems.

Representations of living persons or persons recently dead.

15. Where the names or representations of living persons appear on a trade mark, the Registrar shall if he so require be furnished with consents from such persons before proceeding to register the mark. In the case of persons recently dead the Registrar may call for consents from their legal representatives before proceeding with registration of a trade mark on which their names or representations appear.

Name or description of goods.

16. Where the name or a description of any goods appears on a trade mark the Registrar may refuse to register such mark in respect of any goods other than the goods so named or described.

Where the name or description of any goods appears on a trade mark which name or description in use varies the Registrar may permit the registration of the mark with the name or description upon it for goods other than those named or described, the applicant stating in his application that the name or description varies.

APPLICATION FOR REGISTRATION.

Application by firm.

17. If application for registration of a trade mark be made by a firm or partnership it may be signed in the name or for and on behalf of the firm or partnership by any one or more members thereof.

If the application be made by a body corporate it may be signed by a Director or by the Secretary or other principal officer of such body corporate.

Any application may be signed by an agent.

Address of application.

18. Where application is made for registration of a cotton mark the applicant shall address and send his application to the Keeper of Cotton Marks at the Manchester Branch, 48, Royal Exchange, Manchester. Other applications (except applications which under section 63 of the said Act should be made to the Cutlers' Company) shall be addressed and sent to the Registrar at the Office.

Acknowledgment of application.

19. On or after receipt of the application the Registrar shall furnish the applicant with an acknowledgment thereof.

Application for old mark.

20. Where application is made to register a trade mark which was used by the applicant or his predecessors in business before the 13th of August, 1875, the application shall contain a statement of the time during which and by whom it has been used in respect of the goods mentioned in the application. The Registrar may require a statutory declaration verifying such user with exhibits showing the mark as used.

Contents of form of application.

21. Every application for registration of a trade mark shall contain a representation of the mark affixed to it in the square which the Form T.M. No. 2 contains for that purpose.

Where the representation exceeds such square in size the representation shall be mounted upon linen, tracing cloth or other material that the Registrar may consider suitable. Part of the mounting shall be affixed in the space aforesaid and the rest may be folded over.

Additional representations.

22. There shall be sent with every application for registration of a trade mark four additional representations of such mark on the Form T.M. No. 3 exactly corresponding to that affixed to the application Form T.M. No. 2, and noted with all such particulars as may from time to time be required by the Registrar or by the Keeper of Cotton Marks. Such particulars shall, if required, be signed by the applicant or his agent.

Representations to be durable.

23. All representations of marks must be of a durable nature, but the applicant may in case of need supply in place of representations on the Form T.M. No. 3, half sheets of strong foolscap of the size aforesaid with the representations affixed thereon and noted as aforesaid.

Separate applications.

24. Applications for the registration of the same mark in different classes shall be treated as separate and distinct applications, and in all cases where a trade mark is registered under the same official number for goods in more than one class, the registration shall henceforth for the purpose of fees and otherwise be deemed to have been made on separate and distinct applications in respect of the goods included in each class.

Representations to be satisfactory.

25. The Registrar, if dissatisfied with any representation of a mark, may at any time require another representation satisfactory to him to be substituted before proceeding with the application.

Specimens of trade marks in exceptional cases.

26. Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the trade mark may be sent either of full size or on a reduced scale, and in such form as the Registrar may think most convenient.

The Registrar may also, in exceptional cases, deposit in the office a specimen or copy of any trade mark which cannot conveniently be shown by a representation, and may refer thereto in the register in such manner as he may think fit.

Series of trade marks.

27. When application is made for the registration of a series of trade marks under section 26 of the said Act, a representation of each trade mark of the series shall be affixed, as aforesaid, to the application upon Form T.M. No. 2, and to each of the accompanying Forms T.M. No. 3.

Transliteration and translation.

28. When a trade mark contains a word or words in other than Roman characters, there shall be indorsed on the application in Form T.M. No. 2, and on each of the accompanying representations in Form T.M. No. 3, a sufficient transliteration and translation to the satisfaction of the Registrar of each of such words, and every such indorsement shall be signed by the applicant or his agent.

Where a trade mark contains a word or words in a language other than English, the Registrar may ask for an exact translation thereof, and if he so requires such translation shall be endorsed and signed as aforesaid.

Procedure on Receipt of Application.

Search.

29. Subject to the provisions for special applications under paragraph 5 of section 9 of the said Act, upon receipt of an application for registration the Registrar shall cause a search to be made amongst the registered Marks and pending applications for the purpose of ascertaining whether there are on record any Marks for the same goods or description of goods identical with the Mark applied for or so nearly resembling it as to be calculated to deceive.

Acceptance.

30. If after such search and a consideration of the application the Registrar thinks there is no objection to the Mark being registered, he may accept it absolutely or subject to conditions, amendments, and modifications which he shall communicate to the applicant in writing.

Objections.

31. If after such search and consideration of the application any objections appear, a statement of those objections shall be sent to the applicant in writing, and unless within one month the applicant applies for a hearing, he shall be deemed to have withdrawn his application.

Hearings.

32. If the Registrar accepts an application subject to any conditions, amendments, or modifications, and the applicant objects to such conditions, amendments, or modifications, he shall within one month from the date of the communication notifying such acceptance apply for a hearing, and if he does not do so he shall be deemed to have withdrawn his application. If the applicant does not object to such conditions, amendments, or modifications, he shall forthwith notify the Registrar in writing.

Decision of Registrar.

33. The decision of the Registrar at such hearing as aforesaid shall be communicated to the applicant in writing, and if he objects to such decision, he may within one month apply upon Form T.M. No. 4, requiring the Registrar to state in writing the grounds of his decision and the materials used by him in arriving at the same.

Upon receipt of such form the Registrar shall send to the applicant such statement as aforesaid in writing, and the date when such statement is sent shall be deemed to be the date of the Registrar's decision for the purpose of appeal.

Disclaimers.

34. The Registrar may call on an applicant to insert in his application such disclaimer as the Registrar may think fit, in order that the public generally may understand what the applicant's rights, if his mark is registered, will be.

Special Applications under Paragraph 5 of Section 9.

Special applications under section 9, paragraph 5.

35. An application to register a name, signature, or word or words under paragraph 5 of section 9 of the said Act shall be made on the Form T.M. No. 5, and not otherwise.

Search.

36. Upon receipt of such an application the Registrar shall cause a search to be made amongst the registered marks and pending applications for the purpose of ascertaining whether there are on record any marks for the same goods or description of goods identical with the mark applied for or so nearly resembling it as to be calculated to deceive.

Result of search.

37. If after such search the Registrar thinks there are no such marks, he shall notify the applicant accordingly, but if after such search any such marks appear, he shall notify to the applicant the numbers of those marks and the journals (if any) in which they have been advertised.

Appeal by applicant.

38. Within one month from the receipt of such notification the applicant shall send to the Registrar in writing a case in duplicate stating at length the grounds upon which he relies in support of his application, and whether he desires to be heard by the Board of Trade or by the Court. If he fails to do so his application shall be deemed to be withdrawn. If he desires to be heard by the Board of Trade, he shall send with his case Form T.M. No. 10. If the Board think fit to refer the appeal to the Court, the Registrar may certify the spoilt fee on such form for allowance.

Upon receipt of such case the Registrar shall send the same to the Board of Trade for their information, together with a copy of all communications that have passed between the Registrar and the applicant.

Hearing.

39. Upon receipt of such case the Board of Trade shall if the applicant desires to be heard by them fix a day for such hearing at which the applicant and the Registrar may attend and be heard, and the Board shall make an order determining whether and subject to what conditions, amendments, or modifications, if any, the application is to be accepted, or may require the applicant to apply to the Court and limit a time for that purpose.

Order of the Court.

40. If the applicant desires to obtain an order of the Court he shall within one month from sending to the Registrar his case as aforesaid bring the matter before the Court by motion, and if he does not do so he shall be deemed to have withdrawn his application.

Advertisement, &c., of application.

41. If the application is accepted either by the Board of Trade or the Court it shall be advertised and proceedings thereafter shall be had in respect of it as if it had been accepted by the Registrar in the ordinary course.

Special Trade Marks under Section 62.

Application under section 62.

42. Where an association or person desires to register a mark under section 62 of the said Act they shall apply to the Registrar in writing upon the Form T.M. No. 6.

Mode of application.

43. Such application shall be in duplicate and shall be accompanied by six copies of the mark applied for.

Report by Registrar.

44. Upon the receipt of such application the Registrar shall as soon as may be notify the same to the Board of Trade together with his report upon the application, and shall at the same time

send a copy of the application together with three copies of the mark applied for to the Board. The Registrar shall also send the applicants a copy of his report, and within one month from the receipt of such report the applicants shall send the Board in duplicate a case setting out the grounds upon which they rely in support of their application, and if they fail so to do their application shall be deemed to be abandoned.

Hearing.

45. Upon receipt of such case the Board may call for such evidence, if any, as they think fit, and shall, if necessary, hear the applicants and the Registrar, and make an order determining whether and subject to what conditions amendments or modifications, if any, the application may be permitted to proceed.

Advertisement, &c.

46. If such application is permitted to proceed the mark shall be advertised and the application shall be treated in all respects as if it were an ordinary application, and it shall be open to opposition in the same way and all such proceedings shall be had thereon as if it were an application under section 12 of the said Act.

ADVERTISEMENT OF APPLICATION.

Advertisement of application.

47. Every application when accepted shall be advertised by the Registrar in the Journal during such times and in such manner as the Registrar may direct.

If no representation of the trade mark be inserted in connexion with the advertisement of an application, the Registrar shall refer in such advertisement to the place or places where a specimen or representation of the trade mark is deposited for exhibition.

Wood block or electrotype.

48. For the purposes of such advertisement the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of the trade mark, of such dimensions as may from time to time be directed by the Registrar, or such other information or means of advertising the trade mark as may be required by the Registrar ; and the Registrar, if dissatisfied with the block or electrotype furnished by the applicant or his agent, may require a fresh block or electrotype before proceeding with the advertisement.

Advertisement of series.

49. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in section 26 of the said Act, the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of any or of each of the trade marks constituting the series ; or the Registrar may, if he thinks fit, insert with the advertisement of the application a statement of the manner in respect of which the several trade marks differ from one another.

Advertisement under section 14 (9).

50. Advertisements under section 14 (9) of the said Act shall *mutatis mutandis* be made in the same manner as advertisements relating to an application for registration.

Opposition to Registration.

Opposition.

51. Any person may within one month from the date of any advertisement in the Journal of an application for registration of a trade mark give notice in writing at the Office of opposition to the registration.

Notice of opposition.

52. Such notice shall be in Form T.M. No. 7, and shall contain a statement of the grounds upon which the opponent objects to the registration. If registration is opposed on the ground that the mark resembles marks already on the register, the numbers of such marks and the numbers of the Journals in which they have been advertised shall be set out. Such notice shall be accompanied by a duplicate which the Registrar will forthwith send to the applicant.

Counter-statement.

53. Within one month from the receipt of such duplicate the applicant shall send to the Registrar a counter-statement (Form T.M. No. 8) in writing setting out the grounds on which he relies as supporting his application. The applicant shall also set out what facts, if any, alleged in the Notice of Opposition he admits. Such counter-statement shall be accompanied by a duplicate in writing.

Evidence in support of opposition.

54. Upon receipt of such counter-statement and duplicate the Registrar will forthwith send the duplicate to the opponent, and within one month from the receipt of the duplicate the opponent shall leave at the Office such evidence by way of statutory declaration as he may desire to adduce in support of his opposition and shall deliver to the applicant copies thereof.

Evidence in support of application.

55. If an opponent leaves no evidence, he shall be deemed to have abandoned his opposition, but if he does then within one month from the receipt of the copies of declarations, the applicant shall leave at the Office such evidence by way of statutory declaration as he desires to adduce in support of his application and shall deliver to the opponent copies thereof.

Evidence in reply by opponent.

56. Within fourteen days from the receipt by the opponent of the copies of the applicant's declarations the opponent may leave at the Office evidence by statutory declaration in reply, and shall deliver to the applicant copies thereof. Such evidence shall be confined to matters strictly in reply.

Further evidence.

57. In any proceedings before the Registrar, he may at any time, if he thinks fit, give leave to either the applicant or the opponent to file any evidence upon such terms as to costs or otherwise as the Registrar may think fit.

Exhibits.

58. Where there are exhibits to declarations filed in an opposition, copies or impressions of such exhibits shall be sent to the other party on his request, or, if such copies or impressions cannot conveniently be furnished, the originals shall be sent to the Office, so that they may be open to inspection. The original exhibits shall be produced at the hearing unless the Registrar otherwise directs.

Hearing.

59. Upon completion of the evidence the Registrar shall give notice to the parties of a date when he will hear the arguments in the case. Such appointment shall be for a date at least fourteen days after the date of the notice, unless the parties consent to a shorter notice. Within seven days from the receipt of such notice both parties shall file Form T.M. No. 9. A party who receives such notice and who does not, within seven days from the receipt thereof, give notice on Form T.M. No. 9 that he intends to appear, may be treated as not desiring to be heard and the Registrar may act accordingly.

Extension of time.

60. Where in opposition proceedings any extension of time is granted to any party, the Registrar may thereafter, if he thinks fit, without giving the said party a hearing, grant any reasonable extension of time to the other party in which to take any subsequent step.

Security for costs.

61 Where a party giving notice of opposition neither resides or carries on business in the United Kingdom, the Registrar may call upon him to give a security in such form as the Registrar may deem sufficient for the costs of the proceedings before the Registrar, for such amount as to the Registrar may seem fit, and at any stage in such opposition may require further security to be given at any time before giving his decision in the case.

Non-Completion.

Non-completion within 12 months.

62. Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar shall give notice to the applicant in writing in the Form O. No. 1 of such non-completion, and if the applicant has an agent, shall send a duplicate of such notice to such agent. If after fourteen days from the date when such notice was sent the registration is not completed, the application shall be deemed to be abandoned, but the Registrar may

with such notice, where the applicant lives at a distance, give a further time after such fourteen days for the completion of such application.

REFUSAL AFTER ACCEPTANCE.

Refusal after acceptance.

63. In pursuance of section 16 of the said Act the Board of Trade hereby direct that in cases where a mark has been accepted by error, the Registrar need not register the mark but may withdraw his acceptance and refuse to register, but any such refusal shall be deemed to be a refusal under sub-section 2 of section 12 of the said Act, and an applicant shall have thereafter the same right of being heard, and of appealing, as he would have had if the mark had been refused immediately upon its receipt. In any other case the Board, having regard to any special facts, will give special directions under section 16 of the said Act.

ENTRY ON THE REGISTER.

Entry on register.

64. As soon as may be after the expiration of one month from the date of the advertisement in the Journal of any application, the Registrar shall, subject to any opposition and the determination thereof, and subject to the provisions of Rule 63, and upon payment of the prescribed fee, on Form T.M. No. 11, enter the trade mark on the register. The entry of a trade mark on the register shall give the date of the registration, the goods in respect of which it is registered, and all particulars named in section 4 of the Act, together with particulars of the trade, business, profession, or occupation, if any, of the proprietor, and such other particulars as the Registrar may deem necessary.

Associated marks.

65. Where a mark is registered as associated with any other mark or marks the Registrar shall note upon the register in connection with such mark the numbers of the marks with which it is associated, and shall also note upon the register in connection with each of the associated marks the number of the newly registered mark as being an associated mark with each of them.

Death of applicant before registration.

66. In case of the death of any applicant for a trade mark after the date of his application, and before the trade mark applied for has been entered on the register, the Registrar, after the expiration of the prescribed period of advertisement, may, on being satisfied of the applicant's death, enter on the register, in place of the name of such deceased applicant, the name, address, and description of the person owning the goodwill of the business, on such ownership being proved to the satisfaction of the Registrar.

Certificate of registration.

67. Upon the registration of a trade mark the Registrar shall issue to the applicant a certificate in the Form O. No. 2.

RENEWAL.

Renewal of registration.

68. At any time not less than two months and not more than three months before the expiration of the last registration of a trade mark any person may leave at the Office a fee for the renewal of the registration of the mark upon Form TM No. 12. Such person shall indorse upon such form his name and address, and before taking any further step the Registrar may require such person to furnish within five days an authority to pay such fee signed by the registered proprietor, and if such person does not furnish such authority, may return such fee and treat it as not received.

Notification of receipt of renewal fee.

69. When he does not require such authority, the Registrar shall upon receipt of such fee communicate with the registered proprietor at his registered address, stating that the fee has been received and that the registration will in due course be renewed.

Notice before removal of trade mark from register.

70. At a date not less than one month and not more than two months before the expiration of the last registration of a mark, if no fee upon the Form TM No. 12 has been received, the Registrar shall send to the registered proprietor at his registered address a notice in the Form O. No. 3.

Second notice before removal of trade mark from register.

71. At a time not less than 14 days and not more than 28 days before the expiration of the last registration of a mark, the Registrar shall, if no renewal fee has been received, send a notice to the registered proprietor at his registered address in the Form O No. 4.

Advertisement of non-payment.

72. If at the date of the expiration of the last registration of a mark the renewal fee has not been paid, the Registrar shall advertise the fact forthwith in the Journal, and if within one month of such advertisement the renewal fee upon Form TM No. 13, together with an additional fee upon Form T.M. No. 14, is received, he may renew the registration without removing the mark from the register.

Removal of trade mark from register.

73. Where after one month from such advertisement such fees have not been paid, the Registrar may remove the mark from the register as of the date of the expiration of the last registration, but may upon payment of the renewal fee upon Form TM No. 13, together with the additional fee upon the Form TM No. 15, restore the mark to the register if satisfied that it is just so to do, and upon such conditions as he may think fit to impose.

Removal of mark from register.

74. Where a trade mark has been removed from the register the Registrar shall cause to be entered in the register a record of such removal and of the cause thereof.

Notice and advertisement of renewal.

75. Upon the renewal of a registration a notice to that effect shall be sent to the registered proprietor at his registered address and the renewal shall be advertised in the Journal.

ASSIGNMENT.

Joint request for entry of assignment.

76. The Registrar may on request made jointly by a registered proprietor of a mark and the person to whom he has assigned such mark, together with the goodwill of the business concerned in the goods for which it has been registered, register the assignee as proprietor of the mark. Such application shall be in the Form T.M. No. 16. If the Registrar so require, the assignee shall furnish a declaration in TM No. 17.

Request for entry of assignment by subsequent proprietor.

77. Where no such joint request is made, any person who has become entitled to a registered trade mark by assignment, transmission, or other operation of law, may leave a request at the Office for the entry of his name in the register as proprietor of such trade mark. The request shall be on the Form TM No. 18, and such request shall contain the name, address, and description of the person claiming to be entitled to the trade mark, hereinafter called the claimant.

Case accompanying request.

78. Together with such request the claimant shall leave a case stating full particulars of the assignment, transmission, or other operation of law by virtue of which he claims to be entitled to be entered in the register as proprietor of the trade mark, so as to show the manner in which and the person or persons to whom the trade mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted in connection with the goodwill of the business concerned in the goods for which the trade mark has been registered.

Signature of request.

79. Such request shall in the case of an individual be made and signed by the claimant, and in the case of a firm or partnership by one or more members of such firm or partnership, and in the case of a body corporate shall be signed by a director or by the secretary or other principal officer of such body corporate.

Statutory declaration in support of request.

80. Where the Registrar shall determine that the case sets out particulars such as entitle the claimant to be registered as proprietor of such trade mark, he shall call upon the claimant to furnish a statutory declaration (Form TM No. 19) verifying the several statements in the case, and declaring that the particulars given comprise every material fact and document affecting the proprietorship of the trade mark claimed by such request.

Proof of title.

81. In any case, the Registrar may call on any person who desires to be registered as proprietor of a trade mark for such

proof or additional proof of title and of the existence and ownership of such goodwill as aforesaid as the Registrar may require for his satisfaction.

Alteration of Address.

Alteration of address in register.

82. Every registered proprietor of a trade mark who alters his address shall forthwith apply to the Registrar on the Form T.M. No. 20 to insert the new address on the register, and the Registrar shall alter the register accordingly.

Discretionary Power.

Hearing.

83. Before exercising any discretionary power given to the Registrar by the said Act adversely to any person, the Registrar shall, if so required, hear the person who will be affected by the exercise of such power.

Application for hearing.

84. An application for a hearing shall be made within one month from the date when the matter on which the Registrar is called on to exercise discretionary power has arisen.

Notice of hearing.

85. Upon receiving such application the Registrar shall give the person applying 10 days' notice of a time when he may be heard by himself or his agent.

Within five days from the date when such notice would be delivered in the ordinary course of post the person applying shall notify the Registrar whether or not he intends to be heard on the matter.

Notification of decision.

86. The decision of the Registrar in the exercise of any such discretionary power as aforesaid shall be notified to the person affected.

Applications under Section 23.

Application under section 23.

87. All applications to the Registrar under section 23 of the said Act shall be upon the Form TM No. 21. Such application shall be accompanied by a case setting out fully the facts relating to the marks which the Registrar is requested to permit an apportionment of.

Registrar to enquire and decide.

88. Upon receipt of such request and of such case the Registrar shall enquire into the facts and call for such evidence as he may deem necessary upon the subject of such application. Before giving his decision the Registrar shall, if necessary, give the parties an opportunity of attending before him at a hearing either by themselves or by their agents.

The decision of the Registrar shall be in writing.

Note in register.

89. Upon any apportionment of marks under this section the Registrar shall insert in the register a note in connection with each of the registered trade marks of the fact of such apportionment, and shall in such note refer to the date of the decision under which such apportionment has taken place.

APPLICATIONS UNDER SECTION 32.

Application under section 32.

90. Applications under section 32 to the Registrar may be made by the registered proprietor, or by the trustee in bankruptcy of the registered proprietor, or where the registered proprietor is a company in liquidation by the liquidator, and in other cases by such person as the Registrar may decide to be entitled to act in the name of the registered proprietor.

Evidence.

91. Where such application is made, the Registrar may require such evidence by statutory declaration or otherwise as he may think fit as to the circumstances in which the application is made.

Advertisement of application.

92. Where application is made, on Form TM No. 26, to enter a disclaimer or memorandum relating to a trade mark, the Registrar, before deciding upon such application, shall advertise the application in the Journal for one month in order to enable any person desiring so to do to state any reasons in writing against the applicant being allowed to make such disclaimer or enter such memorandum.

APPLICATIONS UNDER SECTION 34.

Alteration of trade mark.

93. Where a person desires to apply under section 34 to alter a trade mark he shall make his application in writing on Form TM No. 27, and shall furnish the Registrar with six copies of the mark as it will appear when altered.

Advertisement of alteration.

94. Before proceeding with such application the Registrar may call on the applicant to furnish a block suitable to advertise in the Journal the fact that such application has been made, or, if he think fit, the Registrar, without calling for a block, may insert an advertisement describing the alteration proposed in words so that it can be understood by persons interested in the matter.

Where leave is granted the Registrar may, if he is not already in possession of a block showing the trade mark as altered, cause the applicant to furnish a block showing the trade mark as altered for advertisement in the Journal, and upon receipt of such block shall forthwith advertise the mark as altered in the Journal.

SEARCH.

Searches.

95. The Registrar, if requested so to do in writing upon a Form TM No. 28, may cause a search to be made in any class to

ascertain whether any marks are on record at the date of such search which may resemble any mark sent in duplicate to him by the person requesting such search and may cause that person to be informed of the result of such search.

Hours of Inspection.

Hours of inspection.

96. The Office shall be open to the public every weekday, except Saturday, between the hours of ten and four, and on Saturday between the hours of ten and one, except on the days following :—

Christmas Day; Good Friday; the day observed as His Majesty's birthday; the days observed as days of public fast or thanksgiving, or as holidays at the Bank of England; and days which may from time to time be notified by a placard posted in a conspicuous place at the Office.

Power to Dispense with Evidence.

Dispensing with evidence.

97. Where under these Rules any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Registrar, or at the Office, and it is shown to the satisfaction of the Registrar that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Registrar, and upon the production of such other evidence, and subject to such terms as he may think fit, to dispense with any such act or thing, document, declaration, or evidence.

Amendments.

Amendment of documents.

98. Any document or drawing or other representation of a trade mark may be amended, and any irregularity in procedure which in the opinion of the Registrar may be obviated without detriment to the interests of any person may be corrected, if the Registrar think fit, and on such terms as he may direct.

Enlargement of Time.

Enlargement of time.

99. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Registrar, if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct, and such enlargement may be granted though the time has expired for doing such act or taking such proceeding.

Excluded days.

100. Whenever the last day fixed by the said Act, or by these Rules, for leaving any document or paying any fee at the Office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively.

Fees paid late by persons living at distances from Office.

101. Where a time for paying a fee is limited by these Rules and the person who is bound to pay such fee resides at such distance from the Office that he cannot reasonably be expected to pay the fee on the date limited by the Rule, the Registrar, if satisfied that the omission to pay the fee has not been from any want of diligence on the part of the person whose business it is to pay it, may accept the fee even though the date for paying the fee has passed, and treat it as if received on the correct date, provided always that the fee is actually paid with such promptitude as can be expected in the circumstances.

CERTIFICATES.

Certificates by Registrar.

102. The Registrar, when required otherwise than under section 17 of the said Act to give a certificate as to any entry, matter, or thing which he is authorised by the said Act or any of these Rules to make or do, may, on receipt of a request in writing, and on payment of the prescribed fee, give such certificate, but every certificate of registration so given shall have specified on the face thereof, whether the same is to be used in legal proceedings, or for the purpose of obtaining registration abroad, or for purposes other than use in legal proceedings or obtaining registration abroad.

Marks registered without limitation of colour.

103. Where a mark is registered without limitation of colour it shall be lawful for the Registrar to grant a certificate of its registration for the purpose of obtaining registration abroad either in the colour in which it appears upon the register or in any other colour or colours.

Certificates for use in obtaining registration abroad.

104. Where a certificate of registration is desired for use in obtaining registration abroad, the Registrar shall affix to the said certificate a copy of the mark, and shall state in such certificate such particulars concerning the registration of the mark as to him may seem fit, and may omit therefrom reference to any disclaimer appearing on the Register.

DECLARATIONS.

Manner in which, and person before whom, declaration is to be taken.

105. The statutory declarations required by the said Act and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:—

(*a*) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

(*b*) In any other part of His Majesty's dominions, before any court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and

(*c*) If made out of His Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or a notary public, or before a judge or magistrate.

Notice of seal of officer taking declaration to prove itself.

106. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorised to take such declaration in testimony of such declaration having been made and subscribed before him, may be admitted by the Registrar without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration.

CUTLERS' COMPANY.

Applications.

107. All applications to the Cutlers' Company for registration of a trade mark, under section 63 of the said Act, shall be in duplicate, accompanied by the prescribed fees and representations. Requests to enter old corporate marks on the Sheffield Register, under section 63 (2), should be made on Form Sheffield No. 1.

Notice to Registrar.

108. The Cutlers' Company shall, within seven days of the receipt by them of an application to register a trade mark, send the Registrar one copy of such application, by way of notice thereof, together with two representations of the mark for each class for which the applicant seeks registration.

Objections by Registrar to acceptance.

109. The time within which the Registrar shall give notice to the Cutlers' Company of any objection he may have to the acceptance of an application for registration made to the said Company shall be one month from the date of the receipt by the Registrar of the notice from the said Company of the making of the application.

Advertisement of application.

110. If no such objection is made by the Registrar, the Cutlers' Company shall require the applicant to send the Registrar a wood block or electrotype as the Registrar may direct, and the Registrar shall, if satisfied with such wood block or electrotype, advertise the application in the same manner as an application made to him at the Office.

Notification to Cutlers' Company of Application.

111. The manner in which the Registrar shall notify to the Cutlers' Company an application and proceedings thereon made as mentioned in sub-section 8 of section 63 of the said Act shall be by sending to the Cutlers' Company a copy of the Journal containing the application of which notice is required to be given, with a note distinguishing such application.

Similarity of proceedings in London and Sheffield.

112. The provisions of these Rules as to forms, representations, the proceedings on opposition to registration, registration, and all subsequent proceedings, shall, as far as the circumstances allow, apply to all applications to register made to the Cutlers' Company, and to all proceedings consequent thereon.

COTTON MARKS.

Application.

113. An application to the Manchester Branch for registration of a trade mark under section 64 of the said Act shall be in duplicate. The special Forms for cotton marks contained in the Second Schedule to these Rules shall be used. One of the Forms of application shall be stamped and the other unstamped.

One representation to be sent to Registrar.

114. The Keeper of Cotton Marks shall forthwith, on receipt of such application, send the Registrar one representation of the mark applied for.

Search.

115. As soon as may be after receiving any application the Keeper of Cotton Marks shall make a search amongst the marks on the Manchester register, in the B List, and those which have been refused and those which are pending, and shall notify to the Registrar the application and the marks, if any, which he has found so nearly resembling the mark applied for as to be calculated to deceive, and together with such notification shall send a report upon the application.

Hearings.

116. Upon considering such report, if the Registrar thinks it will be necessary to object to the acceptance of the application, he shall give notice to the applicant of a time when he can be heard, and, within one month after hearing the applicant, may give notice to the Keeper of Cotton Marks of objection to the acceptance of the application, or that he has no objection, as the case may be. If no no notice of objection, or if notice of no objection is received from the Registrar, the application shall be advertised in the Journal by the Manchester Branch.

If the applicant, being notified as aforesaid of a time for hearing, does not attend, his application shall be deemed to be refused.

Registration.

117. If the mark is advertised by the Manchester Branch and is not opposed, the Keeper of Cotton Marks may call upon the applicant for the prescribed fee for the registration of such trade

mark, and upon receipt thereof shall report to the Registrar, who shall forthwith, if he think fit, register the same.

Procedure.

118. Where under the said Act or these Rules an application has to be made to the Keeper of Cotton Marks, such application shall be made and such proceedings shall be had thereon as if in these Rules the expression "Manchester Branch, 48, Royal Exchange, Manchester," were substituted for the word "Office," and the expression "Keeper of Cotton Marks" were substituted for the word "Registrar."

Service of documents.

119. Where any document is by these Rules directed to be served upon the Registrar it shall, in respect of cotton marks, be served in duplicate upon the Keeper of Cotton Marks, who shall forthwith transmit one copy to the Registrar.

Search under Rule 95.

120. Where under Rule 95 a search has to be made by the Keeper of Cotton Marks, such search shall cover all marks of which there is a right of inspection under section 64 (11) of the said Act.

Appeals to the Court.

Appeal to Court.

121. When any person intends to appeal to the Court, such appeal shall be made by motion in the usual way, and no such appeal shall be entertained unless notice of motion be given within one month from the date of the decision appealed against or within such further time as the Registrar shall allow.

Appeals to Board of Trade.

Appeal to Board of Trade.

122. When any person intends to appeal to the Board of Trade he shall, before doing so, apply to the Registrar for a hearing and obtain a decision from him upon the point raised. Within one month from the date of such decision he shall, if he is advised to appeal to the Board of Trade in any case in which an appeal is given by the said Act, leave at the Office a notice of such his intention, on Form TM No. 29.

Such notice shall be accompanied—

(1) In case the appeal concerns an application not yet advertised, by a copy of the form of application and six representations of the mark applied for and a copy of the grounds of the Registrar's decision.

(2) In case of an opposition by a copy of the decision of the Registrar, and if the appeal is by the applicant also by a copy of the form of application and six representations of the mark opposed.

(3) In other cases by a copy of the decision of the Registrar and a statement of the date of the hearing before him.

Grounds of appeal to be stated.

123. Such notice shall also be accompanied by a statement in writing of the grounds of appeal, and of the appellant's case in support thereof.

Transmission of notice.

124. A copy of the notice and all the accompanying documents shall also be forthwith sent by the appellant to the Secretary of the Board of Trade, No. 7, Whitehall Gardens, London; and where there has been an opposition before the Registrar to the opponent or applicant as the case may be.

Directions by Board.

125. The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to parties and evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade, or for the purpose of their referring the appeal to the Court to hear and determine the same.

Hearing of appeal.

126. Where the Board of Trade intend to hear the appeal, seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing, shall be given to the Registrar and to the appellant, and where there has been an opposition before the Registrar to the opponent or applicant as the case may be.

No appeal unless notice duly given.

127. No appeal shall be entertained of which notice has not been given within one month from the date of the decision appealed against, or such further time as the Registrar may allow, except by special leave of the Board of Trade.

Withdrawal of Appeals.

Withdrawal of appeal.

128. Where under section 12 (5) or section 14 (8) of the said Act an appellant is entitled to withdraw his appeal, such withdrawal shall be effected by notice given to the Registrar and to the other parties, if any, to such appeal within seven days after the leave referred to in such sections has been obtained.

Applications to and Orders of the Court.

Order of Court.

129. Where an order has been made by the Court in any case under the said Act, the person in whose favour such order has been made, or such one of them, if more than one, as the Registrar may direct, shall forthwith leave at the Office an office copy of such order, together with Form TM No. 30 if required. The register may, if necessary, thereupon be rectified or altered by the Registrar.

Every application to the Court under the said Act shall be served on the Registrar.

Publication of order of Court.

130. Whenever an order is made by the Court under the said Act, the Registrar may, if he thinks that such order should be made public, publish it in the Journal.

Dated this 24th day of March, 1906.

(Sd.) *D. Lloyd-George,*
President of the Board of Trade.

SCHEDULES.

First Schedule.

FEES.

The following fees shall be paid in connection with applications, registrations, and other matters under the Act. Such fees must in all cases be paid before or at the time of the doing of the matter in respect of which they are to be paid:—

	£	s.	d.	Corresponding Form.
1. On application not otherwise charged to register a trade mark for one or more articles included in one class	0	10	0	T.M. No. 2 or 5, Cotton No. 1
1*a*. On application not otherwise charged to register a series of trade marks for one or more articles included in one class ...	0	10	0	T.M. No. 2 or 5, Cotton No. 1
1*b*. On request to the Cutlers' Company to enter a mark on the Sheffield Register under section 63, sub-section (2) ...	5	0	0	Sheffield No. 1.
1*c*. On application to the Board of Trade under section 62 for leave to register a mark for goods in one class	0	10	0	T.M. No. 6
1*d*. On application to the Board of Trade under section 62 for leave to register a mark for goods in more than one class—				
In respect of every class	0	10	0	T.M. No. 6
Total fee in no case to exceed £10 for any number of classes.				
2. On an application to Registrar to state grounds of decision and materials used under section 12, sub-section 3	0	10	0	T.M. No. 4
3. On request to be heard by the Board of Trade on application to register a name, signature, word or words under section 9, paragraph (5)	1	0	0	T.M. No. 10
4. On notice of opposition for each application opposed, by opponent	1	0	0	T.M. No 7

	£	s.	d.	Corresponding Form.
4*a*. On filing a counter-statement in answer to a notice of opposition, by the applicant for each application opposed	0	10	0	T.M. No. 8
4*b*. On the hearing of each opposition, by applicant and by opponent respectively ...	1	0	0	T.M. No. 9
5. For registration of a trade mark for one or more articles included in one class ...	1	0	0	T.M. No. 11
5*a*. For registration of a series of marks for one or more articles included in one class—				
For the first mark	1	0	0	T.M. No. 11
And for every other mark of the series	0	5	0	
5*b*. For registration under section 62 of a mark for goods in more than one class—				
In respect of every class	1	0	0	T.M. No. 11
Total fee in no case to exceed £20 for any number of classes.				
6. Upon each entry in the register of a mark of a note that the mark is associated with a newly registered mark	0	1	0	—
7. On application to register a subsequent proprietor in cases of assignment or transmission of a single mark	1	0	0	T.M. No. 16 or 18
7*a*. On application to register a subsequent proprietor of more than one mark standing in the same name, the devolution of title being identical in each case—				
For the first mark	1	0	0	T.M. No. 16 or 18
And for every other mark	0	2	0	
8. On application to change the name of a proprietor of a single mark where there has been no alteration in the proprietorship	0	5	0	T.M. No. 23

	£	s.	d.	Corresponding Form.
8*a*. On application to change the name of a proprietor of more than one mark standing in the same name, the change being the same in each case—				
For the first mark	0	5	0	T.M. No. 23
And for every other mark	0	1	0	
9. For renewal of registration of a mark at expiration of last registration	1	0	0	T.M. No. 12 or 13
9*a*. For renewal of registration of a series of marks at the expiration of last registration—				
For the first mark of the series ...	1	0	0	T.M. No. 12 or 13
And for every other mark of the series	0	2	0	
9*b*. For renewal of a mark registered under section 62 for goods in more than one class—				
In respect of every class ... ... Total fee in no case to exceed £20 for any number of classes.	1	0	0	T.M. No. 12 or 13
10. Additional fee under Rule 72	0	10	0	T.M. No. 14
11. Additional fee under Rule 73	1	0	0	T.M. No. 15
12. For altering a single entry of the address of a registered proprietor	0	5	0	T.M. No. 20
12*a*. For altering more than one entry of the address of a registered proprietor where the address in each case is the same and is altered in the same way—				
For the first entry	0	5	0	T.M. No. 20
And for every other entry	0	1	0	
13. For every entry in the register of a rectification thereof or an alteration therein, not otherwise charged	0	10	0	T.M. No. 30
14. For cancelling the entry or part of the entry of a trade mark upon the register on the application of the owner of such trade mark	0	5	0	T.M. No. 24 or 25

	—			Corresponding Form.
	£	s.	d.	
15. On request, not otherwise charged, under section 12 (6) or under section 32 ...	0	5	0	T.M. No. 22 or 26
16. For a search under Rule 95	0	10	0	T.M. No. 28
17. For certificate of Registrar of registration to be used in legal proceedings	1	0	0	T.M. No. 34
18. For certificate of Registrar of the registration of a trade mark to be used for the purpose of obtaining registration abroad	0	5	0	T.M. No. 33
18*a*. For certificate of Registrar of the registration of a series of marks for the purpose of obtaining registration abroad	0	10	0	T.M. No. 33
19. For certificate of Registrar other than certificate under section 17 or certificate of registration to be used in legal proceedings, or for the purpose of obtaining registration abroad	1	0	0	T.M. No. 31 or 32.
20. For certificate of Keeper of Cotton Marks	0	5	0	Cotton No.3 or 4
21. On appeal from Registrar to Board of Trade in respect of each decision appealed against by appellant	1	0	0	T.M. No. 29
22. On an application to the Registrar under section 23	5	0	0	T.M. No. 21
23. On an application to the Registrar for leave to add to or alter a single mark...	1	0	0	T.M. No. 27
23*a*. On an application to the Registrar for leave to add to or alter more than one mark of the same proprietor, the addition or alteration to be made, in each case being the same—				
For the first mark	1	0	0	T.M. No. 27
And for every other mark	0	10	0	
24. For inspecting register in connection with any particular trade mark, for every quarter of an hour	0	1	0	—

	£	s.	d.	Corresponding Form.
25. For making a search amongst the classified representations of trade marks, for every quarter of an hour...	0	1	0	—
26. For office copy of documents for every 100 words (but never less than 1s.)	0	0	4	—
27. For certifying office copies MS. or printed matter	0	10	0	—
28. In cases where the wood block or electrotype of the trade mark exceeds 2 inches in breadth or depth, or in breadth and depth—				
For every inch or part of an inch over 2 inches in breadth	0	2	0	—
For every inch or part of an inch over 2 inches in depth	0	2	0	—

The fees to be paid on any proceeding at the Manchester Branch and at Sheffield (except as specially provided above) shall be the same as for the similar proceeding at the London Office.

For the purpose of these fees (except as specially provided above) every mark of a series under section 66, of the Patents Designs and Trade Marks Act, 1883, or section 26 of this Act, shall be deemed to be a mark separately registered.

Dated this 24th day of March, 1906.

(Sd.) *D. Lloyd-George*,
President of the Board of Trade.

Approved,
(Sd.) *J. Herbert Lewis*,
Cecil Norton,
Lords Commissioners
of His Majesty's Treasury.

Second Schedule.

FORMS.

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Form TM No. 1.

Form of Authorisation.

SIR,

I beg to inform you that I have appointed of to act as my agent for

I am, Sir,

Your obedient Servant,

Address

Dated the day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 2.

Application for Registration of Trade Mark (other than Cotton Mark).

Application is hereby made for Registration of the accompanying Trade Mark in Class , in respect of in the name of of trading as who claims to be the proprietor thereof.

do not claim the registration of this Trade Mark under the special provisions of paragraph 5 of Section 9 of the Trade Marks Act, 1905, in regard to names, signatures, or words.

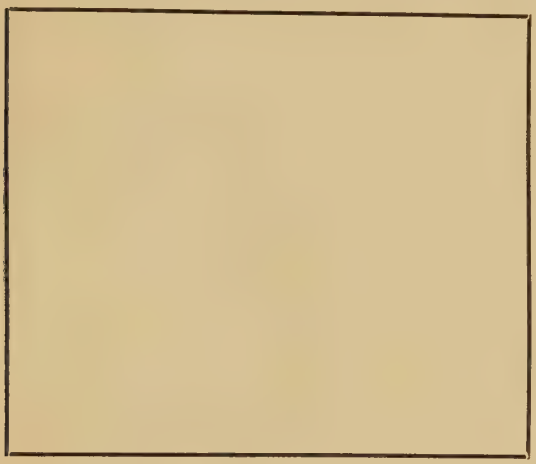
(Signed)

Dated the day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 3.

Additional Representation of Trade Mark, to accompany Application for Registration (other than Cotton Mark).



FOUR of these ADDITIONAL REPRESENTATIONS of the Trade Mark must accompany *each* Form of Application.

Form TM No. 4.

Request for Statement of Grounds of Decision under Section 12 (3).

You are hereby requested under Sub-section 3 of Section 12 of the Trade Marks Act, 1905, and Rule 33 made thereunder, to state in writing the grounds of your decision, dated the day of 19 , after the hearing on the day of 19 , and the materials used by you in arriving at such decision.

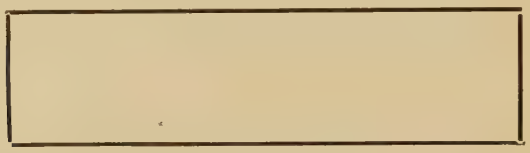
(Signed)

Dated the . day of , 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 5.

Special Application for Registration of Trade Mark under paragraph 5 of Section 9.



Application is hereby made for registration of the accompanying Trade Mark in Class , in respect of in the name of of trading as who claims to be the proprietor thereof and desires an order of the Board of Trade or the Court directing registration of the same.

(Signed)

Dated the day of , 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 6.

Special Application for Registration of Trade Mark under Section 62.

(To be accompanied by an unstamped duplicate.)

Application is hereby made for registration of the accompanying Trade Mark in Class in respect of in the name of of who desire the Board of Trade under Section 62 of the said Act to permit the registration thereof.

(Signed)

Dated the day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 7.

Notice of Opposition to Application for Registration.

(To be accompanied by an unstamped duplicate.)

In the matter of an Application, No.
by of

I hereby give notice of my intention to oppose the Registration of the Trade Mark advertised under the above number for Class in the Trade Marks Journal of the day of 19 , No. , page .

The grounds of Opposition are as follows :—

(Signed)

Dated the day of , 19 .

Address for Service :—

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 8.

Form of Counter-Statement.

To be accompanied by an unstamped duplicate.

In the matter of an Opposition,
No. , to Application,
No

I
the applicant for the above Trade Mark, hereby give notice that the following are the grounds on which I rely as supporting my application :—

I admit the following allegations in the notice of Opposition :—

Signature

Dated this day of , 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 9.

Form of Application for hearing by the Registrar in Cases of Opposition.

Sir,

In reply to your Notice dated the giving of

a date on which you will hear the arguments in the case of Oppositon No. to Application No. , I beg to say that I intend to appear before you on the date you have fixed, namely, the day of 19 .

I am,
Sir,
Your obedient Servant,

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 10.

Application is hereby made to the Board of Trade to hear the matter of the Application No. under Rule 38.

Signature

Dated this day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form O No. 1.

Notice of Non-Completion of Registration.

No.

The Registrar has to call your attention to Section 18 of the Trade Marks Act, 1905, and to Rule 62 of the Trade Marks Rules made thereunder. The Section and the Rule are printed on the back hereof.

Your application numbered as above was made on the day of 19 . Registration has not been completed by reason of your default. Unless it is completed within days from this date the application will be treated as abandoned.

Dated this day of 19 .

To

The Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 11

Fee for Registration of a Trade Mark.

SIR,

In reply to your request I hereby transmit the prescribed fee for the registration of the Trade Mark No. in Class .

I am,
Sir,
Your obedient Servant,

Signature

Dated the day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form O No. 2.

Certificate of Registration under Section 17.

To

I hereby certify, pursuant to Rule 67 of the Rules under the above Act, that the Trade Mark in your application No. was duly advertised in the Trade Marks Journal and has been registered in your name in Class , in respect of the goods specified by you.

Witness my hand this day of , 19 .

(Seal of Patent Office.)

Registrar.

The Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No 12.

Renewal of Registration before notice given.

I hereby leave the prescribed fee of for the renewal of the registration of the Trade Mark No. , in Class .

Dated the day of , 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

N.B.—This Form must be indorsed with the name and address of the person leaving the same.

Form O No. 3.

Notice before Removal of Trade Mark from the Register, under Section 30.

The Registrar hereby gives you notice that in conformity with the provisions of Section 30 of the above Act (printed at back hereof), your Trade Mark No. , registered in Class , will be removed from the Trade Marks Register unless the prescribed fee of (payable by Form TM No. 13) be received at this Office *before* the day of 19 , on which date the existing registration will expire.

A stamped Form TM No. 13, for payment of the fee, may be obtained as directed at the back of this Notice, *but cannot be obtained from this Office.*

Dated this day of 19 .

To

The Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form O No. 4.

SECOND NOTICE.

Notice before Removal of Trade Mark from the Register, under Section 30.

The Registrar hereby gives you notice that, in conformity with the provisions of Section 30 of the above Act (printed at back hereof), your Trade Mark No. , registered in Class , will be removed from the Trade Marks Register, unless the prescribed fee of (payable by Form TM No. 13) be received at this Office *before* the day of 19 , on which date the existing registration will expire.

If the above fee be not paid *before* the date above named, the Trade Mark will, after the end of one month from the date on which the omission to pay the fee has been advertised in the Trade Marks Journal, be removed from the Trade Marks Register, unless an *additional* fee of 10s. (payable by Form TM No. 14) be remitted.

Stamped Forms for payment of renewal fees may be obtained as directed at the back of this Notice, *but cannot be obtained from this Office.*

Dated this day of 19 .

To

The Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 13.

Renewal of Registration of Mark after notice.

SIR,

In pursuance of the notice received from you, I hereby transmit the prescribed fee of for Renewal of Registration of the Trade Mark No. , in Class .

Dated the day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

N.B.—This Form must be indorsed with the name and address of the person transmitting the same.

Form TM No. 14.

Additional Fee of 10*s. to accompany Renewal Fee* (*Form TM No.* 13) *within One Month after advertisement of Non-Payment of Renewal Fee.*

SIR,

In pursuance of the notices issued by you, I hereby transmit the additional fee of 10*s.* (along with Form TM No. 13) for the renewal of the Registration of the Trade Mark No. in Class .

Dated the day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

N.B.—This form must be indorsed with the name and address of the person transmitting the same.

Form TM No. 15.

Restoration of Trade Mark where removed for Non-Payment of Fee.

(To accompany Form TM No. 13.)

SIR,

In pursuance of the notices issued by you, I hereby transmit the additional fee of £1 (along with Form TM No. 13) for restoration to the Trade Marks Register of the Trade Mark No. in Class .

Dated the day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings. Chancery Lane,
London, W.C.

N.B.—This Form must be indorsed with the name and address of the person transmitting the same.

Form TM No. 16.

Joint Request by Registered Proprietor and Assignee to register the Assignee as subsequent Proprietor of a Trade Mark.

We, , of , and , of , hereby request, under Rule 76, that the name of , carrying on business as , at , may be entered in the Register of Trade Marks as proprietor of the Trade Mark No. in Class

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 17.

Form of Declaration (only to be furnished when requested by Registrar) by Assignee in support of Form TM No. 16.

I of do herely solemnly and sincerely declare that the Trade Mark No. in Class has been assigned to me by of together with the goodwill of the business concerned in the goods for which it has been registered, and that I have accepted such Assignment.

And I make this solemn declaration, conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

Declared at , this day of 19 ,

Before me

[If the declaration be made before any authority other than a Justice of the Peace, it will require to be stamped with a 2*s.* 6*d.* impressed Inland Revenue Stamp.]

Form TM No. 18.

Request to Enter Name of Subsequent Proprietor of Trade Mark upon the Register.

I, hereby request that you will enter name in the Register of Trade Marks as proprietor of the Trade Mark No. in Class .

entitled to the said Trade Mark and to the goodwill of the business concerned in the goods with respect to which the said Trade Mark is registered.

Accompanying this request is a statement of case.

Dated this day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 19.

Form of Declaration (only to be furnished when requested by Registrar) in support of Statement of Case accompanying Form TM No. 18.

I, , of , do hereby solemnly and sincerely declare that the particulars set out in the statement of case, exhibit marked and left by me in connection with my request to be registered as subsequent proprietor of the Trade Mark No. , in Class , are true, and comprise every material fact and document affecting the proprietorship of the said Trade Mark as above claimed.

And I make this solemn declaration, conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

Declared at , this day of 19 .

Before me,

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

[If the declaration be made before any authority other than a Justice of the Peace, it will require to be stamped with a 2*s.* 6*d.* impressed Inland Revenue Stamp.]

Form TM No. 20.

Notice of Application for Alteration of Address on Register of Trade Marks.

In the matter of the Trade Mark No. registered in Class .

I , of , the registered Proprietor of the Trade Mark numbered as above, desire that my address on the Register of Trade Marks be altered to

Dated this day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 21

Application to permit an Apportionment of Trade Marks.

In the matter of the Registered Trade Marks Nos.

We, being the parties interested within the meaning of Section 23 of the Trade Marks Act, 1905, in certain marks of who has ceased to carry on business, request you to permit an apportionment of those marks amongst the persons in fact continuing the business. With this application we send a case in pursuance of Rule 87.

(Signed)
(Signed)

Dated this day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 22.

Form of Request for Correction of Clerical Error or for Permission to Amend Application under Section 12 (6) *or Section* 32 (1).

Sir,

I hereby request that

Dated this day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 23.

Request to enter Change of Name of Registered Proprietor of Trade Mark upon the Register.

I, hereby request that you will enter name in the Register of Trade Marks as proprietor of the Trade Mark No. in Class

entitled to the said Trade Mark and to the goodwill of the business concerned in the goods with respect to which the said Trade Mark is registered.

There has been no change in the actual proprietorship of the said Trade Mark, but

Dated this day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 24.

Form of Application by Proprietor of Registered Trade Mark to cancel Entry on Register.

Trade Mark No. , Class , advertised in Trade Marks Journal, No. , page .

Name of Registered Proprietor

Place of Business

Description

I, the undersigned, of [*or* I, the undersigned, a member of the Firm of of on behalf of my said Firm] apply that the entry upon the Register of Trade Marks of the Trade Mark No. in Class may be cancelled.

Dated this day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 25.

Request to strike out Goods from those for which a Trade Mark is Registered.

I, of , hereby request that you will strike out from the goods for which the Trade Mark No. is registered in Class .

Dated this day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 26.

Request to enter Disclaimer or Memorandum relating to a Trade Mark.

I , of , , hereby request that you will enter in the Register in connection with Trade Mark No. in Class the following , namely :—

Dated this day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 27.

Application under Section 34 to add to or alter a Trade Mark.

In the matter of the Trade Mark
No. in Class

Application is hereby made on behalf of the registered proprietor of the Trade Mark numbered as above to alter it in the following particulars, that is to say :—

Six copies of the mark as it will appear when so altered are filed herewith.

Signed

Dated this day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 28.

Request for Search under Rule 95.

You are hereby requested to search under Rule 95 in Class to ascertain whether any Trade Marks are on record which resemble the Trade Mark sent herewith in duplicate each mounted on a half-sheet of foolscap.

Dated this day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form Sheffield No. 1.

Request to enter a Mark under Section 63, Sub-section (2).

You are hereby requested to register the accompanying Old Corporate Mark in Class in respect of in the name of , who claims to be the proprietor thereof.

(Signed)

Dated this day of 19 .

To the Cutlers' Company,
Cutlers' Hall,
Sheffield.

Cotton No. 1.

COTTON MARKS.

Application for Registration of Trade Mark.

(*See* the annexed Extracts from the Trade Marks Act.)

(To be accompanied by an unstamped duplicate of this Form, and also by four Additional Representations on Form Cotton No. 2.)

Application is hereby made for Registration of the accompanying Trade Mark in Class in respect of
in the name of
Address and description
Trading as
who claim to be the Proprietor thereof.

No claim of exclusive right is made to any of the letterpress appearing on the said Trade Mark except in so far as it consists of the applicant's own name and address, or the foreign equivalent thereof.

The said Trade Mark has not hitherto been used by the applicant upon or in connection with the above-mentioned goods, but is proposed to be so used

[*or* The said Trade Mark has been used by the applicant [$\frac{\text{and}}{\text{or}}$ by the predecessors in business of the applicant] upon or in connection with the above-mentioned goods since the 19]

(Signed)

Dated the day of 19 .

To the Keeper of Cotton Marks,
Manchester Branch of the Trade Marks Registry,
48, Royal Exchange, Manchester.

Cotton No. 2.

COTTON MARKS.

Additional Representation of Trade Mark to accompany Application for Registration.

Class
Description of Goods
Length of User (if any)
Name of Applicant
Address
Description

No claim of exclusive right is made to any of the letterpress appearing on the Mark except in so far as it consists of the applicant's own name and address or the foreign equivalent thereof.

FOUR of these ADDITIONAL REPRESENTATIONS of the Trade Mark must accompany *each* Form of Application.

Cotton No. 3.

COTTON MARKS.

Request for Certificate under Sub-section (12) *of Section* 64.

SIR,

You are hereby requested to issue a certified copy of the application numbered and dated the day of , 19 , for registration in Class of the Cotton Mark of which a facsimile is sent herewith, setting forth in such certificate the length of time of user (if any) of such Mark as stated on the application, and any other particulars you may deem necessary.

Dated this day of , 19 .

(Signed)
Address

To the Keeper of Cotton Marks,
Manchester Branch of the Trade Marks Registry,
48, Royal Exchange, Manchester.

Cotton No. 4.

COTTON MARKS.

Request for Certificate of Keeper of Cotton Marks as to a Trade Mark entered in the Manchester Register.

In the matter of the Trade Mark
No. in Class .

Sir,

I hereby request you to furnish me with your Certificate of Registration of the Mark numbered as above for use

Dated this day of 19

(Signed)

Address

To the Keeper of Cotton Marks,
Manchester Branch of the Trade Marks Registry,
48, Royal Exchange, Manchester.

MB No. 1.

COTTON MARKS.

Certificate under Sub-Section (12) *of Section* 64.

Manchester Branch of the Trade Marks Registry,
48, Royal Exchange,
Manchester.

It is hereby certified by the Keeper of Cotton Marks, that a true copy of the application numbered and dated the day of , 19 , for registration in Class of the Cotton Mark therein referred to is contained in the paper hereto annexed and that a facsimile of the said Mark is attached thereto, and that the length of time of user of such Mark as stated on the application is , and that the said Mark is on deposit at this Office.

Witness my hand and seal this day of 19 .

The Keeper of Cotton Marks.

MB No. 2.

COTTON MARKS.

General Certificate.

Manchester Branch of the Trade Marks Registry,
48, Royal Exchange,
Manchester.

It is hereby certified by the Keeper of Cotton Marks, that

REPRESENTATION OF TRADE MARK.

Witness my hand and seal this day of 19 .

The Keeper of Cotton Marks.

Form TM No. 29.

Form of Appeal from the Registrar to the Board of Trade.

I, of hereby give notice of my intention to appeal to the Board of Trade from of the Registrar of the day of 19 , whereby he

Accompanying this notice is a statement of my case for the decision of the Board of Trade.

(Signed)

Dated this day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C., and to
[Name of Opponent, if any].

Form TM No. 30.

Notice of Order of Court for Alteration or Rectification of Register of Trade Marks.

In the matter of the Trade Mark, No. , registered in Class in the name of

SIR,

Notice is hereby given that by an Order of the Court made on the day of 19 , it was directed that

An Office Copy of the Order of the Court is enclosed herewith.

Dated this day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 31.

Request for General Certificate of Registrar (other than Certificate for use in Legal Proceedings or for use in obtaining Registration abroad.)

In the matter of the Trade Mark No. in Class .

SIR,

I, of hereby request you to furnish me with your Certificate that

Signed

Dated this day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 32.

Request for Certificate of Refusal to Register a Trade Mark.

In the matter of an Application for registration of a Trade Mark, No. in Class .

SIR,

I, of the Applicant in the above matter, hereby request you to furnish me with your Certificate of Refusal to register the said Trade Mark.

Signed

Dated this day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 33.

Request for Certificate of Registration of Trade Mark for use in obtaining Registration Abroad.

In the matter of the Trade Mark
No. , registered in Class
in the name of

SIR,

I, of the registered proprietor of the above Trade Mark, hereby request you to furnish me with your Certificate of Registration for use in obtaining registration of the same in

Dated this day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Form TM No. 34.

Request for Certificate of Registration of Trade Mark to be used in Legal Proceedings.

In the matter of the Trade Mark,
No. , registered in Class
in the name of

SIR,

I, of the registered proprietor of the above Trade Mark, hereby request you to furnish me with your Certificate of Registration to be used in legal proceedings.

Dated this day of 19 .

To the Registrar,
Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

Dated this 24th day of March, 1906.

(Sd.) *D. Lloyd-George*,
President of the Board of Trade.

Third Schedule.

CLASSIFICATION OF GOODS.

	Illustrations.
	Note.—Goods are mentioned in this column by way of illustration, and not as an exhaustive list of the contents of a class.
Class 1.	
Chemical substances used in manufactures, photography, or philosophical research, and anti-corrosives.	Such as— Acids, including vegetable acids. Alkalies. Artists' colours. Pigments. Mineral dyes.
Class 2.	
Chemical substances used for agricultural, horticultural, veterinary, and sanitary purposes.	Such as— Artificial manure. Cattle medicines. Deodorizers. Vermin destroyers.
Class 3.	
Chemical substances prepared for use in medicine and pharmacy.	Such as— Cod liver oil. Medicated articles. Patent medicines. Plasters. Rhubarb.
Class 4.	
Raw or partly prepared vegetable, animal, and mineral substances used in manufactures, not included in other classes.	Such as— Resins. Oils used in manufactures and not included in other classes. Dyes, other than mineral. Tanning substances. Fibrous substances (*e.g.*, cotton, hemp, flax, jute). Wool. Silk. Bristles. Hair. Feathers. Cork. Seeds. Coal. Coke. Bone. Sponge.

CLASSIFICATION OF GOODS—*continued.*

CLASS 5.	
Unwrought and partly wrought metals used in manufacture.	Such as— Iron and steel, pig or cast. Iron, rough. ,, bar and rail, including rails for railways. ,, bolt and rod. ,, sheet and boiler and armour plates. ,, hoop. Lead, pig. ,, rolled. ,, sheet. Wire. Copper. Zinc. Gold, in ingots.
CLASS 6.	
Machinery of all kinds and parts of machinery, except agricultural and horticultural machines included in Class 7.	Such as— Steam engines. Boilers. Pneumatic machines. Hydraulic machines. Locomotives. Sewing machines. Weighing machines. Machine tools. Mining machinery. Fire engines.
CLASS 7.	
Agricultural and horticultural machinery, and parts of such machinery.	Such as— Ploughs. Drilling machines. Reaping machines. Thrashing machines. Churns. Cyder presses. Chaff cutters.
CLASS 8.	
Philosophical instruments, scientific instruments, and apparatus for useful purposes. Instruments and apparatus for teaching.	Such as— Mathematical instruments. Gauges. Logs. Spectacles. Educational appliances.
CLASS 9.	
Musical instruments.	
CLASS 10.	
Horological instruments.	

CLASSIFICATION OF GOODS—*continued.*

CLASS 11.	
Instruments, apparatus, and contrivances, not medicated, for surgical or curative purposes, or in relation to the health of men or animals.	Such as— Bandages. Friction gloves. Lancets. Fleams. Enemas.
CLASS 12.	
Cutlery and edge tools.	Such as— Knives. Forks. Scissors. Shears. Files. Saws.
CLASS 13.	
Metal goods not included in other classes.	Such as— Anvils. Keys. Basins (metal). Needles. Hoes. Shovels. Corkscrews.
CLASS 14.	
Goods of precious metals (including aluminium, nickel, Britannia metal, &c.), and jewellery, and imitations of such goods and jewellery.	Such as— Plate. Clock cases and pencil cases of such metals. Sheffield and other plated goods. Gilt and ormolu work.
CLASS 15.	
Glass.	Such as— Window and plate glass. Painted glass. Glass mosaic. Glass beads.
CLASS 16.	
Porcelain and earthenware.	Such as— China. Stoneware. Terra Cotta. Statuary porcelain. Tiles. Bricks.

CLASSIFICATION OF GOODS—*continued.*

CLASS 17.	
Manufactures from mineral and other substances for building or decoration.	Such as— Cement. Plaster. Imitation marble. Asphalte.
CLASS 18.	
Engineering, architectural, and building contrivances.	Such as— Diving apparatus. Warming apparatus. Ventilating apparatus. Filtering apparatus. Lighting contrivances. Drainage contrivances. Electric and pneumatic bells.
CLASS 19.	
Arms, ammunition, and stores not included in Class 20.	Such as— Cannon. Small-arms. Fowling pieces. Swords, Shot and other projectiles. Camp equipage. Equipments.
CLASS 20.	
Explosive substances.	Such as— Gunpowder. Gun-cotton. Dynamite. Fog-signals. Percussion caps. Fireworks. Cartridges.
CLASS 21.	
Naval architectural contrivances and naval equipments not included in Classes 19 and 20.	Such as— Boats. Anchors. Chain cables. Rigging.
CLASS 22.	
Carriages.	Such as— Railway carriages. Waggons, Railway trucks. Bicycles. Bath chairs.

CLASSIFICATION OF GOODS—*continued.*

CLASS 23.	
(*a*) Cotton yarn. (*b*) Sewing cotton.	
CLASS 24.	
Cotton piece goods of all kinds.	Such as— Cotton shirtings. Long cloth.
CLASS 25.	
Cotton goods not included in Classes 23, 24, or 38.	Such as— Cotton lace. Cotton braids. Cotton tapes.
CLASS 26.	
Linen and hemp yarn and thread.	
CLASS 27.	
Linen and hemp piece goods.	
CLASS 28.	
Linen and hemp goods not included in Classes 26, 27, and 50.	
CLASS 29.	
Jute yarns and tissues, and other articles made of jute not included in Class 50.	
CLASS 30.	
Silk, spun, thrown, or sewing.	
CLASS 31.	
Silk piece goods.	
CLASS 32.	
Other silk goods not included in Classes 30 and 31.	
CLASS 33.	
Yarns of wool, worsted, or hair.	

CLASSIFICATION OF GOODS—*continued.*

CLASS 34.	
Cloths and stuffs of wool, worsted or hair.	
CLASS 35.	
Woollen and worsted and hair goods not included in Classes 33 and 34.	
CLASS 36.	
Carpets, floor-cloth, and oil-cloth.	Such as— Drugget. Mats and matting. Rugs.
CLASS 37.	
Leather, skins unwrought and wrought, and articles made of leather not included in other classes.	Such as— Saddlery. Harness. Whips. Portmanteaus. Furs.
CLASS 38.	
Articles of clothing.	Such as— Hats of all kinds. Caps and bonnets. Hosiery. Gloves. Boots and shoes. Other ready-made clothing.
CLASS 39.	
Paper (except paper-hangings), stationery, and bookbinding.	Such as— Envelopes. Sealing wax. Pens (except gold pens). Ink. Playing cards. Blotting cases. Copying presses.
CLASS 40.	
Goods manufactured from india-rubber and gutta-percha not included in other classes.	

CLASSIFICATION OF GOODS—*continued.*

CLASS 41.	
Furniture and upholstery.	Such as— Paper-hangings. Papier mâché. Mirrors. Mattresses.
CLASS 42.	
Substances used as food, or as ingredients in food.	Such as— Cereals. Pulses. Olive oil. Hops. Malt. Dried fruits. Tea. Sago. Salt. Sugar. Preserved meats. Confectionery. Oil cakes Pickles. Vinegar. Beer clarifiers.
CLASS 43.	
Fermented liquors and spirits.	Such as— Beer. Cyder. Wine. Whisky. Liqueurs.
CLASS 44.	
Mineral and aërated waters, natural and artificial, including ginger beer.	
CLASS 45.	
Tobacco, whether manufactured or unmanufactured.	
CLASS 46.	
Seeds for agricultural and horticultural purposes.	

CLASSIFICATION OF GOODS—*continued.*

CLASS 47.

Candles, common soap, detergents; illuminating, heating or lubricating oils; matches, and starch, blue, and other preparations for laundry purposes.	Such as— Washing powders. Benzine collas.

CLASS 48.

Perfumery (including toilet articles, preparations for the teeth and hair, and perfumed soap).	

CLASS 49.

Games of all kinds and sporting articles not included in other classes.	Such as— Billiard tables. Roller skates. Fishing nets and lines. Toys.

CLASS 50.

Miscellaneous— (1.) Goods manufactured from ivory, bone or wood, not included in other classes. (2.) Goods manufactured from straw or grass, not included in other classes. (3.) Goods manufactured from animal and vegetable substances, not included in other classes. (4.) Tobacco pipes. (5.) Umbrellas, walking sticks, brushes, and combs. (6.) Furniture cream, plate powder. (7.) Tarpaulins, tents, rick-cloths, rope, twine. (8.) Buttons of all kinds other than of precious metal or imitations thereof. (9.) Packing and hose of all kinds. (10.) Goods not included in the foregoing classes.	Such as— Coopers' wares.

Dated this 24th day of March, 1906.

(Sd.) *D. Lloyd-George,*
President of the Board of Trade.

APPENDIX B.

APPENDIX B.

INSTRUCTIONS TO PERSONS WHO WISH TO REGISTER TRADE MARKS.

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1.—General.

It is advisable in the first instance for a person who desires to register a Trade Mark to buy a copy of the Trade Marks Rules, 1906, and of the Trade Marks Act of 1905 now governing the registration of Trade Marks. For information as to obtaining copies of the Rules and Act, *see* paragraph 26.

2.—Who may Apply for Registration of a Trade Mark.

Any person claiming to be the proprietor of a Trade Mark, whether a British subject or not, may make an application for the Registration of a Trade Mark in the United Kingdom.

The term "person" includes firm, partnership, and body corporate.

Any person who has made a previous application for Registration of a Trade Mark, which is registrable under the Trade Marks Act, 1905, either in any of the Foreign States or in any of the British Possessions (*see* paragraph 24) with which certain arrangements for mutual protection of Trade Marks have been made, may obtain priority of date in the United Kingdom, provided that the application is made within four months from the date of the application in such Foreign State or British Possession.

3.—What may be Registered as a Trade Mark.

Section 9 of the Trade Marks Act, 1905, provides as follows:—

9. A registrable trade mark must contain or consist of at least one of the following essential particulars:—

(1) The name of a company, individual, or firm represented in a special or particular manner;

(2) The signature of the applicant for registration or some predecessor in his business;

(3) An invented word or invented words;

(4) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;

(5) Any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the above paragraphs (1), (2), (3), and (4), shall not, except by order of the Board of Trade or the Court, be deemed a distinctive mark:

Provided always that any special or distinctive word or words, letter, numeral, or combination of letters or numerals used as a trade mark by the applicant or his predecessors in business before the thirteenth day of August one thousand eight hundred and seventy-five, which has continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to the date of the application for registration shall be registrable as a trade mark under this Act.

For the purposes of this section "distinctive" shall mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons.

In determining whether a trade mark is so adapted, the tribunal may, in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered such trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered.

4.—Manner of Applying for Registration of a Trade Mark.

All applications and communications must be made in the English language.

Applications relating to Marks not being Cotton Marks or Sheffield Marks must be left at the Patent Office by hand or sent by post addressed to the Registrar, The Patent Office, Trade Marks Branch, 25, Southampton Buildings, London, W.C.

In the case of Cotton Marks, applications should be addressed to the Keeper of Cotton Marks, Manchester Branch of the Trade Marks Registry, 48, Royal Exchange, Manchester (*see* paragraph 19).

In the case of Sheffield Marks, applications should be addressed to the Law Clerk to the Cutlers' Company, The Cutlers' Hall, Sheffield (*see* paragraph 18).

Applicants must use the appropriate Stamped Forms (*see* paragraph 5), as fees cannot be received by cheque or money order or in cash at the Patent Office.

5.—Trade Mark Forms and Fees.

The following is a List of the Forms under the Trade Marks Act, 1905, and of the principal Fees:—

Number of Form.	Title of Form.	Fee. £ s. d.
TM No. 1	Form of authorisation of Agent	—
TM No. 2	Application for registration of Trade Mark	0 10 0
TM No. 3	Additional Representation of Trade Mark	No stamp.
TM No. 4	Request for statement of grounds of decision under section 12 (3)	0 10 0
TM No. 5	Application for registration of Trade Mark under section 9 (5)	0 10 0
TM No. 6	Application for registration of Special Trade Mark under section 62... ...	0 10 0
TM No. 7	Notice of Opposition to application for registration	1 0 0
TM No. 8	Counter-statement to opposition to application for registration	0 10 0
TM No. 9	Application for hearing in cases of opposition	1 0 0
TM No. 10	Application to the Board of Trade for hearing under Rule 38	1 0 0
TM No. 11	Fee for Registration of a Trade Mark ...	1 0 0
TM No. 12	Renewal of Registration before notice has been given by Registrar	1 0 0
TM No. 13	Renewal of Registration after notice has been given by Registrar	1 0 0
TM No. 14	Additional fee to accompany renewal fee within one month after advertisement of non-payment of renewal fee ...	0 10 0
TM No. 15	Restoration of Trade Mark where removed for non-payment of fee ...	1 0 0
TM No. 16	Joint request by registered proprietor and assignee to register assignee as subsequent proprietor	1 0 0
TM No. 17	Form of Declaration (only to be furnished when requested by Registrar) by assignee in support of Form TM No. 16	—
TM No. 18	Request to enter name of subsequent proprietor upon register	1 0 0

Number of Form.	Title of Form.	Fee. £ s. d.
TM No. 19	Form of Declaration (only to be furnished when requested by Registrar) in support of Statement of Case accompanying Form TM No. 18	—
TM No. 20	Application for alteration of address on Register	0 5 0
TM No. 21	Application to permit an apportionment of Trade Marks	5 0 0
TM No. 22	Request for correction of clerical error or amendment of application	0 5 0
TM No. 23	Request to enter change of name of registered proprietor	0 5 0
TM No. 24	Application to cancel entry on register ...	0 5 0
TM No. 25	Request to strike out goods from those for which a mark is registered ...	0 5 0
TM No. 26	Request to enter disclaimer or memorandum	0 5 0
TM No. 27	Application to add to or alter a Trade Mark	1 0 0
TM No. 28	Request for search under Rule 95 ...	0 10 0
TM No. 29	Appeal from Registrar to Board of Trade	1 0 0
TM No. 30	Notice of Order of Court for alteration of Register	0 10 0
TM No. 31	Request for general certificate	1 0 0
TM No. 32	Request for certificate of refusal to register	1 0 0
TM No. 33	Request for certificate of registration for use in obtaining registration abroad...	0 5 0
TM No. 34	Request for certificate of registration for use in legal proceedings	1 0 0
	For office copies every 100 words, but never less than one shilling	0 0 4
	For certifying office copies MS. or printed matter	0 10 0
	An additional stamp duty of one shilling is also charged under the Stamp Act upon certified copies of certain documents.	

These Stamped Forms are not supplied by the Patent Office, but can be purchased on personal application at the Inland

Revenue Office, Royal Courts of Justice (Room No. 6), Strand, London, W.C., or, at a few days' notice and upon pre-payment of the value of the stamp, at any Money Order Office in the United Kingdom.

If it should not be convenient to apply in either of the ways above specified, the Stamped Forms can be ordered by post from the Controller of Stamps (Room No. 5), Inland Revenue Office, Somerset House, London, W.C. In this case a bankers' draft or a Money or Postal Order payable to the Commissioners of Inland Revenue and crossed Bank of England, to cover the value of the stamp and the cost of transmitting the Form in a registered envelope by post, must be forwarded to Somerset House with the application for the Form. Cheques will not be accepted.

Forms bearing the numbers TM No. 2, TM No. 3, and TM No. 11 are kept in stock at the following Post Offices in London :—

The General Post Office, E.C.

District Post Office, Lombard Street, E.C.

,, 195, Whitechapel Road, E.

,, 239, Borough High Street, S.E.

,, Charing Cross, W.C.

,, 28, Eversholt Street, Camden Town, N.W.

Post Office, 12, Parliament Street, S.W., and

The Chief Post Office of the undermentioned cities and towns :—

In England and Wales.

Accrington.	Burnley.	Dewsbury.
Altrincham.	Burslem.	Doncaster.
Ashton-under-Lyne.	Burton-on-Trent.	Dorchester.
Barnsley.	Bury.	Driffield.
Barrow-in-Furness.	Cambridge.	Droitwich.
Bath.	Cardiff.	Dudley.
Bedford.	Carlisle.	Durham.
Beverley.	Chatham.	Exeter.
Birkenhead.	Chester.	Gateshead.
Birmingham.	Clitheroe.	Goole.
Blackburn.	Congleton.	Greenwich.
Bolton.	Coventry.	Guildford.
Bradford.	Crewe.	Halifax.
Brighton.	Croydon.	Hartlepool.
Bristol.	Darlaston.	Huddersfield.
Bromsgrove.	Derby.	Hull.

Ipswich.
Keighley.
Kendal.
Kidderminster.
Knaresbro'.
Knutsford.
Lancaster.
Leamington.
Leeds.
Leicester.
Lichfield.
Lincoln.
Liverpool.
Macclesfield.
Manchester.
Middlesbrough.
Nantwich.
Newcastle.
Newport (Mon.).
Northallerton.
Northampton.
Nottingham.
Nuneaton.
Oldbury.
Oldham.
Patrington.
Plymouth.
Pontefract.
Portsmouth.
Prescot.
Preston.
Reading.
Redditch.
Richmond (Yorks).
Ripon.
Rochdale.
Rotherham.
Rugby.
Salford.
St. Helens.
Scarborough.
Sedgley.
Sheffield.
Southampton.
Stafford.
Stalybridge.
Stockport.
Stoke-on-Trent.
Stourbridge.
Stourport.
Sunderland.
Swansea.
Tamworth.
Truro
Tunstall.
Wakefield.
Walsall.
Warrington.
Wednesbury.
West Bromwich.
Whitby.
Widnes.
Wigan.
Wolverhampton.
Wolverton.
Woolwich.
York.

In Scotland.

Aberdeen.
Dumbarton.
Dundee.
Edinburgh.
Glasgow.
Greenock.
Inverness.
Lanark.
Leith.
Paisley.
Perth.
Renfrew

In Ireland.

Belfast.
Cork.
Dublin.
Dundalk.
Galway.
Limerick.
Londonderry.
Waterford.
Wexford.

6.—Documents, &c., Required on Application for Registration of a Trade Mark.

An application for the Registration of a Trade Mark, under paragraphs 1 to 4 of Section 9, *see* paragraph 3, must be made on an Application Form (Form TM No. 2) bearing an impressed stamp

of 10s. (*see* paragraph 5). In the case of an application under Section 9 (5) Form TM No. 5 must be used.

(The Applicant should, before filling up the form, carefully read the marginal notes.)

Four Additional Representations of the Trade Mark, each mounted on Form TM No. 3, should accompany every application on TM No. 2 (*see* paragraph 5).

A *separate* Application Form is required for *each* class in cases where the same Trade Mark is claimed in more than one class of goods.

If the Mark be the property of a Firm or Partnership, the Form TM No. 2 should be signed by some one or more members of such Firm or Partnership, who should add, after his or their signature, "A Member of the Firm" or "Members of the Firm" (as the case may be); if of a Body Corporate, by a Director or by the Secretary or other Principal Officer, who should add, after his signature and designation, "For the Company."

Applications may be made by Agents in the names of and on behalf of the owners of Trade Marks. The Agent must be duly authorised in writing, in the Form TM No. 1, by the owner or owners; the Authority to an Agent should be signed by the owner or owners; in the case of a Firm, Partnership, or Body Corporate, the Authority should be signed in the same manner as indicated in the paragraph next above.

Each application made by an Agent should have, after the signature of the Agent, the description "Agent."

When an Applicant, or his authorised Agent, for the Registration of a Trade Mark, otherwise than under an International Convention, resides out of the United Kingdom at the time of making the Application, an Address for Service in the United Kingdom must be given in the application.

When the Mark consists of or includes words printed in other than Roman characters, there should be given upon the Forms a translation and a transliteration of such words, signed by the Applicant or his Agent.

In the case of Marks claimed in the Cotton Classes and Class 34, the Applicant should state by what name the particular Mark claimed would be referred to in the invoices of his house.

The Representations of the Mark on the Form TM No. 3 must agree *in every respect* with each other, and with that on the Form TM No. 2.

Representations of a Mark of a large size may be folded. In that case they must, however, be backed with linen, tracing cloth, or other suitable material and firmly affixed to the forms. Representations must in no case be executed *in pencil*. They should be not only of a durable nature, but of such a kind as will admit of their being preserved and bound together in volumes as records of the property of the owners. Photographs are not, as a rule, therefore, acceptable.

7.—Word Marks.

In most of the Classes, except the Cotton Classes, Word Marks are very popular. Speaking broadly, the Act debars from Registration three kinds of words: (1) Geographical names; (2) surnames; (3) descriptive words; and it is frequently difficult to decide whether any given word falls under any of these heads. Cases often happen in which a person thinks he has invented a word, and yet on investigation it is found that such a word already exists, and falls under one of the heads above-mentioned.

Again, though a given word may, after argument, be decided not to fall under one of the forbidden heads, yet the matter is so much on the border-line that much discussion can be raised before a final decision is reached.

It is very greatly to the advantage of a person adopting a new Word Mark—it being immaterial to him what word he adopts—to choose a word open to little or no discussion, and which clearly falls within paragraphs 3 or 4 of the ninth section of the Act. The Registrar will give what assistance he can on this subject, and it is suggested that an Applicant desirous of adopting a new Word Mark should, before doing so, submit by letter a word, such as he thinks will suit his purpose, for the Registrar's consideration. The Registrar will of course only express an opinion as to how far a word submitted is within the section, and will make no search for the purpose of ascertaining whether any other person has a similar Registered Mark, unless a search fee is paid.

8.—Search.

A person wishing to adopt a Trade Mark may make application to the Registrar in writing upon a Form TM No. 28, to cause a Search to be made to ascertain whether any Marks are on record at the date of such Search which may resemble the proposed Mark, and the applicant will be informed of the result of such Search. The Request on Form TM No. 28 should be accompanied by two representations of the proposed Mark, each mounted on a half-sheet of foolscap.

A person may, however, search amongst the classified representations of Trade Marks at the Trade Marks Branch of the Patent Office, if he so desire. The Index includes a general collection of Marks, a divisional Index of Devices, and an alphabetically arranged Index of Words appearing as parts of Trade Marks or alone. It must not be assumed, however, that all words contained in this index are protected by registration.

The fee payable by a person making a search is 1*s.* for every quarter of an hour.

Complete Searches amongst classified collections of Marks in the *Cotton Classes* (Classes 23, 24 and 25) can only be made at the Manchester Branch Office, 48, Royal Exchange, Manchester. *See* paragraph 19.

9.—Series of Trade Marks.

By Section 26 of the Act, when a person claiming to be the proprietor of several Trade Marks for the same description of goods which, while resembling each other in the material particulars thereof, yet differ in respect of—

(*a*) statements of the goods for which they are respectively used or proposed to be used; or

(*b*) statements of number, price, quality, or names of places; or

(*c*) other matter of a non-distinctive character which does not substantially affect the identity of the Trade Mark; or

(*d*) colour;

seeks to register such Trade Marks, they may be registered as a series in one registration.

When an application is made for a series, a representation of each of the Marks of the series must be affixed to Form TM No. 2, and also to each of the Forms TM No. 3.

10.—Old Marks.

In order that an application for an "Old Mark" may be treated as such, there must have been continuous uses, since before the date mentioned in paragraph 3, in the United Kingdom and in connexion with the goods stated in the application. An applicant for such a Mark should state how, *i.e.*, whether as a label, by branding or embossing or in any other manner, the Mark has been so used. The Registrar may require a declaration verifying the statements made in such an application.

11.—Procedure on Receipt of Application.

As soon as may be following the receipt of an application and after due consideration and search, the Registrar will communicate the result to the Applicant in writing.

12.—Non-completion of Registration of a Trade Mark.

When Registration is not completed within twelve months from the date of the application by reason of default on the part of the Applicant, the application may, after notice duly given, be treated as abandoned, unless it be completed within the time specified in such notice.

13.—Duration of Registration and Payment of Renewal Fees.

Registration of a Trade Mark is for a period of 14 years from the date of the original application, but may be renewed from time to time on payment of the prescribed fee.

Each renewal is for 14 years.

The fee for renewal should be paid in due time by lodging the proper Form as directed by the Rules.

If the renewal fee is not paid in due time, extra cost is incurred, and, possibly, the registration may entirely lapse.

14.—Classification of Goods.

A Guide to the Classification of Goods under the Trade Marks Rules can be obtained on application at The Patent Office, Trade Marks Branch, and should be asked for if the Applicant feels any difficulty in determining to which of the Classes set out in the Third Schedule to the Rules the goods for which he uses his Mark belong.

15.—Advertisement in the Trade Marks Journal.

A Trade Mark cannot in any case be entered upon the Register until after the expiration of one month from the date of its advertisement in the Journal.

A Wood-block or Electrotype must be furnished for each Mark (even though the Mark consists only of a word or words) in each Class claimed, except in the case of the Cotton Classes, for which no Blocks are required.

No Block or Electrotype shall be forwarded until a formal demand for it is sent by the Registrar.

In the case of a "Series" of Trade Marks differing only in respect of the particulars mentioned in Section 26 of the Act, a Wood-block or Electrotype must, if the Registrar so require, be furnished for each Mark in the series.

The Wood-blocks or Electrotypes furnished must correspond *exactly* with the representations, must afford *perfectly distinct* impressions of the Marks, and must be upon a scale sufficiently large to reproduce the Marks faithfully. Worn or mutilated Blocks or Electrotypes cannot be accepted. It is found in practice that Zincotypes or Process Blocks do not, as a rule, yield impressions distinct enough for the purposes of this Journal, and a great number of such blocks have to be returned as unsuitable. It is generally found that the most suitable blocks are Wood-blocks or Electrotypes.

In the case of Word Marks the words on the Block should be in plain block type.

The largest space available for the insertion of any single Block or Electrotype is five and a half inches broad by seven and a half inches deep.

When a Block or Electrotype *exceeds two inches in breadth or depth, or in breadth and depth*, a charge for additional space is made, at the rate of two shillings for every inch or part of an inch over two inches in breadth, and for every inch or part of an inch over two inches in depth.

The Official Number given by the Registrar to a Mark should *not* be cut on the face of the Block or Electrotype, but should be *marked upon the side* in such a manner as to secure identification.

All Blocks or Electrotypes should be sent to the Patent Office, Trade Marks Branch, together with the paper marked "Form R. Adv. 3," and with the representation of the Mark sent for the guidance of the Applicant in preparing the Block or Electrotype.

After the advertisement of a Trade Mark the Block or Electrotype supplied for such advertisement cannot in any case be returned to Applicants, even for temporary use.

16.—Restrictions on Registration.

Ornamental or coloured groundwork, such as tartans or checks, cannot be claimed as part of a Mark unless such groundwork be included within the Mark by some border or lines.

Applications may be refused in cases where the following appear upon the Representations of Trade Marks forming part of an application :—

(*a*) The words "Patent," "Patented," "By Royal Letters Patent," "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is Forgery," or words to like effect.

(*b*) Representations of Their Majesties or of any Member of the Royal Family.

The following also may not appear on Trade Marks, the registration of which is applied for, unless the Marks have been used since before 13th August, 1875 :—

(*a*) The Royal Arms or Royal Crests, or Arms or Crests so nearly resembling them as to lead to mistake.

(*b*) British Royal Crowns.

(*c*) British National Flags.

(*d*) The word "Royal" or any other words, letters, or devices calculated to lead persons to think that the applicant has Royal patronage or authorisation.

In cases where the following appear on a Mark, the Registrar may call for such justification as he may deem necessary for their use :—

Representation of the Arms of a Foreign State or Place.

In cases where the following appear on a Mark, the Registrar may require to be furnished with consents from such officials, persons, or their legal representatives as he may consider necessary :—

(*a*) Representations of the Arms or Emblems of any City, Borough, Town, Place, Society, Body Corporate, or Institution.

(*b*) Names or Representations of Living Persons or Persons recently dead.

Where there appears on the face of a Trade Mark the name or a description of the goods to which the Mark is applied, the Registrar may refuse to register such Mark in respect of any goods other than the goods so named or described. Where the name or description of any goods appears on a Trade Mark, which name or description in use varies, the applicant should state in his application that the name or description varies.

17.—Oppositions.

Notice of Opposition to the Registration of a Trade Mark (*see* Rules, Form TM No. 7) must be filed within one month from the date of advertisement of the Mark in the Journal, accompanied by an unstamped duplicate.

The applicant's Counter-statement, Form TM No. 8, accompanied by an unstamped duplicate, must be filed within one month from the date of receipt by him of the duplicate Notice of Opposition.

The opponent's Evidence, in support of the opposition, must be filed within one month from the date of receipt by him of the duplicate counter-statement, and copy of such Evidence must be forthwith sent to the applicant.

The applicant's Evidence must be filed within one month from the receipt of the copies of the applicant's Evidence, and a copy of such Evidence must be forthwith sent to the opponent.

The opponent's Evidence in Reply must be filed within fourteen days from the receipt of the copies of the applicant's Evidence, and a copy of such evidence must be forthwith sent to the applicant.

On the completion of the Evidence, a Hearing is appointed by the Registrar. Each party attending the Hearing must lodge the Hearing Fee Form (Form TM No. 9, with £1 stamp).

18.—Cutlers' Company.

By Section 63 of the Act, Application for the Registration of Trade Marks used on Metal Goods shall, if made by a person carrying on business in Hallamshire or within six miles thereof, be made to the Cutlers' Company of Sheffield. *See* Rules 107 to 112.

Applications made to the Cutlers' Company in pursuance of Section 63 of the Act should be made on Form TM No. 2, the address in the left-hand corner to be "To the Cutlers' Company, Sheffield," instead of "To the Registrar," and should be left at, or sent by post to, the Cutlers' Hall, Sheffield.

Each Application should be accompanied by an unstamped copy on an Application Form TM No. 2. *See* Rule 107.

Requests to enter Old Corporate Marks on the Sheffield Register, under Section 63 (2), should be made on Form Sheffield No. 1.

Applications sent by post should be addressed—

The Law Clerk to the Cutlers' Company,
The Cutlers' Hall, Sheffield.

19.—Manchester Branch.

By Section 64 of the Act, Application for the Registration of Cotton Marks should be made to the Manchester Branch on Form Cotton No. 1. It should be accompanied by an unstamped duplicate of the Form, and also by four additional representations on Form Cotton No. 2.

These forms can be obtained at the Chief Post Office, Manchester, and at the Inland Revenue Office, Royal Courts of Justice, London, Room No. 6.

Applications sent by post should be addressed:—

The Keeper of Cotton Marks,
Manchester Branch of the Trade Marks Registry,
48, Royal Exchange, Manchester.

Searches can be made at the Manchester Branch on payment of 1*s.* for each quarter of an hour for Marks in the Cotton Classes.

20.—Certificates.

The Registrar's Certificate in relation to a Trade Mark is of four kinds, viz.:—

(i.) Of Registration for use in Legal Proceedings.

(ii.) Of Registration for use in obtaining Registration Abroad.

(iii.) Of any application made and of proceedings thereon.

(iv.) Of refusal to register a Mark in use since before 13th August, 1875, and not registrable.

A person desirous of obtaining any of the above Certificates should forward Form TM No. 34, Form TM No. 33, Form TM No. 31, or Form TM No. 32 (*see* paragraph 5), as the case may be, to the Registrar, giving the Registrar's Official Number of the Mark and the Class, and stating whether the Certificate is required for use in legal proceedings, or for use in applying for the registration of the Mark abroad, or for what other purpose.

In every case where a certificate is required in respect of a Cotton Mark, or in respect of any Trade Mark of which the representations or specimens forming part of the application for registration are *coloured*, or in respect of an application made, or in respect of an application refused, two unmounted copies of the Mark must be supplied, agreeing *in every respect* with the representations forming part of the Application for Registration.

Special attention should be paid to this requirement, as the Certificate cannot in any such case be prepared until these unmounted copies are received.

21.—Inspection of Register and Copies of Entries.

The fee payable by a person inspecting the register in connection with any particular Trade Mark is 1*s.* for every quarter of an hour.

Copies of any entry in the register can be supplied at the rate of 4*d.* for every 100 words, with a minimum charge of 1*s.*

22.—Registration of Subsequent Proprietors of Registered Trade Marks.

The Request to be made by a Subsequent Proprietor on application for the Registration in his name of a Registered Trade Mark must be made on Form TM No. 16 or Form TM No. 18 (*see* paragraph 5), as the case may be. In the case of a Firm or Partnership the Declaration may be made by one member of the Firm or Partnership. In the case of a Body Corporate the Declaration should be made by a Director or by the Secretary or a Principal Officer of such Body Corporate.

If the Registrar considers it necessary he may require a Declaration on Form TM No. 17 or Form TM No. 19 to be furnished in support of the request.

Where a person becomes entitled to the goodwill of a business, he should forthwith ascertain what Registered Marks have been in use in that business, and at the earliest possible moment get those Marks transferred into his name on the Register. The mere possession of the Certificates of Registration is quite insufficient.

23.—Miscellaneous Matters relating to Trade Marks and the Patent Office.

(*a.*) *Advice on Trade Mark Matters, &c.*—The Patent Office does not undertake to give legal advice or opinions on questions of infringement or on any subject connected with Trade Mark Law which, like other Laws, is left to the interpretation of professional men.

(*b.*) The Registrar cannot recommend any particular Agent for employment by Applicants. A List of Registered Patent Agents who, as a rule, also transact Trade Mark business, may be obtained from Messrs. Eyre and Spottiswoode, East Harding Street, Fleet Street, London, E.C., and 32, Abingdon Street, Westminster, London, S.W., or through any bookseller. Price (including postage) 1*s.* 1*d.*

(*c.*) *Application for Reduction of Fees.*—It is not within the power of the Registrar to comply with any request for the reduction or remission of any of the fees required by the Trade Mark Law.

(*d.*) *Use of the word "Registered."*—Any person who represents that a Trade Mark is registered which is not so is liable for every offence on summary conviction to a fine not exceeding five pounds.

A person is deemed, for the purposes of the Trade Marks Act, 1905, to represent that a Trade Mark is registered if he uses in connection with the Trade Mark the word "Registered" or any words expressing or implying that registration has been obtained for the Trade Mark (*see* Section 67 of the Trade Marks Act, 1905).

(*e.*) *Patent Medicines.*—Communications with respect to the preparation and supply of Medicine Stamps appropriated to a particular medicine, or as to the liability to Stamp Duty of so-called "Patent Medicines," should be addressed to the Secretary (Stamps and Taxes), Inland Revenue, Somerset House, London, W.C.

(*f.*) *Mere Trading Names.*—Mere trading names or names given to business premises cannot be registered at the Patent Office.

24.—International and Colonial Arrangements.

An International Convention for the protection of Industrial Property exists between the following States:—

Belgium.
Brazil.
Cuba.
Denmark with the Faröe Islands.
France with Algeria and Colonies.
Germany.
Great Britain with New Zealand and Queensland.
Italy.
Japan.
Mexico
Netherlands with the Dutch East Indies, Surinam and Curaçoa.
Norway.
Portugal with the Azores and Madeira.
Santo Domingo
Servia.
Spain.
Sweden.
Switzerland.
Tunis.
United States of America.

Copies of the Text of the Convention and of the Additional Act modifying the Convention, may be purchased for 2*d.* and 1*d.*, respectively, from Messrs. Eyre & Spottiswoode, East Harding Street, Fleet Street, London, E.C., and 32, Abingdon Street, Westminster, London, S.W., or through any bookseller.

Under this Convention, an applicant for a Trade Mark in any one of the contracting States may obtain priority of date in any one of the other States.

Similar arrangements, for the mutual protection of Trade Marks, have been made between Great Britain on the one side, and each of the following States and Colonies on the other :—

Ecuador.
Greece.
Honduras.
Paraguay.
Roumania.
Tasmania.
Uruguay.
Western Australia.

The above List may of course be varied from time to time.

25.—Applications for the Registration of Trade Marks in the British Colonies and Foreign States.

Applications for the registration of Trade Marks in the Colonies and Foreign States must be made to the Government of the Colony or Foreign State in which protection is desired. A collection of Colonial and Foreign Trade Mark Laws and Rules may be seen in the Free Library of the Patent Office.

26.—Sale of Official Publications.

Copies of the Act and of the Rules can be purchased at the Sale Branch of the Patent Office. The price of the Act and Rules together is 8*d.*, postage, 2½*d.*; of the Act alone, 3*d.*, postage, 1*d.*; and, of the Rules alone, 5*d.*, postage, 1½*d.* Sums exceeding 5*d.* should be remitted by Postal Order or Post Office Order.

Copies of the *Trade Marks Journal* may also be obtained from the Sale Branch of the Patent Office.

The price of the *Trade Marks Journal* is :—

Nos. 1 to 509 (Years 1876 to 1887)	...	1*s. per number.*
Nos. 510 to 561 (Year 1888)	... ...	1*s.* 6*d.* ,,
No. 562 and following Nos. from 1 January, 1889		6*d.* ,,

27.—Patent Office Library.

The Free Public Library of the Patent Office, 25, Southampton Buildings, Chancery Lane, London, W.C., is open daily, from 10 a.m. to 10 p.m., except on Sundays, Christmas Day, Good Friday, and Bank Holidays. On the day observed as His Majesty's Birthday, Christmas Eve, Easter Eve, and Whitsun Eve, the Library is closed at 4 p.m.

C. N. DALTON,
Registrar.

April, 1906.

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